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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1893.

No. 1140.

THE UNITED STATES EX RELATIONE THE STATE OF SOUTH CAROLINA, PLAINTIFF IN ERROR,

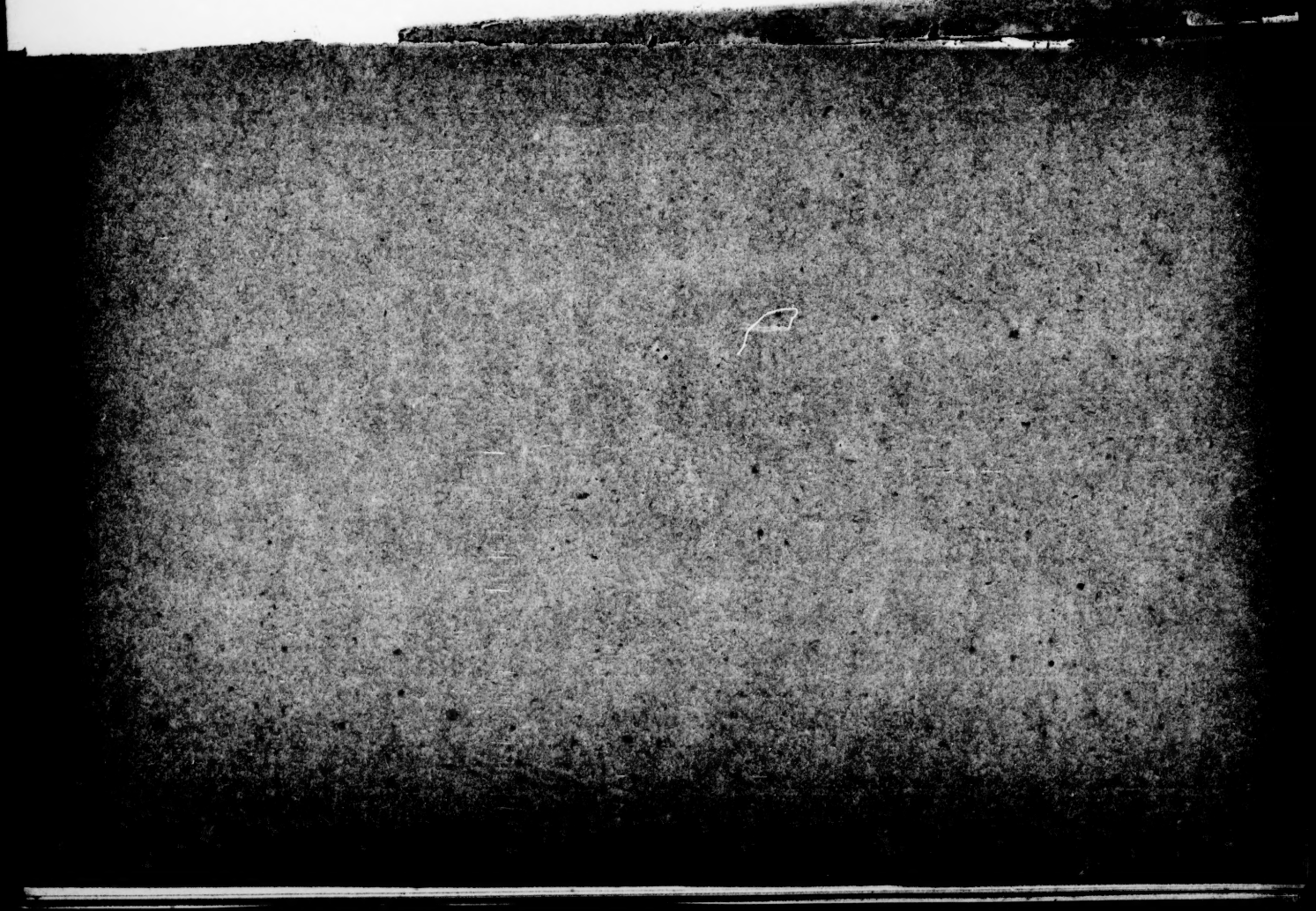
vs.

JOHN S. SEYMOUR, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

FILED MARCH 10, 1894.

(15,524.)



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1 & 2 Supreme Court of the District of Columbia.

THE UNITED STATES *Ex Relatione* THE STATE OF SOUTH CAROLINA *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } At Law. No. 34714.

UNITED STATES OF AMERICA, *District of Columbia*, } *ss*:

Be it remembered that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had in the above-entited cause, to wit:

Petition for Mandamus. Filed September 11, 1893.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *Ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner, *vs.* JOHN S. SEYMOUR, Commissioner of Patents, Respondent. } At Law. No. 34714.

To the honorable justice of the supreme court of the District of Columbia, holding a special term of the said court for the trial of causes at law:

The petitioner, the State of South Carolina, a body politic and corporate, and one of the Commonwealths that constitute the United States of America, by Daniel A. Townsend, its attorney general, represents to your honor as follows:

1. The petitioner, under and by virtue of an act of its General Assembly, approved by its governor December 24, 1892, assumed control of and is at present, under and by virtue of the said act, engaged in a traffic in intoxicating liquors. Through its officers and agents, as authorized in the said act, and since July 1, 1893, the petitioner has bought and sold and otherwise handled in the way of trade, in the manner provided in the said act, certain kinds of pure and unadulterated liquors. In connection with the said liquors and the sale thereof, and as a means of designating the same, the petitioner adopted and used a certain trade-mark, and thereby became and was the owner of the said trade-mark as used in connection with such liquors, and it has remained such owner to the present time.

2. The petitioner's trade-mark, adopted as aforesaid, has become famous, and constitutes a valuable right which the petitioner is desirous of protecting to the full extent of the law enacted for the protection of trade-marks.

3. The trade-mark aforesaid is used in commerce with foreign nations; and the petitioner, desirous to avail itself of the benefits of the act of the Congress of the United States approved March 3, 1881, applied to the Commissioner of Patents for the registration thereof under the said act. The petitioner has complied in this regard with all the requirements of the said act. On July 15, 1893, it paid into the Treasury of the United States the sum of twenty-five (25) dollars and filed with the Commissioner of Patents,
3 John S. Seymour, aforesaid, its statement and declaration as required by the said act, and in all respects complied with the provisions of the said act and the regulations thereunder prescribed by the Commissioner of Patents. Its statement and declaration, so filed, are in the words following, to wit:

To all whom it may concern:

Be it known that the State of South Carolina, one of the Commonwealths composing the United States of America, possessed in this regard of the full rights of a corporation, and doing business at its capital city of Columbia, in the county of Richland, State aforesaid, has adopted for its use a trade-mark for chemically pure distilled liquors of which the following is a full, clear, and exact specification:

The said trade-mark consists of the word "palmetto." This has generally been arranged as shown in the accompanying fac-simile, in which the said word palmetto appears in ornamental type, curved above a representation of a portion of the State coat of arms, showing the palmetto tree growing in foot hills. The said representation is enclosed within an annulus, and between the annulus and the curved word palmetto appear the words of the motto, "Animis opibusque parati." The annulus above referred to is supported by an ornamental bracket, which rests upon a name-band having shade lines from side to side, and ending in ornamental scroll-work. Upon the said name-band appears, as in the fac-simile, the name of the particular distilled liquor enclosed within the receptacle to which the trade-mark is applied, to wit, "bourbon whiskey;" or the words "gin, rye whiskey, New England rum, Jamaica rum, California brandy, blackberry brandy," or the like may be used in place thereof when other liquors are to be designated.

In the fac-similes herewith presented this name is printed in ornamental type, shaded in high relief. Below the name-band appears the word "warranted," printed in plain capitals upon a line, and below this word appears the words "U. S. standard proof," printed in shaded capitals, below which appears the conjunction "and," preceded and followed by a dash, and below this are the words "chemically pure," printed in the same style as the words "U. S. standard proof." Below all of this are the words indicating the origin of the article, "South Carolina State dispensary," under which is "Columbia, S. C."

Above the curved word palmetto are placed stars to indicate the quality of the article enclosed.

The whole is usually enclosed in an ornamental border which imitates lath scroll-work.

It is to be understood that all the words above described, excepting the one word palmetto, may be omitted, and the various accessories of ornamentation and arrangement may be varied at pleasure or altogether omitted, and the said word palmetto and its accessories may be printed in any style of type, in any method of arrangement, and in any color without materially altering the character of the said trade mark, the essential feature of which is the word "palmetto."

This trade-mark has been continuously used by the said State since the first day of July in the year of our Lord 1893.

The class of merchandise to which this trade-mark is appropriated is intoxicating liquors, and the particular description of goods comprised in such class on which it is used by the said State are chemically pure distilled liquors.

4 It has been the practice to apply the said trade-mark to the bottles, flasks, jugs, kegs, and other receptacles containing the liquors by means of suitable labels, on which it is printed as above described. The trade-mark may also be used by attaching the said labels to baskets, crates, barrels, boxes, hogsheads, and the like in which the articles may be packed, or it may be branded upon the said receptacles, blown into any and all glass receptacles, stamped or molded upon stone or earthenware, or used in any of the many well-known ways.

The said trade-mark palmetto may be used upon letter-heads, bill-heads, posters, dodgers, and the like, and generally in all ways known in the art of advertising.

In testimony whereof, I, Benjamin R. Tillman, governor of the State of South Carolina have hereto affixed my signature in the presence of two witnesses, and have caused the seal of the State of South Carolina to be hereto attached.

STATE OF SOUTH CAROLINA,
By B. R. TILLMAN,
Governor of the State of South Carolina.

W. H. ELLERBE,
Comptroller General.
D. A. TOWNSEND,
Attorney General.

By the Governor:
J. E. TINDALL,
Secretary of State, State of South Carolina.

[Seal of State of S. C.]

STATE OF SOUTH CAROLINA, } *To wit:*
County of Richland, }

Benjamin R. Tillman, being duly sworn, deposes and says tha he is the governor of the State of South Carolina, the applican named in the foregoing statement; that he verily believes that th

foregoing statement is true; that the said State at this time has a right to the use of the trade-mark therein described; that no other person, or firm, or corporation has the right to such use either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the said trade-mark is used by the said State in commerce with foreign nations or Indian tribes, and particularly with Canada; and that the description and fac-similes presented for record truly represent the trade-mark sought to be registered.

B. R. TILLMAN, *Gov. S. C.*

Subscribed and sworn to before me this 13th day of July, in the year of our Lord, 1893.

[SEAL.] N. K. PERRY,
Notary Public, S. C.

4. The trade-mark aforesaid is lawfully used as such by the petitioner in foreign commerce; it is not merely the name of the petitioner; it is not identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, and it does not so nearly resemble any other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; there is no dispute between the petitioner and any previous registrant of a trade-mark or
5 any applicant for registration; but the trade-mark of the petitioner aforesaid is altogether lawful and the claim of the petitioner thereto as owner and user thereof is altogether just and legal; and the plain duty of the Commissioner of Patents in the premises is to register the said trade-mark, thus admitting the petitioner as the owner of the said mark to the benefits of the trade-mark statute aforesaid.

5. Yet the Commissioner of Patents has refused, and still continues to refuse to register the trade-mark aforesaid, thereby denying to the petitioner a plain right which as owner of the said trade-mark it has to the registration thereof under the statute aforesaid; and the petitioner is thereby greatly injured and damaged, and petitioner has no other remedy in the premises than the one herein prayed for.

6. The petitioner files herewith a copy of its trade-mark herein mentioned and of the request to the Commissioner of Patents to register the same; it files also a communication received from the trade-mark examiner, dated July 28th, 1893, and a copy of his answer to the Commissioner dated August 1, 1893; it likewise files a copy of the answer made by its attorneys before the Patent Office to the said communication, as also a copy of the brief by them filed with the Commissioner of Patents on appeal to him in person; it files also a copy of the opinion of the Commissioner dated August 30, 1893, refusing to register the said trade-mark, and likewise a copy of the argument made by its attorneys on a rehearing of the case and the Commissioner's answer thereto, dated September 6, 1893, the said papers being marked Exhibits A, B, C, D, E, F, G, H, and I, respectively.

Wherefore, your petitioner prays that an alternative writ of mandamus may issue from this honorable court directed to the respondent, the said John S. Seymour, Commissioner of Patents, commanding him to register the said trade-mark as provided in the said statute of March 3, 1881, or else to appear before this honorable court on a day appointed by your honor and show cause for his failure so to register.

THE STATE OF SOUTH CAROLINA,
By D. A. TOWNSEND, *Its Attorney General.*

STATE OF SOUTH CAROLINA, }
County of Richland, } *ss:*

Daniel A. Townsend, a citizen of the State of South Carolina, being first duly sworn, deposes and says that he is the attorney general of the State of South Carolina; that he is acquainted with the contents of the foregoing petition by the said State, which in the name of the said State he has subscribed; and that the matters and things set forth in the said petition are true, as he verily believes.

D. A. TOWNSEND.

Subscribed and sworn to before me this 8th day of September, A. D. 1893.

[SEAL.] J. A. SAWYER,
Notary Public, S. C.

Exhibit A. Filed September 11, 1893.

(Eight fac-simile labels.)

(See side p. 75.)

6 EXHIBIT B. Filed September 11, 1893.

To the Commissioner of Patents:

Herewith is presented a fac-simile of the lawful trade-mark of the State of South Carolina; and I have to request that the same, together with the accompanying statement and declaration, be registered in the United States Patent Office, in accordance with the law in such cases made and provided.

And the State has appointed John Altheus Johnson and James Edgar Smith its attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, and to transact all business in the Patent Office connected therewith.

B. R. TILLMAN,
Governor of the State of South Carolina.

EXHIBIT C. Filed September 26, 1893.

Room No. 240½.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *July* 28, 1893.

The State of South Carolina (care Johnson & Smith), city:

Please find below a copy of a communication from the examiner of trade-marks regarding your trade-mark application, filed July 15, 1893.

Very respectfully, JOHN S. SEYMOUR,
Commissioner of Patents.

Case No. 44836.

This application is peculiar, and in its consideration questions not hitherto considered by the office are presented. As a matter of form it is observed that the words "copyrighted 1893" appear upon the labels, which is contrary to fact, and under the copyright law entails a penalty. These words should therefore be removed from the label.

The statute provides only for the registration of trade-marks owned by persons, firms, or corporations; a State of the American Union is neither a person, a firm, nor a corporation, and it is doubtful if the statement that it is "possessed of the full rights of a corporation," though to a certain extent true, makes it a corporation in the sense contemplated by the act of March 3d, 1881; consequently the right of applicant to register a trade-mark cannot be admitted.

It is thought on account of the peculiar character of the case that it ought to be considered by the Commissioner formally, and therefore should be brought before him by petition. For this purpose, in order that it may be presented to him without delay, the application is rejected and, so far as the examiner is concerned, a second action is waived.

7 EXHIBIT E. Filed September 11, 1893.

United States Patent Office. The State of South Carolina. Trade-mark. Filed July 15, 1893. No. 44836. Appeal to the Commissioner.

Examiner's Answer.

Petition is taken from the examiner's refusal to register a trade-mark for whiskey applied for by the State of South Carolina. There is no objection to the trade-mark presented, but the case is a novel one in respect to the character of the applicant, and for this reason, apart from all other objections, the examiner has preferred that it should be considered by the Commissioner in person.

The only objection that has been made is that a State of the American Union is not a corporation as contemplated in the act of M'ch 3, 1881, for the registration and protection of trade-marks. Certainly it is a corporation in one sense, but it is not a private corporation such as is created for the advantage or emolument of individuals; but it is a public or municipal corporation established to exercise functions of government. It may seriously be questioned whether the act of M'ch 3, 1881, used the word corporation in the municipal or public sense, but only referred to private manufacturing or trading corporations. The office rule based upon this statute requires that the corporation filing an application shall state by the laws of what State it is incorporated, and therefore contemplates the corporation as a creature of the State rather than as a State itself. That a State is not a corporation for all purposes is shown by the decision in Georgia *v.* Atkins, 1 Abb. U. S., 22, in which it was held that "a State is not embraced in the word corporation as used in a United States internal-revenue law imposing a tax on corporations." Possibly the Commissioner's familiarity with corporation law may lead him to other authorities as pertinent or more so, but if a State is not included as a corporation in a revenue law it is fair to doubt whether it is included as a corporation in a trade-mark law. To the examiner's mind it has seemed that in order to be able to register this trade-mark the State of South Carolina should by law have created a corporation with the necessary powers to carry out the provisions of its dispensary law, and that such corporation might properly have registered any trade-mark it might have adopted on behalf of the State. The case is—

Respectfully submitted

F. A. SEELY,
Examiner of Trade-marks.

August 1, 1893.

EXHIBIT E. Filed September 11, 1893.

In the United States Patent Office. State of South Carolina. Application for registration of trade-mark. Filed July 15, 1893. Case No. 44836.

The Commissioner of Patents.

SIR: The official letter of July 28th has been received, and in reply thereto the State of South Carolina desires to say that it appreciates the action of the examiner, and especially the fact that the case has been speeded.

The words "copyrighted 1893," which appear upon the label, were placed there under a misapprehension as to the proper
8 method of protecting trade-mark property. There was never any intention to deceive any person or persons by using these words; but in the rush and hurry of business, and in preparing to meet the requirements of the law whereby the State assumed control of the liquor traffic, the words were used upon the first labels

printed in the belief that the proper method of procedure would be under the copyright law, and that the label would be copyrighted as a matter of course as soon as application therefor was made, and before the occasion to use them arose, viz., July 1, 1893. The new labels, which are about to be printed, will not have these words, and, as a matter of fact, these words were stricken from the labels first printed when attached to the liquors on which used; and it was an oversight on the part of the State's attorneys not to erase these words from the labels filed.

Amendment is hereby made by cancelling the words "copyrighted 1893."

In reply to the second paragraph of the letter above referred to the attorneys beg to call the attention of the office to the fact that the statute of March 3, 1881, provides that the "owners" of trade-marks, etc., may obtain registration. It is also respectfully urged upon the office by the attorneys that, for the purpose of the said act and as affording the identification required thereby of the "party applying" for the benefits thereof, a State of the American Union is both a person and a corporation. As far as the phraseology used in the application to indicate the State's corporate powers is concerned, the attorneys are perfectly willing to change that, if necessary, to meet the requirements of the office; but would ask that for the present the matter be left where it is, in order that the case may be fully heard by the Commissioner.

The attorneys further ask the attention of the office to the fact that the act of March 3, 1881, contemplate- persons and corporations that trade. The State of South Carolina, a body politic, and therefore a corporation, having established a trade in intoxicating liquors, and having a common-law trade-mark, which is used in commerce with a foreign nation, to wit, Canada, having its place of business or corporate domicile in the city of Columbia, in the State of South Carolina, in the United States of America, is undoubtedly entitled to registration under the present trade-mark law.

The attorneys thank the examiner for his courtesy; and, as he has waived second action, in the same spirit and for the same purpose they also waive the second action and will petition that the Commissioner hear the case in person.

Very respectfully,

JOHN ALTHEUS JOHNSON,
JAMES EDGAR SMITH,
Attorneys for the Applicant, the State of South Carolina.

EXHIBIT F. Filed September 11, 1893.

In the U. S. Patent Office. The State of South Carolina. Application for registration of trade-mark. Filed July 15, 1893. Case No. 44836.

Brief in Behalf of Applicant.

The decision of the examiner of trade-marks, from whose action this appeal is prosecuted, is expressed in the following language:

"This application is peculiar, and in its consideration questions not hitherto considered by the office are presented.

9 "The statute provides only for the registration of trade-marks owned by persons, firms, or corporations. A State of the American Union is neither a person, a firm, nor a corporation, and it is doubtful if the statement that it is 'possessed of the full rights of a corporation,' though to a certain extent true, makes it a corporation in the sense contemplated by the act of March 3, 1881; consequently, the right of applicant to register a trade-mark cannot be admitted."

Let us glance for one minute at the phraseology employed in the application herein. The application does not allege, *totidem verbis*, that the State is a corporation. A definition that would describe a State as a corporation simply would be meager, indeed, if not positively defective. A State is a corporation, but it is much more. Every essential characteristic or quality of a corporation is to be found in a State; that is to say, all the attributes and qualities that go to constitute a corporation are to be found in the distinctive entity styled a State; and hence a State for many purposes is regarded by the law simply as a corporation, and so designated; and still to say of a State that it is a corporation, simply, would be to shear it of much of its dignity, by failing to recognize the fullness of its sovereign power. When we say "State," we by implication say "corporation;" that is, by the word State, we designate an entity which is inherently a corporation. We don't need to predicate of it that it is a corporation; its very name imports that it is a corporation. Hence, in drawing the present application, we did not derogate from the prerogatives of a sovereign State by making her synonymous simply with a corporation; we alleged her statehood and called attention simply to her corporate capacity and independent legal existence, entitling her to engage in trade and to avail herself of all the rights provided for persons, artificial or otherwise, who engage therein. The words of the application on this point are as follows:

"Be it known, that the State of South Carolina, one of the Commonwealths composing the United States of America, possessed in this regard of the full rights of a corporation, and doing business at its capital city of Columbia, in the county of Richland, State aforesaid, has adopted for its use a trade-mark," &c., &c.

Having thus explained why the particular phraseology used in the application was adopted, let us now see if it be not true that a State is a corporation in every sense of the word when under the law it is necessary or proper for it to avail itself of its rights. Let us see what the courts say.

In the case of Delafield *v.* State of Illinois, 2 Hill (N. Y.) 159, the State of Illinois had filed a bill in a court of chancery in New York, praying that Delafield be required to deliver up certain bonds and stocks issued by the State of Illinois which, it was alleged, the State officers or agents had delivered under a contract they had no authority to make. The chancellor having decreed the relief prayed, the case came before the court of errors of New

York (twenty judges sitting) where the twofold objection was made (1) that at the common law a State could not sue; and (2) that it could not sue in the courts of another State. The court in the course of its opinion, speaking by Mr. Justice Bronson, says (p. 162):

"I cannot entertain a doubt that one of the States of this Union may sue in its political or corporate capacity. In that capacity it may contract and acquire rights; and there can be no reason why, like every other legal being, it should not be allowed to sue for the redress of wrongs. It is a matter of every-day observation that such suits have been brought and maintained; and I am not aware that any one has ever thought before of making a question about it. I see no difference whether a State sues in its own courts or in those of another jurisdiction. Although the right of the people of this State to sue is recognized by the laws, there is, I believe, no direct provision that such suits may be maintained. The right depends on the general principle that every person, whether natural or artificial, capable of making a contract or suffering a wrong, may have an action to enforce the one and to redress the other."

To the same point is the State *v.* Delesdenier, 7 Texas, 76. In this case the State, through her attorney general, had brought suit to recover certain lands of which the defendant was in possession. The proceedings had been objected to and the court on appeal said (p. 95):

"Of the right of the State to appear in her own courts and prosecute suits in her own behalf there can be no question; it is an incident of sovereignty, not dependent upon any statute."

The attorney general had proceeded in this case under direction of a joint resolution; and the court said further (p. 96):

"The State was not prosecuting her suit in the present instance by virtue of a special enactment, creating an exception to a general rule; but she was exercising an unquestionable right incident to her sovereignty. The right to sue was not in any way dependent upon the joint resolution; the resolution was the expression of her purpose made for the direction of her officer."

Further to the point that a government is inherently possessed of corporate and legal rights, and, therefore, to be viewed as a corporation simply when its rights or duties so require, let us turn to some decisions made by courts of the United States. There is no difference whatever between the government of a State and the Government of the United States in this regard; indeed, any distinct legal autonomy acting within its proper sphere is given the same recognition.

In the case of the United States *v.* Maurice *et al.*, 2 Brockenbrough, 96, decided by Chief Justice Marshall, then holding the circuit court for the district of Virginia, an action had been brought by the United States upon an official bond given by an officer whose appointment was irregular. As a statutory obligation the bond was void; it was, however, held to be good as a common-law obligation.

In the course of his opinion the Chief Justice uses this language (p. 109):

"It is contended that the bond is void because there is an inability on the part of the United States to make any contract not previously directed by statute.

"The United States is a government and, consequently, a body politic and corporate, capable of attaining the objects for which it was created, by the means which are necessary for their attainment. This great corporation was ordained and established by the American people, and endowed by them with great powers for important purposes. Its powers are unquestionably limited; but, while within those limits, it is a perfect government as any other, having all the faculties and properties belonging to a government, with a perfect right to use them freely in order to accomplish the objects of its institution. It will certainly require no argument to prove that one of the means by which some of these objects are to be accomplished is contract. The Government, therefore, is capable of contracting, and its contracts may be made in the name of the United States."

11 The same high authority, speaking in Dixon *et al. v.* United States, which was also an action of debt brought by the United States on a bond, reported in 1 Brockenbrough, 177, says (p. 181):

"It is contended on the part of the plaintiffs in error that the bond is void.

"It is void, they say, because the United States of America, not being a natural but an artificial being, is incapable, at common law, of becoming a party to a contract.

"The instances given to illustrate the position taken by the plaintiffs in error are those of a corporation which has not acted by its corporate name, or of a corporation which has expired, neither of which is supposed to be the fact in this case. A bond given to the people of the United States would undoubtedly be void at common law, and perhaps a bank whose charter had expired might no longer be capable of sustaining an action; but 'The United States of America' is the true name of that grand corporation which the American people have formed, and the charter will, I trust, long remain in full force and vigor."

Again to the point that a State is a corporation in all matters where its property rights or interests are involved, let us turn to the case of Cotton *v.* United States, 11 Howard, 229, where we have the voice of the highest tribunal in the land on the subject. This case was one where the United States had brought a civil action for damages for trespassing upon public lands; but we will let the court speak for itself (p. 231):

"This is an action of trespass *quare clausum fregit* brought by the United States against Loftin Cotton, in which he is charged with cutting and carrying away a large number of pine and juniper trees of plaintiff.

"On the trial below, the counsel for defendant requested the court to instruct the jury, 1st, that the only remedy for the United States for cutting pine timber on the public lands was by indictment; 2d,

that the United States have no common law remedy for private wrongs. The refusal of the court to give these instructions is now alleged as error.

"Every sovereign State is, of necessity, a body politic, or artificial person, and, as such, capable of making contracts and holding property, both real and personal. It is true, that in consequence of the peculiar distribution of the powers of government between the States and the United States, offences against the latter, as a sovereign, are those only which are defined by statute, while what are called common-law offences are the subjects of punishment only by the States and Territories within whose jurisdiction they are committed. But the powers of the United States as a sovereign, dealing with offences against their laws, must not be confounded with their rights as a body politic. It would present a strange anomaly indeed, if, having the power to make contracts and hold property as other persons, natural or artificial, they were not entitled to the same remedies for their protection. The restraints of the Constitution upon their sovereign powers cannot affect their civil rights. Although as a sovereign the United States may not be sued, yet as a corporation or body politic they may bring suits to enforce their contracts and protect their property, in the State courts or in their own tribunals administering the same laws. As an owner of property in almost every State of the Union, they have the same right to have it protected by the local laws that other persons have. As was said by this court in Dugan *v.* United
12 States, 3 Wheat., 181, 'It would be strange to deny to them a right which is secured to every citizen of the United States.' In the United States *v.* The Bank of the Metropolis, 15 Peters, 392, it was decided that when the United States, by their authorized agents become a party to negotiable paper, they have all the rights and incur all the responsibilities of other persons who are parties to such instruments. In the United States *v.* Gear, 3 Howard, 120, the right of the United States to maintain an action of trespass for taking ore from their lead mines was not questioned.

"Many trespasses are also public offences by common law, or are made so by statute; but the punishment of the public offence is no bar to the remedy for the private injury. The fact, therefore, that the defendant in this case might have been punished by indictment as for a public offence is no defence against the present action."

It is not our purpose to pile Pelion on Ossa in an attempt to scale a point too weak to afford resistance; but some of the words of Chief Justice Marshall in the case of the Bank of the United States *v.* The Planters' Bank of Georgia, 9 Wheaton, 904, are so apposite to the matter of this discussion that we will not refrain from quoting them. The State of Georgia was a member of the Planters' bank, a corporation which it had created for banking purposes. The question before the court was whether the fact that the State of Georgia was one of the corporators ousted the jurisdiction of the circuit court and gave jurisdiction to the Supreme Court, under article XI of the Amendments to the Constitution. Confessedly, as a sovereign, the State of Georgia would not have been

suable in the circuit court; but the suit was against a corporation of which the State had become a member like any other corporator or private stockholder. The State had a perfect right of course, having seen fit to do so, to connect itself with others in the banking business. But to give the words of the Chief Justice in the matter before the court (p. 907):

"When a government becomes a partner in any trading company, it divests itself, so far as concerns the transactions of that company, of its sovereign character, and takes that of a private citizen. Instead of communicating to the company its privileges and its prerogatives, it descends to a level with those with whom it associates itself, and takes the character which belongs to its associates, and to the business which is to be transacted. Thus, many States of this Union which have an interest in banks are not suable even in their own courts; yet they never exempt the corporation (the banking corporation) from being sued. The State of Georgia, by giving to the bank the capacity to sue and be sued, voluntarily strips itself of its sovereign character, so far as respects the transactions of the bank, and waives all the privileges of that character." Again, on page 908: "The government, by becoming a corporator, lays down its sovereignty so far as respects the transactions of the corporation, and exercises no power or privilege which is not derived from the charter."

A State, the repository of sovereign power, is a corporation, from whatever aspect viewed; it differs from corporations of its own creation chiefly in the plenitude of its power. A private, or specially chartered, municipal corporation, is possessed only of the powers conferred upon it by its creator. The powers of the State, however, are as varied as the hues of a chameleon, deriving its colors from the light in which exhibited. No matter in what direction the State may branch out in the exercise of its power, it is the State still, possessed in the eye of the law of its corporate existence.

13 In the light of the judicial opinions which have been cited, and others which might be cited to the same effect, no doubt whatever can exist but that the courts would accord to a State all the rights which exist at the common law in a trade-mark, and protect her to the utmost in the ownership and enjoyment thereof.

The question is reduced then to the simple one as to whether the act of 1881, governing the registration of trade-marks, embraces the case of States which engage in trade and adopt trade-marks. There is nothing whatever about the act to indicate that such States are not within its meaning. Let us quote the words of so much of the statute as is material to the matter in hand (21 St. at L., p. 502):

"Owners of trade-marks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country or tribes which, by treaty, convention or law, afford similar privileges

to citizens of the United States may obtain registration of such trade-marks by complying with the following requirements:

"First. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying. * * * *

"SEC. 2. The application prescribed in the foregoing section must be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use." * * * * *

The terms of the act, it will be noted, are broad—"Owners of trade-marks * * * * * domiciled in the United States * * * * may obtain registration" of the same. There can be no doubt as to the domicile, or habitat, of a State that is a constituent part of the Federal Union. The very title of the act is "An act to authorize the registration of trade-marks and protect the same;" and the subsequent act of August 5, 1882 (22 St. at L., p. 298), declares that nothing contained in the act of March 3, 1881, "shall prevent the registry of any lawful trade-mark rightfully used by the applicant." * * *

"Owner," "party applying," and "applicant," are the broad terms used. "Owners" may obtain registration; and, as though to designate such as unrestrictedly as possible, we have them referred to by the words "party applying" and "applicant."

For the purposes of personal description and identification the act provides that the "owner" or "party applying" shall cause to be recorded in the Patent Office a statement specifying his "name, domicile, location, and citizenship." The word "citizenship" is a term that has regard simply to the legal rights and status of the party to whom applied; and in the present place is intended to distinguish the party according to the government and laws under which he is resident; for the owners of trade-marks "in any foreign country or tribes" are not allowed registration under our law, unless such countries or tribes "by treaty, convention, or law, afford similar privileges to citizens of the United States." "Citizens" and "citizenship" are not words that are dissociated from government and law. They have regard always to some system of polity and rights thereunder; they do not designate natural persons, or individuals, any more than artificial persons or corporations, for both classes of persons are possessed of rights and privileges under the law, and both have the consideration and protection of the
14 laws; and hence "citizenship" is predicated of the one equally with the other. Or, to use the language of the Supreme Court in Louisville R. R. Co. *v.* Letson, 2 Howard, 497, a case in which objection had been made to the jurisdiction of the circuit court for the district of South Carolina on the plea of the citizenship of the parties (p. 555):

"A corporation created by a State to perform its functions under the authority of the State and only suable there, though it may have members out of the State, seems to us to be a person, though

an artificial one, inhabiting and belonging to that State, and therefore entitled, for the purpose of suing and being sued, to be deemed a citizen of that State."

And (p. 558): "A corporation createdby and doing business in a particular State, is to be deemed to all intents and purposes as a person, although an artificial person, an inhabitant of the same State, capable of being treated as a citizen of that State as much as a natural person. Like a citizen, it makes contracts, and though, in regard to what it may do in some particulars, it differs from a natural person, it is substantially, within the meaning of the law, a citizen of the State which created it, and where its business is done, for all the purposes of suing and being sued."

The word "domicile" is likewise a legal term, and does not in any manner restrain, limit, or quality the character of the party applying, being an owner, since it is predicable of every person, natural or artificial, that can trade.

The "application" for registry, however, "must be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use."

The words here used, "person," "firm," and "corporation," are but an elaboration of the word "owner;" they are but species or classes into which the generic term is here divided; they are not intended to be restrictive of the broad words first used, "owners" and "party applying;" nor, in the light of what has been said, are they so restrictive. They are but a distribution of what is contained in the word "owner;" as to whether they exhaust that word is another question; probably they do exhaust it. We have no doubt, however, but, as used in the statute, they embrace a State that is an "owner" of a trade-mark.

The only other ground on which it could be contended that registration should be denied to the applicant would be the broad and general one which, outside of this statute and without regard to it, denies a trade-mark or trade-mark rights to any one not engaged in trade and not using the mark in connection with articles of trade. The right to adopt, own, and use a trade-mark is incident to the right to engage in trade or commerce; and, unless the right of a State to trade at all is to be denied, her right to acquire and use a trade-mark must be admitted. But it will not be seriously questioned, we take it, that a State may engage in trade, in business, in commerce, or in any other pursuit which it may consider of benefit to its people, or which for the common welfare it may desire to control. Governments of all kinds and at all times have successfully assumed and used these powers. In Hungary at this time the government controls certain wines; in Germany certain railroads are directly under the control of the state and are
15 owned by the state; and in France the state controls the manufacture and sale of tobaccos, matches, and the like. There is one branch of traffic controlled almost exclusively by the

state in all portions of the world, and that is the postal system. It needs no argument to show that the postal service would naturally be a branch of traffic, a business open to common competition like the express and parcels systems of the various countries, had it not seemed proper to all the governments of the world to assume control of the postal systems within their own territory. By international conventions the systems have been so linked that its advantages are apparent everywhere.

The telegraph systems of Great Britain and France are owned by the state and are under immediate governmental control in connection with the postal systems there. In like manner the parcels systems of these countries and of Switzerland are to a large extent absorbed by the postal systems thereof.

The monopoly of tabaccos and tobacco products in France by the state has been of inestimable benefit to the French people; and the trade that is carried on by the French government in this class of goods is of enormous proportions.

The State of South Carolina has done what it had the perfect right to do, established State control and ownership of the liquor traffic. It has entered into trade in this particular, and its acts in this regard cannot be questioned elsewhere.

The State of South Carolina, in entering into trade, has established for itself a trade-mark valid at common law, and has used that trade-mark, not only within its own boundaries, but also in commerce with a foreign nation, to wit, Canada: and has thereby brought itself within the terms of the statute of March 3, 1881, relating to the registration of trade-marks in the Patent Office of the United States of America.

As far as we are advised, this is the first case of the kind ever brought before the United States Patent Office, and a somewhat diligent search among authorities and precedents fails to show an adjudicated case of this kind within the United States. However, the reason for the statute seems to be in favor of the registration of a trade-mark owned by a State, whenever such a case may arise, and we may, without violence, examine the views taken in foreign countries of state trade-marks.

In this connection, we quote by translating from an authority on trade-marks, to wit: Noveau Traité des Marques de Fabrique et de Commerce, Par Alexandre Braun, Bruxelles-Paris, 1880. This author says, on page 249, subsection 75, as follows:

"What of a state?—The question if a state is competent to claim its trade-mark as a producer or manufacturer has been presented repeatedly before our courts and tribunals and those of other countries. It has been decided in the affirmative. Why, indeed, if a state may engage in an industry, has it not, as every trader, in consideration of the performance of the usual formalities, the right to certify the origin of products coming from its manufactories? So the court of cassation has declared that the State of Belgium, inasmuch as it manufactures guns to arm the soldiery, ought to be considered as a regular manufacturer. (Cass. B., 5 mai 1870, État belge c. Gerard, Ancion et Ce., P. B., 1870, I, 265.) What is to prevent,

therefore, besides the official stamp, which attests that its arms have passed the board of approval, the impress of a mark showing that they are of its own make?

16 "It has been decided: 1°. That the French administration is properly allowed, in our jurisdiction, the character of a private manufacturer, whose trade-mark is susceptible of protection on condition that the outward sign of its product (cigarettes) has been regularly registered at the Registry of the Tribunal of Commerce in Brussels, in the same way as all other foreign producers (Cass. B., 26 dec. 1876, Proc. génér., Spies et État français c. Kiss et consorts, P. B., 77, I, 54); 2°. That the usurpation or imitation of a trade-mark, such as that the French state places upon the cigarettes made and sold by it, falls within the application of the German law of November 30, 1874, especially when the registration of that mark has been regularly made and published conformably to that law (Trib. de 1re instance de Dresde, 3 mars 1877, État français c. Taenbrich, Pataille 77, 199").

It may easily be imagined that the cases cited above in M. Braun's book were not uncontested, and if there were any ground for holding that a state cannot engage in commerce this objection would have been urged. It is to be noticed, also, that these decisions are made in favor of powers that have not always been friendly to each other. One decision made by the French court of cassation holds that Belgium is entitled to be protected in France in the use of its trade-mark upon guns and the like manufactured by that state; and the other, which is stronger for the purposes of this argument, is a decision of the tribunal of the first instance of Dresden, holding that the trade-mark of the government of France used upon its cigarettes is entitled to full protection in Germany under the registration act there in force. Inasmuch as these countries, France and Germany, base the right to recover damages for the infringements of trade-marks upon the fact of registration, these decisions are the stronger in our favor, going to show that a state has the right to registration and protection of its trade-marks used in ordinary commerce.

We desire to quote further from the exhaustive work of the Count Maillard de Marafy. The title of the book is the "Grand Dictionnaire International de la Propriété Industrielle au point de vue du Nom Commercial des Marques de Fabrique et de Commerce et de la Concurrence Déloyale: par le Cte. Maillard de Marafy.—Paris, 1891." The particular portion of this work from which we quote will be found in the third volume, on pages 601, 602, under the title "État." For convenience we have translated these pages and incorporate the translation herewith.

Dictionary of Industrial Property (Trade-marks) by Maillard de Marafy, vol. III, pages 601–2.

"1. The state, as well as private individuals, may have to appeal, on its own account, to the laws concerning trade-marks, trade, and proprietary names. The state possesses, indeed, generally, manufactories, forests, mineral springs, industrial monopolies of every kind, tobacco, powder, matches, &c. In like manner it may

have to affix its seal to authenticate brands, guarantee the reality of licenses of enterprises granted by itself; in a word, to make demands or suits upon usurpations or counterfeits. Therefore, it is proper in this place to examine the law suits which belong to it in these diverse hypotheses.

"2. In France the state owns manufactories of tobacco, of powder, of arms, of matches, of tapestry, and of porcelain. These manufactures possess trade-marks, some of which are very celebrated: for example, that of the manufactory of Sevres.

"The state can defend its rights in this respect by relying upon two sorts of legal provisions: Article 142 of the penal code and the law of June 23d, 1857, upon trade-marks.

17 "3. Article 142 of the penal code punishes with imprisonment from two to five years every counterfeiting of the seal of the state upon merchandise. This is a penalty relatively rigorous, and that, for this reason, might be repugnant to the judge in the present state of our customs. Accordingly, the French government has preferred to register its trade-marks, in accordance with the law of June 23, 1857, and to appeal only to its provisions.

"It should be added that this determination was suggested by our consuls abroad, in order to raise no point of law which might complicate the matter. The trade-marks in question have been registered in the registry of the tribunal of commerce in Paris, and afterwards in foreign countries. It is under these conditions that numerous procedures have been commenced for the counterfeiting of the trade-mark for tobacco in Germany, in Belgium, and in Switzerland. It was in Germany the most important successes were obtained. On page 113, vol. I, will be found a remarkable specimen of one of the condemned imitations. The legal fight was victorious from start to finish. And, therefore, it was not without some astonishment that one saw the administration, as soon as its rights of ownership were well established in its trade-marks, abandon them immediately in order to adopt new ones. Now, we do not think we state anything new when we say that the habits of German smokers do not change rapidly. It is the old trade-mark which for some time yet will be the only true one in the minds of a goodly number of the faithful. We could not wish for a better proof of this fact than the following:

"There exists yet in Germany, although the fact seems hardly credible, tobacco bearing counterfeits of the trade-marks of the administration of the Bourbons in France. We, ourselves, have bought samples of this piracy in Dresden, and we have the labels at this moment before our eyes. There is yet, it seems, a patronage in Saxony for this brand.

"At the time of the suits undertaken in 1875 by the French government the counterfeits branded with the fleur-de-lis disappeared temporarily from the shop windows; but, no action having been entered against it, it soon reappeared in circulation. What is more interesting is that at that time that kind was readily sold as French tobacco. We remember that the consul general at Leipzig, carried away by his zeal, wished to file a complaint, but the administration

considered that a wise abstention was particularly proper in the circumstances, and the matter rested there."

It appears, therefore, that several states in Europe have trade-marks which are registered in their own and in foreign countries, and, in this connection, we call attention to article VI of the convention of the International Union for the protection of industrial property (1886), the United States of America being one of the powers subscribing to the convention. Article VI says:

"Every trade or commercial mark, regularly deposited in the country of origin, shall be admitted to deposit and so protected in all the other countries of the Union."

Therefore, France, Belgium, or any other power or state possessing a trade-mark, and being a member of the aforesaid Union, is entitled to registration in the United States Patent Office of any trade-mark regularly deposited in the country of origin. Is it possible that a foreign state should be entitled to registration under the act of March 3, 1881, and that one of the States of the American Union should be denied such registration? The mere state-
18 ment of the question carries conviction with it that every State in the American Union which has a trade of any kind, and in connection with that trade uses a trade-mark in commerce with foreign nations or Indian tribes, is entitled to all the benefits of the trade-mark laws of the United States.

But the case is still stronger. To look at it from one of its plainest aspects, let us suppose that the State of South Carolina, after determining to enter into trade, had bought a certain distillery, the products of which were known by the use of a certain trade-mark; and suppose the said trade-mark had been properly registered in the United States Patent Office, what then? Why, under section 12 of the act of March 3, 1881, and the rules and regulations therein authorized, the State of South Carolina would have become the owner of a trade-mark registered in accordance with the act in question, and the most learned and dignified court in the world, the Supreme Court of the United States, would have upheld the transfer and the State ownership. In this connection we refer to Browne on Trade-marks, second edition, Boston, 1885, §§ 53, 54, 361–363, and the cases there cited. Is it possible that a State, a body politic, a corporation, a legal entity, a person, which by the act of becoming a trader is thereby entitled, not only to use a trade-mark valid at common law, but also to own a trade-mark properly registered in the United States Patent Office by means of an ordinary sale, assignment, and use—is it possible, we repeat, that such a party should be denied registration of a trade-mark in the first instance as not coming within the meaning of the law?

But the question may be asked, Can a State of the American Union engage in commerce with a foreign nation? The answer is plain and simple. It may, provided there is no prohibition on such commerce or trade in the Constitution of the United States. Article I, section 10, of the Constitution says:

"No State shall enter into any treaty, alliance, or confederation; grant letters of marque and reprisal; coin money; emit bills of

credit; make anything but gold and silver coin a tender in payment of debts; pass any bill of attainder, *ex post facto* law, or law impairing the obligation of contracts, or grant any title of nobility.

"No State shall, without the consent of the Congress, lay any imposts or duties on imports or exports, except what may be absolutely necessary for executing its inspection laws; and the net produce of all duties and imposts, laid by any State on imports or exports, shall be for the use of the Treasury of the United States; and all such laws shall be subject to the revision and control of the Congress.

"No State shall, without the consent of Congress, lay any duty of tonnage, keep troops or ships of war in time of peace, enter into any agreement or compact with another State, or with a foreign power, or engage in war, unless actually invaded, or in such imminent danger as will not admit of delay."

Article X of the amendments to the Constitution says as follows:

"The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people."

The plain reading of the Constitution makes it clear that a State may engage in commerce with foreign nations or Indian tribes. Certainly the State has the same right as any other person to trade with the individuals of a foreign nation; and it is asserted without fear of question that the "commerce with foreign nations or
19 with the Indian tribes" required by the trade-mark act is not a "commerce or trade with "foreign nations" or "Indian tribes," as such, but with the subjects or individual citizens composing them. Perhaps 99 per cent. of the persons who have registered trade-marks have never had, and cannot have, commerce with "foreign nations" or "Indian tribes" in the collective, corporate, or sovereign character of such nations or tribes; but the only trade required by the statute, the only trade understood by the registrants, and the only commerce regarded by the Patent Office as necessary to bring an applicant within the statute, is a trade or commerce with the individuals, firms, or corporations of foreign nations or Indian tribes.

We have no hesitation in saying that every State has the sovereign right to engage in whatsoever trade, business or commerce the will of its people may choose, and that its act in so doing cannot be questioned elsewhere; we are sure that a State, viewed as a trading corporation, may own a trade-mark valid at common law; we are confident that it is competent to such a trading corporation to engage in commerce with foreign nations, and to use its common-law trade-mark in such commerce; and we have an abiding conviction that by doing these things the State has a perfect right to the registration of its trade-mark under the statute of March 3, 1881.

In conclusion, the State of South Carolina, a body politic, and, therefore, a corporation, having established a common-law trade-mark which is used in commerce with a foreign nation, to wit, Canada, having its place of business or corporate domicile in the city of Columbia in the State of South Carolina in the United States of

America, is undoubtedly entitled to registration under the present trade-mark law.

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In the U. S. Patent Office.—In the matter of the application of the State of South Carolina for registration of trade-mark, "palmetto," filed July 15, 1893, serial No. 44836.—Appeal to the Commissioner.

Supplemental Brief in Behalf of Applicant.

While the applicant has caused a brief to be prepared which it is believed fully covers the questions involved in this appeal, the attorneys for the State consider it only courteous to the examiner and to the office to make special response to the particular points which are raised in the examiner's answer. The brief itself was prepared in anticipation of objections which might be raised, but some slight amplification of a few of the points made therein will be appropriate in this reply, with an additional thought or two.

The examiner says:

"The only objection that has been made is that a State of the American Union is not a corporation as contemplated in the act of March 3, 1881, for the registration and protection of trade-marks. * * * The office rule based upon this statute requires that the corporation filing an application shall state by the laws of what State it is incorporated, and therefore contemplates the corporation as a creature of the State rather than as a State itself."

As has been insisted upon in the applicant's brief, the act of March 3, 1881, is an enabling act and not one to disqualify or restrict. The title of the act in full is "An act to authorize the registration of trade-marks and protect the same." From the title no one can imagine that the intent of Congress was to restrict any person, a lawful owner of a trade-mark, from registration under its provisions or to deny protection to any such lawful owner. The title is broad and liberal.

The act begins with these words: "That owners of trade-marks * * * may obtain registration of such trade-mark," etc. The other words used in connection with these contain no essential restriction upon them, except—

1. The restriction which it was considered necessary to give Congress power under the Constitution to enact any law whatsoever relating to trade-marks (Trade-mark cases, 100 U. S., 82).

2. And a restriction dictated by public policy for the benefit of the merchants and traders of this country in their commerce with the citizens of other powers.

This is absolutely all that is contained in the first paragraph of the act.

In the second paragraph the one operative word is "party applying," and the other words in the paragraph may be dismissed without consideration as being inserted merely for the purpose of iden-

tification and description. Even this word "party applying" is by grammatical construction and meaning referable back to the word "owners."

In section 3 are these words: "In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark, and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases." We think we need cite no authorities to show the Commissioner what the practice of courts of equity of the United States is in the construction of enabling statutes. It is well known to be broad and liberal. That Congress did not intend by this act to circumscribe or limit rights of any kind is apparent from section 10 of the act, which is as follows:

"That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed."

But in order to remove all doubt as to the latitude of the act of March 3, 1881, we will quote the act of August 5, 1882, which is entitled "An act relating to the registration of trade-marks:" it is in these words:

"That nothing contained in the law entitled 'An act to authorize the registration of trade-marks and protect the same,' approved March 3, 1881, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act."

This act, though it is restricted by its terms to "any lawful trade-mark used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act," yet shows by implication how broad the meaning of the original act was to the mind of Congress. The words are "nothing" and "applicant."

In regard to the office rule based upon the statute to which the examiner calls attention, it is respectfully submitted that the only object of the words of the statute and of the office rule is to provide proper identification of the "owner" or "party applying," and to guard against illegal or sharp practice in the prosecution of applications under the statute. Neither the statute nor the office rule necessarily "contemplates the corporation as a creature of a State rather than as a State itself."

21

The examiner says further:

"Certainly it is a corporation in one sense, but it is not a private corporation such as is created for the advantage or emolument of individuals; but it is a public or municipal corporation, established to exercise functions of government. It may seriously be questioned whether the act of March 3, 1881, used the word corporation in the municipal or public sense, but only referred to private manufacturing or trading corporations."

The answer to this is that a State, because it happens to be a sovereign, is not thereby divested of its rights to engage in trade or commerce. Its acts in this regard can only be questioned by itself. That a State is a sovereignty and exercises functions of government, is entirely beside the question that it also may be, and often is, a trading corporation.

The examiner cites the case of Georgia *v.* Atkins, 35 Ga., 315, as holding that "a State is not embraced in the word corporation as used in a United States internal revenue law imposing a tax on corporations."

Before discussing this case, the attorneys for the applicant desire to say that the State of South Carolina, in entering into the liquor trade, complied with the requirements of the United States internal revenue law regarding the sale of intoxicating liquors by causing her State commissioner to procure the proper license therefor.

However, the case of the State of Georgia *v.* Atkins, above cited, was in substance as follows: The State of Georgia owned exclusively the Western and Atlantic railroad, and James Atkins, collector of the fourth collection district of that State, endeavored to collect from the road some $6,000 as an income tax under the internal revenue laws of the United States. This attempt was resisted, and the State filed a bill against Atkins in the United States circuit court, praying an injunction to restrain the defendant from further proceedings. Atkins demurred to the bill.

There were two questions raised:

First. The jurisdiction of the United States circuit court, with which we have nothing to do in this case.

Second. Whether, under the internal revenue laws, it was the intention of Congress that a duty or tax should be collected out of property owned, controlled, and managed solely by a State.

This latter question arose under section 103 of the act of June 30, 1864, as amended by that of March 3, 1865, declaring "that every person, firm, company, or corporation owning or possessing, or having the care or management of, any railroad, canal, steamboat, ship, etc., engaged or employed in the business of transporting passengers or property for hire, or in transporting the mails of the United States, * * * shall be subject to and pay a duty of two and one-half per centum upon the gross receipts of such railroad, canal, steamboat, ship," etc.

The court held that a State was not included within the meaning of that statute, and said, among other things:

"The question, narrowed to a point, is this: Does the word or term 'corporation,' for the purposes of this act, and as herein used, include the term 'State'?" * * *

22 "In Dunn *v.* Ried (10 Peters, 524) it was remarked by Mr. Justice McLean, in pronouncing the decision of the court, that 'cases may be found where courts have construed a statute most liberally to effectuate the remedy, but where the language of the act is explicit there is great danger in departing from the word used, to give an effect to the law which may be supposed to have been designed by the legislature.' I am of the opinion that Con-

gress intended the term 'corporation,' as used in this act, to be understood in its general, obvious, and natural meaning; and, therefore, it does not include the term 'State'"

It is to be noted that the case arose upon what was really an attempt to collect "a duty of two and one-half per centum" upon the income of a State, as the earnings of the Western and Atlantic were a part of the revenue of the State.

Surely the court, in view of the prior decisions of the Supreme Court of the United States, did not mean to hold that a State is not a corporation, and to be regarded as a corporation in all proper cases when engaged in trade or commerce or business. It was merely construing the word corporation as used in the particular statute before it, and, as there used, it found the word not to include a State. The word to be construed in the trade-mark statute before us, as already pointed out, is the word "owner."

For the purposes of the present discussion, however, the case of Georgia *v.* Atkins is an admirable one, and we thank the examiner for citing it. It is set forth most clearly in that case, and was admitted by the defendant's demurrer, that the State of Georgia was the exclusive owner of the Western and Atlantic railroad. It also appears that the revenue derived from this source was something considerable. What better evidence of a State of the American Union engaging in trade, traffic, commerce, or business could be desired? Taking this fact in connection with the decisions of the Supreme Court of the United States cited in the brief, adding thereto the broad words and general terms of the act of March 3, 1881, which differs in so many particulars from the internal revenue act discussed in Georgia *v.* Atkins, the right of a State to register a trade-mark in the Patent Office is doubly clear.

While

> "To guard a title that was rich before,
> To gild refined gold, to paint the lily,
> To throw a perfume on the violet,
> To smooth the ice, or add another hue
> Unto the rainbow, or with taper-light
> To seek the beauteous eye of heaven to garnish,
> Is wasteful, and ridiculous excess."

it may still be well to say a word in regard to the interpretation of statutes.

In the case of The People *v.* The Utica Insurance Company, 15 Johnson (N. Y.), 358, the court, speaking by Mr. Chief Justice Thompson, says (p. 380):

"That, in construing a statute, the intention of the legislature is a fit and proper subject for inquiry, is too well settled to admit of dispute. That intention, however, is to be collected from the act itself, and other acts, *in pari materia*. It may not, however, be amiss to state, and keep in view, some of the established and well-settled rules on this subject.

"Such construction ought to be put upon the statute as may best answer the intention which the makers had in view. And this intention is sometimes to be collected from the cause or necessity of

making the statute, and sometimes from other circumstances; and, whenever such intention can be discovered, it ought to be
23 followed with reason and discretion in the construction of the statute, although such construction seem contrary to the letter of the statute. Where any words are obscure or doubtful, the intention of the legislature is to be resorted to in order to find the meaning of the word. A thing which is within the intention of the makers of a statute, is as much within the statute as if it were within the letter; and a thing which is within the letter of the statute, is not within the statute, unless it be within the intention of the makers. And such construction ought to be put upon it as does not suffer it to be eluded. * * * It was decided by this court, in the case of The Clinton Manufacturing Co. *v.* Morse, that under the act for the assessment and collection of taxes, corporations are liable to be taxed for property owned by them; yet the act speaks only of persons liable to be assessed, and the term corporation is not used at all. So, also, in England, a corporation seized of land in fee, for their own profit, are considered inhabitants or occupiers, within the meaning of the statute 43 Eliz., ch. 2, and liable, in their corporate capacity, to be rated for the poor tax (Rex *v.* Gardner, Cowp., 79). And Lord Coke, in his exposition of the statute 22 Hen. VIII, ch. 5, for the repair of bridges, commenting on the word inhabitants, with respect to what persons are included under that description, says, every corporation and body politic, having lands, &c., are inhabitants, within the purview of that statute (2 Inst., 703). If corporations can, under the term inhabitants or persons, be subjected to the same burthens to which individuals are subject in the same character they may also, very properly under the same term, be included within the prohibitions in the restraining act."

This learned opinion was delivered in a case in which the act incorporating the insurance company was considered in connection with a general statute prohibiting certain persons from engaging in the banking business, the insurance company having undertaken to engage in that business. The case is particularly strong in favor of the contention as to the construction of words made by the attorneys for the State in this case, inasmuch as the court in that case was speaking in relation to a prohibitory statute, whereas the statute which we are now discussing is an enabling act passed by the Congress of the United States for the express purpose of providing means whereby owners of trade-marks may, by complying with its provisions, obtain registration and protection for such marks.

If the Commissioner should wish to know whether the agents of the State, within the purview of their power as gathered from the "dispensary act" itself, are authorized to sell liquor to parties who do not reside within the limits of the State, let us turn to the act itself for information.

Section 2 provides for the appointment of a commissioner who shall reside at Columbia, who shall purchase all intoxicating liquors that shall be sold in the State, and who shall sell to the various county dispensers for sale. "He shall not sell to the county dis-

pensers any intoxicating or fermented liquors except such as have been tested by the chemist of the South Carolina college and declared to be pure and unadulterated." And, by the way, when the State commissioner ships to the county dispensers (sec. 3), it is to be in packages of not less than one-half pint, nor more than five gallons, and securely sealed; and it is unlawful for the county dispenser to break any such package or open the same for any reason whatever. He can sell by the package only, and the purchaser is not allowed to open the package on the premises.

24 "All rules and regulations (sec. 2) governing the said commissioner in the purchase of intoxicating liquors, or in the performance of any of the duties of his office, where the same are not provided for by law, shall be prescribed by a State board of control composed of the governor, the comptroller general, and the attorney general."

In section 2 it is also provided that "in all purchases or sales of intoxicating liquors made by said commissioner, the commissioner shall cause a certificate to be attached to each package containing said liquors when the same is shipped to him from the place of purchase, or by him to the county dispensers, certified by his official signature and seal, which certificate shall state that the liquors contained in said package have been purchased by him for sale within the State of South Carolina, or to be shipped out of the State, under the laws of the State, and without such certificate any package containing liquors which shall be brought into the State, or shipped out of the State, or shipped from place to place within the State, by any railroad, express company, or other common carrier, shall be regarded as intended for unlawful sale, and upon conviction thereof such common carrier shall be liable in a penalty of $500 for each offence, &c., &c."

These certificates attached to all packages of liquors constitute the authority, it will be observed, for common carriers to transport the article. Indeed, as will be seen from section 6, the manufacturers of liquor within the State, who are allowed to sell their product to no person within the State except the State commissioner, must have such certificate for the shipment of their product beyond the limits of the State; and without this certificate the liquor is liable to confiscation and the common carrier to punishment.

This certificate is in all cases, however, under the law of the State, a carte-blanche for the transportation of the liquor to which attached; and every package received and sold by a county dispenser has such a certificate attached; and section 2 also provides that "any person knowingly attaching or using such certificate without the authority of the commissioner, or any counterfeit certificate, for the purpose of securing the transportation of any intoxicating liquors into, out of, or within the State, in violation of law, shall, upon conviction thereof, be punished by a fine of not less than $500 and imprisonment, &c., &c." And a county dispenser, by the way, as will be seen by section 5, can procure his liquor from nobody but the State commissioner.

As to the duty of the county dispenser in the selling of liquor,

the part of his oath material to our present purpose is the following (in sec. 9):

"I will not sell or furnish intoxicating liquors to any person who is not known to me personally, or duly identified; nor to any minor, intoxicated person, or persons who are in the habit of becoming intoxicated."

It will be noticed that persons at a distance, if not known personally to the dispenser, are at liberty to identify themselves to him; and the written order for a sale required by section 11 can be made by another for them, as well as by themselves. No person obnoxious to the law as a purchaser of liquor, to wit, "a minor," "an intoxicated person" or a "person who is in the habit of becoming intoxicated," can appear in such order either as the party for whom the order is intended, or as the party filling it up and filing it for the other's use.

The restrictions above noted, applicable to all sales by county dispensers, contain no discrimination, it will be observed,
25 between residents and non-residents of the State. All that any person who wishes to purchase a brand of South Carolina whiskey needs to do, whether he be resident in that State, in Georgia, or in the Dominion of Canada, is to bring himself within the terms of the law, which is operative alike upon both residents and non-residents. It is as competent for a party a thousand miles away to make his purchase as the party who lives only twenty miles away, and who asks his next neighbor that happens to be going to town that day to bring him back a demijohn of "South Carolina Bourbon."

Section 11 provides what information shall be put into a request or order for liquor necessary to be filed with the dispenser; and section 19 provides a punishment for false or unauthorized statements in such orders.

The Commissioner is probably not concerned with the startling statements that time and again have been flashed before the *the* country, indicating that the South Carolina dispensary law was to be broken into smithers; that it had been decided unconstitutional by one of the ablest judges of the State; that it was a part of the "odious" Tillman legislation, etc., etc.; and we now refer to this aspect of the matter simply to meet a suggestion contained in the query, "Where will the Commissioner of Patents be, who admitted to registration a trade-mark that arose under an act which the courts have wiped from the statute books?"

Whether the law is to be of long or short duration; whether it is to be repealed by the legislature or declared obnoxious by the courts, is of little amount to him who, in these proceedings, is only concerned to know that the State is at present engaged in a trade wherein she has adopted a trade-mark and uses it. How long that trade will continue is of no interest to the registration of that trade-mark.

We are willing to be recorded, however, as saying that the law is in not the slightest danger of being overturned by the storms

which, according to some of the lurid dispatches furnished to the press of the country, are now brewing in the courts.

The law was attacked in the circuit court of the United States for the district of South Carolina in February last when a bill was filed by a couple of liquor venders of Charleston against Benj. R. Tillman, governor, and Wm. T. C. Bates, treasurer, to enjoin the carrying out of the law. The bill alleged the act to be in violation of the Constitution of the United States and also of the constitution of the State; and the further point was made in the case, the complainants being Italian subjects, that the act was in violation of certain treaty stipulations between Italy and the United States. The opinion of the court was delivered by Judge Simonton; it considers the act from all three of the standpoints above mentioned. This case, Cantini *et al. v.* Tillman *et al.*, is reported in 54 Fed. Rep., 969. Instead of quoting from it at this place, we simply refer to it as a masterly decision sufficient of itself to vindicate the constitutionality of the ground upon which the act rests.

And we will remark in passing that no man stands in higher repute as a lawyer and jurist among his fellows than Judge Simonton. At the time of his appointment to the bench, he was a most distinguished member of the Charleston bar, recognized as easily at the front of his profession, and hailed as a gentleman that would carry learning and ability of the highest order to the posttion he had assumed; and his decisions as a judge, distinguished for legal acumen and a sense of right, command always the highest respect.

26 But questions as to the constitutionality of the "dispensary act" have been considered by others than Judge Simonton. In May a couple of saloon-keepers in the town of Chester, South Carolina, applied to the supreme court of the State for a writ of mandamus upon the town council of Chester to require the council to issue to them the annual license, January 1, 1893, to December 31, 1893, the council, in the face of the dispensary law which was to go into operation July 1, 1893, having refused to issue licenses beyond June 30, 1893, as provided in the dispensary act. These proceedings (The State *ex rel.* W. H. Hoover *v.* The Town Council of Chester; and The State *ex rel.* Groeschel & Co. *v.* The Same) were intended to test the constitutionality of the act; and the court, on May 16, 1893, having waived the consideration of some technical and collateral questions in order to come to the main questions presented in the case, viz., the constitutionality of the passage of the act and of the prohibition therein of licenses for more than six months, filed its unanimous opinion on these points. The prayer of the petitioner was denied and their petition dismissed.

A few weeks ago one of the circuit judges of the State (Judge Hudson) having taken occasion to declare the act unconstitutional, a great "hue and cry" was at once set up, and the press of the country was fed with startling accounts of the disastrous failure of the "Tillman" liquor law. Two other circuit judges (Judge Gary and Judge Norton) have since that time had the same questions presented to them for adjudication, and their decisions have not been heralded before the country in press dispatches; they were of a dif-

ferent character from Judge Hudson's. Further, the decision of Judge Hudson was promptly superseded by one of the justices of the supreme court until the matter should be brought up for review by the higher court.

The foundations of the dispensary law are on bed rock, as determined by judicial assaying; and, if the superstructure, not yet perhaps fully tested, should be found in any part to be deficient, the workmen who laid the foundations are still on duty. The day of adulterated liquors has gone by in South Carolina, and the strong arm of the State has taken charge of the traffic in intoxicating beverages.

Now, Mr. Commissioner, in submitting the case to your hands, we really feel under some obligation to apologize to you for the extreme amplification of the points raised by this application and the somewhat lengthy discussion of them; but we were unwilling that the burden of rummaging libraries and dissecting opinions should fall upon you; and, besides, as the case was a new one, we felt that our duty to the applicant would not be properly performed with less than an exhaustive consideration of the matter. We examined the law of the subject before we filed the case and were certain of the complete right of the State to the registration of its trade-mark as presented. We have not multiplied words, we hope, at random, and, as the Commissioner is entitled to be convinced of the right and justice of every case presented to him, we have endeavored, in view of our double duty to him and to our client, to make the case as clear as possible.

The case is respectfully submitted to the Commissioner for his action in the premises.

JOHN ALTHEUS JOHNSON,
JAMES EDGAR SMITH,
Attorneys for the Applicant, The State of South Carolina.

27 EXHIBIT G. Filed September 11, 1893.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *August* 30, 1893.

In the Matter of the Application of THE STATE OF SOUTH CAROLINA. Trade-mark. Filed July 15, 1893. No. 44836. } Petition.

SIR: You are hereby informed that the above petition has been denied by the Commissioner. Please find enclosed herewith a copy of the decision.

By direction of the Commissioner.

Very respectfully,

S. E. DARBY,
Chief Clerk.

The State of South Carolina (c. o. Johnson & Smith), 408 5th St., city.

U. S. Patent Office. *Ex Parte* The State of South Carolina. Trade-mark for liquors, &c. Appeal from primary examiner.

Application filed July 15, 1893.

Messrs. Johnson & Smith for applicant.

Appeal is taken from the refusal of the examiner to register a trade-mark applied for in the name of the State of South Carolina, consisting of the word Palmetto, to be applied to bottles and other receptacles containing intoxicating liquors, by means of suitable labels upon which the trade-mark is to be printed, together with the arms of the State, the name of the liquor, and the words, "Warranted U. S. standard proof and chemically pure, South Carolina State dispensary, Columbia, S. C.," it being understood that all these words except Palmetto may be omitted, and that the various accessories of ornamentation and arrangement may be varied at pleasure, or altogether omitted.

It is the intention of the State officers that the State shall enter markets outside the State and outside the Union as a vendor of liquors for profit. As the present legislation of Congress on trade-marks is restricted to those used in commerce with foreign nations or with the Indian tribes, the authorities have sold a case of the State liquors bearing this trade-mark in Canada, and it is claimed that thus the trade-mark has been used by the State in commerce with foreign nations.

It also appears that the trade-mark was adopted on the 1st day of July, 1893, by the State board of control created by the act approved December 24, 1892.

It was claimed in argument that the State in this regard possesses the full rights of a trading corporation, and that it followed from the nature of a State that it might undertake a business of this character to be conducted outside as well as within its own limits, and that apart from its general powers authority was found in the provisions of its recent liquor legislation to enable the State to do this.

The examiner held otherwise, and therefore refused to register the trade-mark.

A State may become a partner in a commercial company, and when it does so" it divests itself, so far as concerns the transac-
28 tions of that company, of its sovereign character, and takes that of a private citizen. Instead of communicating to the company its privileges and its prerogatives, it descends to a level with those with whom it associates itself, and takes the character which belongs to its associates, and to the business which is to be transacted." (U. S. Bank *v.* Planters' Bank, 9 Wheaton, 904–907.)

If a State may be a member of a corporation it was urged that it might resolve itself into a trading corporation, in the particular intent proposed, without associates, while in other respects it retained the characteristics or essentials of a sovereign State.

The Republic of France enjoys the monopoly of the trade in tobaccos and tobacco products, it owns manufactories of powder, of arms, of matches, of tapestry, and of porcelain, among them the

celebrated manufactory of Sevres. Belgium manufactures guns for its own use as well as for sale in the markets of the world. Nor are state trade-marks unknown in foreign jurisprudence. An instructive passage occurs in an authority on trade-marks, Nouveau Traité des Marques de Fabrique et de Commerce, par Alexandre Braun, 1880, page 249:

"What of a state? The question whether a state is competent to claim its trade-mark as a producer or manufacturer has been presented repeatedly before our courts and tribunals and those of other countries. It has been decided in the affirmative. Why, indeed, if a state may engage in an industry, has it not, as every trader, in consideration of the performance of the usual formalities, the right to certify the origin of products coming from its manufactories? So the court of cassation has declared that the state of Belgium, inasmuch as it manufactures guns to arm the soldiery, ought to be considered as a regular manufacturer. (Cass. B., 5 mai, 1870, État belge c. Gerard, Ancion et Ce., P. B., 1870, I. 265.) What is to prevent, therefore, besides the official stamp, which attests that its arms have passed the board of approval, the impress of a mark showing that they are of its own make?

"It has been decided: 1°. That the French administration is properly allowed, in our (the Belgian) jurisdiction, the character of a private manufacturer, whose trade-mark is susceptible of protection on condition that the outward sign of its product (cigarettes) has been regularly registered at the registry of the tribunal of commerce in Brussels, in the same way as all other foreign producers. (Cass. B., 26 dec. 1876, Proc. génér., Spies et État français c. Kiss et consorts, P. B., 77, I, 54): 2°. That the usurpation or imitation of a trade-mark, such as that the French state places upon the cigarettes made and sold by it, falls within the application of the German law of November 30, 1874, especially when the registration of that mark has been regularly made and published conformably to that law (Trib. de 1re instance de Dresde, 3 mars 1877, État français c. Taenbrich, Pataille, 77, 199)."

Quoting by translation from the Dictionary of Industrial Property (trade-marks), by Maillard de Marafy, vol. 3, page 602:

"The state, as well as private individuals, may have to appeal, on its own account, to the laws concerning trade-marks, trade and proprietary names. The state possesses, indeed, generally, manufactories, forests, mineral springs, industrial monopolies of every kind, tobacco, powder, matches, &c. In like manner it may have to affix its seal to authenticate brands, guarantee the validity of licenses of enterprises granted by itself; in a word, to make demands or suits upon usurpations or counterfeits."

It seems that a State of the American Union, having all the powers of an independent sovereign State except those surrendered
29 to the Federal Government, has the inherent right as a State to engage in trade, domestic or foreign. Whether this may be done without limitation, or whether it may be done where it is necessary to invoke the power to tax, in order to provide the capital for embarking in trade, I do not now consider. Nor is it neces-

sary to discuss the implied limitation upon the executive, the legislative, and the judicial branches of the governments of the States laid down in a line of cases of which The Loan Association *vs.* Topeka (20 Wall., 655–663) is one. Nor is it necessary to point out how this might be done, if it may be done at all, or whether an express grant of power in the State constitution would be necessary or would be effectual to inaugurate such policy. It is certain that a lawful trade in liquors outside the State must be established in some effectual manner before the State can become the owner of a trade-mark which would be entitled to registration in its name in the Patent Office under the law of 1881.

The question now arises, Has the State of South Carolina taken upon itself the character of a trading corporation in intoxicating liquors outside its own limits or with foreign nations?

The application for this trade-mark is made by the governor in the name of the State, and the State legislation under which this action is taken is before me. Its significant title is, "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this State, except as herein provided."

A critical analysis of the act shows it to be a stringent measure of State regulation, within the State, of a traffic considered open to abuse in private hands. The comprehensive language of the first section definitively restricts the traffic within the limits laid down in the act. The State commissioner purchases the liquors and furnishes them to the county dispensers, to be sold as the act prescribes: "In all purchases or sales of intoxicating liquors made by said commissioner, as contemplated in this act, the commissioner shall cause a certificate to be attached to each and every package containing said liquors when the same is shipped to him from the place of purchase, or by him to the county dispensers, certified by his official signature and seal, which certificate shall state that the liquors contained in said package have been purchased by him for sale within the State of South Carolina, or to be shipped out of the State, under the laws of said State." (Part of section 2.)

The expression "to be shipped out of the State" evidently refers to the traffic, elsewhere permitted in the act, to manufacturers located within the State, who may sell outside the State, provided the certificate of the State commissioner is obtained and affixed to every package.

Section 18 appropriates the sum of fifty thousand dollars, if so much be necessary, for the purpose of purchasing and of supplying liquors to be distributed to county dispensers under the provisions of the act.

Every one of its minute provisions may be given its full and appropriate meaning by construing the whole act as a measure for the suppression of the liquor traffic in South Carolina by private individuals, and to substitute therefor its complete control by the State through local public dispensers. It is only by strained constructions that any phrases in the act may be held to look to the establishment of an outside traffic of any kind, excepting in the purchase of the liquors to be dispensed. Nor is there anything in

the general or special objects of the statute to show that the State intended to descend to the level of a trading corporation outside its own limits in and by the same public act whereby it prohibits both individuals and private corporations, and, by necessary construction, other States themselves, if they should attempt to act as private corporations in this particular, from entering for the purpose of this traffic the domain of South Carolina. If it should be held that the State could enter the field of commerce in traffic in intoxicating liquors outside its own limits, it must at the same time be held that the State has not done so in or by the legislation before me.

The State speaks by its constitution and public acts. Its law-making power, including within that term the power by which constitutions are made as well as laws, is alone the repository of the sovereign and governmental powers of the State. That power is alone competent to initiate and define the policy of the State. Neither the governor nor the State board of control provided for in this act can by any acts of theirs, even in the name of the State, take the State into trade.

The provisions of the trade-mark law of 1881 are that owners of trade-marks used in commerce with foreign nations, or with Indian tribes, may obtain registration, but the application must be accompanied by a declaration "to the effect that such party has at the time a right to the use of the trade-mark sought to be registered."

It is considered that the State of South Carolina, notwithstanding the acts of its governor and State board of control, has no authorized trade in liquors outside its own limits, is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered, and therefore the application is denied.

JOHN S. SEYMOUR,
Commissioner.

August 30, 1893.

EXHIBIT H. Filed September 11, 1893.

In the United States Patent Office. The State of South Carolina. Application for registration of trade-mark "Palmetto." Application filed July 15, 1893. Serial No., 44836. Appeal to the Commissioner.

Argument on the Rehearing of the Case.

The Commissioner having consented to reopen this case, the applicant, through its attorneys, will avail itself of the opportunity thus afforded to point out wherein it conceives the Commissioner to have erred in his decision herein, as shown by his written opinion filed August 30, 1893.

The Commissioner, reviewing partially the argument as made by the attorneys for the applicant, says:

"It seems that a State of the American Union, having all the powers of an independent sovereign State except those surrendered

to the Federal Government, has the inherent right as a State to engage in trade, domestic or foreign."

Correct. He then, after some statements not material to be here referred to, says: "The question now arises, has the State of South Carolina taken upon itself the character of a trading corporation in intoxicating liquors outside its own limits or with foreign nations;" and, for answer to this question, the Commissioner, looking to the dispensary act itself, under which the applicant has engaged in trade, assumes to examine it: and, as the result of such examination, to conclude that under it there can be no trade by the applicant with a foreign nation, a requisite to registration under the United States trade-mark statute. He notices that the very title of the act is "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this State, except as herein
31 provided;" he observes, after glancing through the act, that "every one of its minute provisions may be given its full and appropriate meaning by construing the whole act as a measure for the suppression of the liquor traffic in South Carolina by private individuals, and to substitute therefor its complete control by the State through local public dispensers. It is only by strained constructions that any phrases in the act may be held to look to the establishment of an outside traffic of any kind, except in the purchase of the liquors to be dispensed;" and his conclusion is:

"If it should be held that the State could enter the field of commerce in traffic in intoxicating liquors outside its own limits, it must at the same time be held that the State has not done so in or by the legislation before me."

True, "the legislation before the Commissioner," the dispensary act, undertakes to regulate the liquor traffic only within the State; the act does not assume to apply to anything to be done outside the limits of the State. No State probably would be absurd enough to enact a law designed to regulate the sale of intoxicating liquors as a beverage outside of its own limits. The State of South Carolina, by the dispensary act, legislated, and pretty effectively too, as to the sale of liquors within its borders; but it did not by the same act, nor has it by any other, fenced itself about with a Chinese wall of exclusion against foreigners; nor has it, by that act or any other, provided a line of defence on its frontiers with pickets to halt or shoot down indiscriminately every non-resident that shall approach in the way of commerce. Its position is simply that of any trader who will sell his goods to any proper person that wants to buy. The merchant whose place of business is at Charleston is not confined to the limits of the State for his custom. The facilities of the postal system and of the media of exchange, bank checks, drafts, &c., &c., enable him to trade with the four quarters of the globe, and still his place of business is within the State; all his sales are made within the State; and he may never go without the State. In the same way, because the State's place of business is within her own limits, and the article sold to be subject to certain restrictions, it does not follow that she or her agents can sell only to persons who live within her borders. If non-residents, whether living in Georgia,

Jamaica, or the Dominion of Canada, can bring themselves within the terms of the dispensary law, which is applicable alike to all who wish to buy, whether residents or non-residents, the State dispensers do not decline to sell; and such sales create the foreign trade that is requisite to the registry of a trade-mark under the United States statute.

If a State can sell at all, it can sell, like any other trader, to all persons whatsoever, without regard to the question whether they live within or without its boundaries.

But, as to this whole discussion concerning the dispensary act, the Commissioner overlooks the fact that in no sense is the legislation of the State of South Carolina before him for construction. He forgets that it is not his province to decide whether a State, under a particular act of its legislature, has lawfully entered the field of commerce in traffic in intoxicating liquors "outside its own limits," or, in the words of the statute, "with a foreign nation." These questions can arise and be settled only in the proper courts, and to such tribunals they must be left.

It is no more the province or prerogative of the Commissioner of Patents to determine the lawfulness of the trade in connection with which a trade-mark is used than it is of a simple recorder of deeds to investigate and pass upon the value or sufficiency of the muniment of title offered for record before he shall record it. True, the law providing for the record of deeds may say what character
32 of deeds shall be admitted to record and under what form, as to acknowledgment, or otherwise; but it does not thereby relegate to the recorder the determination of what shall go upon record and what shall not. The courts in the proper cases will take care as to the effect proper to be given to what has been recorded.

The function of the Commissioner is fulfilled when he decides "the presumptive lawfulness of claim to the alleged trade-mark." In the present case the propriety of "the alleged trade-mark" for use in connection with distilled liquors is not questioned; and the claim of the applicant to the alleged trade-mark is not disputed except by the Commissioner in the construction which he has assumed to put upon a statute of South Carolina. And even if the Commissioner's construction of the statute were correct, and the State had only a domestic trade confined to her own borders, she would still be the owner, at the common law, of the trade-mark under consideration, and capable of enforcing all her rights as such, without regard to the trade-mark statute of the United States which expressly reserves all rights as they exist, irrespective of the statute; consequently, if the State is trading at all, the claim (of the applicant) to the alleged trade-mark, that is, the ownership of the trade-mark, is undeniable. The papers on file in the case, that is, the application, are in the approved form; they show a proper trade-mark in connection with distilled liquors; they show such mark to be used in commerce with foreign nations; and they show the applicant to be the user and owner of such mark. Under these circum-

stances it is the plain duty of the Commissioner to give the registration that is asked for.

Having thus referred to the reason upon which the Commissioner bases his refusal to register the trade-mark of the applicant, viz., that the applicant, under the construction which the Commissioner is pleased to put upon the dispensary law of South Carolina, is not engaged in commerce with a foreign nation, being limited by the terms of the act to sales within its own borders, which means, to the mind of the Commissioner, sales to its own citizens, we wish now to take the liberty of referring to some expressions used by the Commissioner in the course of his opinion.

He says: "It is the intention of the State officers that the State shall enter markets outside the State and outside the Union as a vendor of liquors for profit. As the present legislation of Congress on trade-marks is restricted to those used in commerce with foreign nations or with the Indian tribes, the authorities have sold a case of the State liquors, bearing this trade-mark, in Canada, and it is claimed that thus the trade-mark has been used by the State in commerce with foreign nations."

The attorneys for the State do not know by what authority, or on what information, the Commissioner speaks as though but a single "case of the State liquors, bearing this trade-mark," had been sold in Canada. However, there is no question in the case as to the quantum of the trade with either Canada, the particular foreign nation specified in the application, or any other foreign nation; but while it is true that the State has established a trade with Canada, thereby bringing itself within the statute, it is not clear to the attorneys upon what ground the Commissioner was induced to allege the intention of the State officers. The fact that the State has a trade with a foreign nation has no connection that they can see with the intention of her officers. The trade-mark statute under which this application is made has no provision except as to actual trade; the intention to trade is not within its terms.

33 Nor is it clear to the attorneys by what right the Commissioner assumes to make the statement that "neither the governor nor the State board of control provided for in this act can by any acts of theirs, even in the name of the State, take the State into trade." In the pending application, the chief magistrate of the State, who is also her ranking representative on the board of control which she created by the dispensary act, sets forth, in the manner required by the trade-mark law, what the State has done; and it does not lie in the mouth of the Commissioner of Patents, when thus requested to record a trade-mark presented for registration, to pass criticisms upon the official conduct of the State's representatives and agents. He is not authorized to sit in judgment upon the State officers, to divine their intentions or prescribe their duty under the dispensary law. They acknowledge no amenability to the Commissioner of Patents, and they repudiate any attempt on his part to pass judgment upon their official acts.

If the Commissioner of Patents will have regard to those points only which are properly before him in this application, and upon

which the solution of the case depends, we are fully persuaded that, in justice to himself, not less than to the applicant, he will not only reconsider, but reverse his decision of August 30, and admit the trade-mark of the applicant to the registration provided in the act of Congress of March 3, 1881.

JOHN ALTHEUS JOHNSON,
JAMES EDGAR SMITH,
Attorneys for Applicant, The State of South Carolina.

EXHIBIT I. Filed September 11, 1893.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Sept.* 6, 1893.

In the Matter of the Application of THE STATE OF SOUTH CAROLINA. Trade-mark. Filed July 15, 1893. } Request for Reconsideration.

SIR: You are hereby informed that the motion for reargument on the above-entitled case has been denied by the Commissioner.

By direction of the Commissioner.

Very respectfully, JNO. W. FROST,
Acting Chief Clerk.

The State of South Carolina (care Johnson & Smith), No. 408 Fifth St. N. W., city.

Rule to Show Cause. Filed September 11, 1893.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner,
vs.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent. } No. 34714. At Law.

Upon reading the petition for mandamus in the above-entitled cause, and considering the same, it is ordered, this 11th day
34 of September, 1893, that the respondent, John S. Seymour, Commissioner of Patents, show cause, on Tuesday, the 19th instant, at 10 o'clock a. m., before me at the special term of this court, why the said writ should not issue as prayed by the petitioner; provided a copy of this order and of the petition be served upon the said respondent on or before the 14th instant.

A. C. BRADLEY, *Justice.*

Marshal's Return.

Served copy of the within order and petition filed therewith on the within-named John S. Seymour, Commissioner of Patents, Sept. 12, 1893.

D. M. RANSDELL, *Marshal.*

Demurrer. Filed September 19, 1893.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *Ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner,
vs.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent. } At Law. No. 34714.

The respondent says that the petition is bad in substance.

JOHN I. HALL.
LEVIN H. CAMPBELL.
Attorneys for Respondent.

The respondent notes the following matters to be argued in particular, to wit:

NOTE 1.—The trade-mark law referred to in the petition makes the Commissioner of Patents in an application for registration of a trade-mark the sole and final judge as to the presumptive lawfulness of claims to the alleged mark, and this court cannot interefere by mandamus to direct, control, and command his judgment therein.

NOTE 2.—One of the matters is that under the law referred to in the petition, to wit, the act to authorize the registration of trade-marks and protect the same, approved March 3, 1881, the duty of the respondent, The Commissioner of Patents, thereunder, in deciding the presumptive lawfulness of claim to an alleged trade-mark on application for its registration, is wholly discretionary and not ministerial at all, and the petition showing that such discretionary duty has been performed by the herein respondent, the Commissioner of Patents, mandamus will not lie.

NOTE 3.—Another matter to be argued is that the trade-mark law referred to in the petition, makes the decision of the Commissioner of Patents, on an application for registration of a trade-mark, final and conclusive as to the presumptive lawfulness of claim to an alleged trade-mark, and consequently a command of this court requiring the Commissioner of Patents to register a trade-mark on an application therefor, after an adverse decision thereon by him, would in purpose and effect be to overrule and supplant the decision of the Commissioner of Patents in such matter and to substitute therefor a decision of this court as to the presumptive lawfulness of claim to the mark, a result not contemplated nor provided for by the act in question, but on the contrary prohibited by the plain wording and meaning of the act.

35 NOTE 4.—Another matter is that, it appearing affirmatively from the said petition that the respondent, The Commissioner of Patents, has as a matter of fact and in accordance with his judgment in and under the trade-mark law, referred to in the petition, decided the presumptive lawfulness of claim to the alleged trade-mark "palmetto," on the application for registration therefor by

the relator, and adversely to relator, this court has not jurisdiction to command the respondent, The Commissioner of Patents, to register the said trade-mark to the relator; nor to require the respondent to show cause why he has not registered and refuses to register the said trade-mark to the said relator.

NOTE 5.—Another matter is that the petition shows, not that the respondent has refused and continues to refuse to perform a discretionary duty, to wit, to decide upon the application by relator for the registration of the mark the presumptive lawfulness of its claim to the alleged trade-mark, required of him under and by virtue of the trade-mark law, referred to in the petition, but, on the contrary, the petition shows that the respondent has decided the presumptive lawfulness of claim to the alleged trade-mark, but decided it adversely to the relator, and that he, the respondent, has declined and continues to decline to decide such presumptive lawfulness of claim to the trade-mark in question in favor of the relator, and also refuses to decide it in favor of relator in accordance with a certain construction put upon the trade-mark law by the relator, as set forth and referred to in the petition.

JOHN I. HALL,
LEVIN H. CAMPBELL,
Attorneys for Respondent.

Proceedings before the supreme court of the District of Columbia, holding a circuit court (division number one), and special term in and for said District, commencing the first Tuesday, it being the 3d day of October, A. D. 1893.

TUESDAY, *October 3d*, A. D. 1893.

By order of Honorable A. C. Bradley, justice, one of the justices of said supreme court, presiding, the court is opened by proclamation of the marshal, pursuant to rule of court.

* * * * * * *

Order Overruling Demurrer, &c.

THE UNITED STATES *Ex Rel.* THE STATE OF SOUTH CAROLINA, Petitioner, *vs.* JOHN S. SEYMOUR, Commissioner of Patents, Respondent.	At Law.	No. 34714.

This cause coming on to be heard upon the rule to show cause herein issued, the petition, with its exhibits, and the demurrer thereto filed, and the same having been argued by counsel, it is thereupon, upon consideration by the court, ordered and adjudged this 3d day of October, A. D. 1893, that the said demurrer be, and the same hereby is, overruled; and it is also further ordered that an alternative writ of mandamus issue to the respondent, John S. Seymour, Commissioner of Patents, as prayed in the said petition,

commanding him to register, as provided in the act of Con-
36 gress of March 3, 1881 (21 Stat. at L., 502), the trade-mark of the petitioner, The State of South Carolina, the said writ to be returnable on Saturday, the 7th instant, at ten o'clock a. m.

A. C. BRADLEY, *Justice.*

Alternative Writ of Mandamus.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *Ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner, *vs.* JOHN S. SEYMOUR, Commissioner of Patents, Respondent.	No. 34714. At Law.

The President of the United States to the respondent, John S. Seymour, Commissioner of Patents, Greeting:

The demurrer to the petition, in your behalf interposed, having been by the court overruled, you are hereby commanded to register in the United States Patent Office the trade-mark of the petitioner, The State South of Carolina, the essential feature of which is the word "palmetto", as used in connection with chemically pure distilled liquors, as described in the application heretofore filed in the United States Patent Office and prayed in the petition filed herein, as provided in the act of Congress approved March 3, 1881, entitled "An act to authorize the registration of trade-marks and protect the same;" or in default thereof that you appear before said supreme court of the District of Columbia and show cause on Saturday, the 7th day of October, A. D. 1893, at 10 o'clock a. m., why you refuse so to do.

Witness the Honorable Edward F. Bingham, chief justice of said court, this 4th day of October, A. D. 1893.

[SEAL.] JOHN R. YOUNG, *Clerk.*

Marshal's Return.

Served copy of the within writ on S. T. Fisher, acting Commissioner of Patents, Oct. 4, 1893.

D. M. RANSDELL, *Marshal.*

Return of Respondent to Alternative Writ of Mandamus. Filed October 7, 1893.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *Ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner, *vs.* JOHN S. SEYMOUR, Commissioner of Patents, Respondent.	At Law. No. 34714.

Respondent's Answer.

The respondent, John S. Seymour, Commissioner of Patents, respectfully makes return to the alternative writ of the honorable the supreme court of the District of Columbia, made in the above-
37 entitled case, commanding him to register a trade-mark as petitioned for in the petition, or in default thereof to appear before the said supreme court to show cause why he refuses so to do:

1. The respondent admits a knowledge of the act of the General Assembly of the State of South Carolina, approved by its governor, December 24, 1892, and entitled "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this State, except as herein provided," a copy of which act is hereto attached and made a part of his answer herein, but the respondent denies that under and by virtue of said act, or in any other way, so far as he has information and belief, that the petitioner, The State of South Carolina, was engaged in commerce with foreign nations or with Indian tribes at the time of its application for the registration of the said alleged trade-mark, and denies that the State of South Carolina was the owners of the said alleged trade-mark used in commerce with foreign nations or with the Indian tribes at the time of its application for the registration of the said alleged trade-mark, under the Federal trade-mark law, in connection with liquors dispensed or to be dispensed under the said act of its General Assembly.

2. As to the second paragraph of the petition, the respondent states that he has no knowledge as to the truth or falsity of its allegations, other than as will appear by the record herein.

3. As to the averments of the third paragraph of the petition, respondent admits the filing of an application by relator for a certificate of registration of a trade-mark and of payment of the fee of twenty-five dollars ($25.00) into the Treasury of the United States, and its statement and declaration, as required by the trade-mark act of March 3, 1881, but denies that the relator thereby complied with all the provisions of the said trade-mark law, in that the relator was not the owner of the trade-mark used in commerce with foreign nations or with Indian tribes.

4. As to the statements in the fourth paragraph, the respondent denies (a) that the alleged trade-mark could be used by the relator in foreign commerce, for the reason that a State acts through its officers, its agents. The agent designated by the State of South Car-

olina to purchase and sell liquors is "a commissioner," provided for by the act. His authority is limited to purchases and sales within the State, and the State, through its agent, cannot use nor become, by the illegal action of its agent, the owner of the alleged trade-mark in commerce with foreign nations or Indian tribes, and therefore the relator is not the owner of the alleged trade-mark used in commerce with foreign nations or with the Indian tribes, within the meaning of the trade-mark law, the State of South Carolina not being engaged in commerce with foreign natiens or with the Indian tribes; (b) the respondent denies that the trade-mark "is altogether lawful and the claim of the petitioner thereto is altogether just and legal, and the plain duty of the Commissioner of Patents in the premises is to register the said trade-mark, thus admitting the petitioner, as the owner of the said mark, to the benefits of the trade-mark statute aforesaid" (the act of March 8, 1881). (c) As to the other allegations in the fourth paragraph, the respondent admits their truth.

5. As to the allegations of the fifth paragraph, the respondent admits that he has refused and still continues to refuse to register the trade-mark in the petition mentioned, because under the trade-mark law it is his duty to decide the ownership of petitioner to the alleged trade-mark, as used in commerce with foreign nations or with
38 Indian tribes, and he, the respondent, has, upon a just and thorough examination of the application for the registration of the alleged trade-mark, in his sound judgment and discretion, decided adversely to the registration of the alleged trade-mark, because the State of South Carolina is not the owner of the alleged trade-mark used in commerce with foreign nations or with the Indian tribes. The respondent denies that by his refusal to register the alleged trade-mark he thereby denied to the petitioner a plain right. He denies further that the petitioner was at the time of the refusal to register its alleged trade-mark, or at this hour, so far as the respondent knows, the owner of a trade-mark used in commerce with foreign nations or with Indian tribes. As to the remaining statements in the fifth paragraph, the respondent neither affirms nor denies them, but puts the petitioner to their proof.

The respondent, for further answer, denies that the petitioner was at the time of its application for the registration nor since, so far as the respondent is aware, entitled to have its alleged trade-mark registered under the Federal trade-mark law.

The respondent, further answering, denies that this court has jurisdiction to compel the respondent to register the alleged trade-mark to the relator, because the decision, whether said alleged trade-mark can lawfully be registered or not, and whether the applicant is the owner of the said alleged trade-mark, *i. e.*, a trade-mark used in commerce with foreign nations or with Indian tribes, involves discretionary duties upon the part of him, the respondent.

The respondent, for further answer, states that under paragraph two, section one, of the trade-mark act of 1881, he is authorized to prescribe regulations for the conduct of proceedings in the Patent Office, and in pursuance of such authority he established and pro-

mulgated rules, designed to be in strict accordance with the provisions of the Federal trade-mark law for the proceedings before the Patent Office for the registration of trade-marks under the Federal trade-mark act of March 3, 1881, a copy of said rules being hereto attached and made a part of this answer.

The respondent, for further answer, states that if the act of registration which he is required to perform under the trade-mark law were solely ministerial and such as this court might compel him to perform, it is yet submitted that, upon the merits of petitioner's case, the relator is not entitled to the relief prayed for. The State of South Carolina is not the owner of a trade-mark used in commerce with foreign nations or with the Indian tribes, and consequently not entitled to have the alleged trade-mark registered.

Wherefore your respondent prays the judgment of your honor whether this court has jurisdiction in the premises, and, if so, whether the facts in the case as contained in the record and the law in the pleadings show a right in the relator to have a writ of mandamus in its behalf as prayed for, and that he be hence dismissed.

JOHN S. SEYMOUR,
Commissioner of Patents,
By JOHN I. HALL AND
LEVIN H. CAMPBELL,
His Attorneys.

39 RULES AND FORMS ADOPTED BY THE UNITED STATES PATENT OFFICE FOR THE REGISTRATION OF TRADE-MARKS UNDER THE ACT OF MARCH 3, 1881.

UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *January* 4, 1892.

The following regulations, designed to be in strict accordance with the provisions of the act of March 3, 1881, for the registration of trade-marks, are published for gratuitious distribution.

Applicants for registration and their attorneys are advised that their business will be facilitated by the observance as closely as possible of the appended forms.

W. E. SIMONDS,
Commissioner of Patents.

Who May Obtain Registration.

1. (*a*) Any person, firm, or corporation domiciled in the United States or located in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States,* and who is entitled to the exclusive use of any trade-mark and uses the same in commerce with foreign nations or with Indian tribes.

(*b*) Any citizen or resident of this country wishing the protection of his trade-mark in any foreign country the laws of which require registration in the United States as a condition precedent.

* For a list of the countries having treaties with the United States at this time see page 20.

Statutory Requirements.

2. Every applicant for registration of a trade-mark must cause to be recorded in the Patent Office—

(*a*) The name, domicile, and place of business or location of the firm or corporation desiring the protection of the trade-mark, and the residence and citizenship of individual applicants.

(*b*) The class of merchandise and the particular description of goods comprised in such class to which the trade-mark has been appropriated.

(*c*) A description of the trade-mark itself, with fac-similes thereof, and the mode in which it has been applied and used.

(*d*) The length of time during which the trade-mark has been used by the applicant on the class of goods described.

3. A fee of $25 is required on filing each application, except in the cases hereinafter named. (See pars. 17 and 18.)

The Application.

4. An application for the registration of a trade-mark will consist of a statement or specification, a declaration or oath, and the fac-simile with duplicates thereof. The statement and declaration should be written on one side of the paper only.

5. These should be preceded by a brief letter of advice requesting registration and signed by the applicant.

6. The statement should announce the full name, citizenship, domicile, residence, and place of business of the applicant (or, if the applicant be a corporation, under the laws of what State or nation incorporated), with a full and clear specification of the trade-mark, particularly discriminating between its essential and non-essential features. It should also state from what time the trade-mark has been used by the applicant, the class of merchandise, and the particular goods comprised in such class to which the trade-mark is appropriated, and the manner in which the trade-mark has been applied to the goods. (See form, p. 13.)

7. The declaration should be in the form of an oath, by the person, or by a member of the firm, or by an officer of the corporation, making the application, to the effect that the party has at the time of filing his application a right to the use of the trade-mark described in the statement; that no other person, firm, or corporation has a right to such use, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in lawful commerce with foreign nations or Indian tribes, one or more of which should be particularly named; and that it is truly represented in the fac-simile presented for registry. (See form, p. 14.)

8. This oath may be taken within the United States before a notary public, justice of the peace, or the judge or clerk of any court of record. In any foreign country it may be taken before the secretary of a legation or consular officer of the United States, or before any person duly qualified by the laws of the country to administer

oaths, whose official character shall be certified by a representative of the United States having an official seal.*

Fac-similes to be Filed.

9. An applicant for registration of a trade-mark must in every case, which admits of it, furnish a drawing thereof which conforms to the rules for drawings of mechanical patents. If for any
41 reason such drawing does not constitute a satisfactory fac-simile of the trade-mark, two copies of the trade-mark, as actually used, must be deposited in addition to the required drawing, to be preserved in the office for reference.

Proceedings in the Office.

10. All applications for registration are considered in the first instance by the trade-mark examiner. An adverse decision by such examiner upon the applicant's right to registration will be reviewed by the Commissioner in person upon petition without fee.

11. No trade-mark will be registered unless it shall be made to appear that the same is used as such by the applicant in commerce between the United States and some foreign nation or Indian tribe, or is within the provisions of a treaty, convention, or declaration with a foreign power, nor which is merely the name of the applicant, nor which is identical with a known or registered trade-mark owned by another and appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion in the mind of the public or to deceive purchasers, or which is merely descriptive in its nature.

12. The statement may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination; but no amendments will be admitted unless warranted by something in the statement or fac-simile as originally filed. In respect to amendments the established rules in regard to applications for patents will be observed.† The declaration cannot be amended. If that filed with the application is faulty or defective, a substitute declaration may be filed.

13. In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties may have an opportunity to prove priority of adoption or right; and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents; but each applicant and registrant will be held to the date of adoption alleged in the statement filed with his application. On the petition of any party dissatisfied with the decision of the examiner of interferences the case will be reviewed by the Commissioner without fee.

14. When these requirements have been complied with, and the

* See Appendix, rule 46.
† See Appendix, par. 71 *et seq.*

office has adjudged the trade-mark lawfully registrable, a certificate will be issued by the Commissioner, under seal of the Interior Department, to the effect that applicant has complied with the law, and that he is entitled to the protection of his trade-mark in such case made and provided. Attached to the certificate will be a fac-simile of the trade-mark and a printed copy of the statement and declaration.

42 15. The protection for such trade-mark will remain in force for thirty years, and may, upon the payment of a second fee, be renewed for thirty years longer, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it will cease to have force in this country, by virtue of the registration, at the same time that the trade-mark ceases to be exclusive property elsewhere.

16. The right to the use of any trade-mark is assignable by an instrument in writing, and provision is made for recording such instrument in the Patent Office. But no such instrument or conveyance will be recorded unless the trade-mark shall have first been registered as provdied by law; and it must be identified by its certificate number. No particular form of instrument is prescribed.

17. Owners of trade-marks for which protection has been sought by registering them in the Patent Office under the act of July 8, 1870 (declared unconstitutional by the Supreme Court of the United States,) may register the same for the same goods, without fee, on compliance with the foregoing requirements. With each application of this character a specific reference to the date and number of the former certificate is required.

18. Applicants whose cases were filed under the act of 1870, either prior to or since the decision of the Supreme Court declaring it unconstitutional, which are now pending before the office, are advised to prepare applications in conformity with the law and foregoing rules. On the receipt of such an application, referring to the date of the one formerly filed, all fees paid thereon will be duly applied. Those who have paid only $10 as a first fee are advised that the law does not provide for a division of the legal fee of $25, and that the remainder of the entire fee is required before the application can be entertained.

Copies and Publications.

19. Printed copies of the statement and declaration in each case, with a duplicate of the trade-mark, can be furnished by the office.

The Official Gazette of the Patent Office will contain a list of all trade-marks registered, with the name and address of the registrant, an illustration of the trade-mark, a brief statement of its essential features, and the particular description of goods to which it is applied.

Fees.

20. On filing an application for registration of a trade-mark	$25 00
For abstracts of title:	
For the certificate of search	1 00
For each brief from the digests of assignments	20
For copies of matter in any foreign language, for every 100 words or fraction thereof	10
43 For translation, for every 100 words or fraction thereof	50
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or under	1 00
For recording every assignment, agreement, power of attorney, or other paper of over 300 words and under 1,000 words	2 00
For recording every assignment, agreement, power of attorney, or other paper of over 1,000 words	3 00
For assistance to attorneys and others in the examination of records, one hour or less	50
Each additional hour or fraction thereof	50
For single printed copy of statement and declaration	10
If certified, for the certificate, additional	25
Single copy of Official Gazette	10
Annual subscription Official Gazette	5 00

Correspondence.

21. All letters should be addressed to "The Commissioner of Patents;" and all remittances by postal order, check, or draft should be to his order.

22. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relating to registered trade-marks must refer to the name of registrant, number or date of certificate, and the class of merchandise to which the trade-mark is applied.

23. The office cannot undertake to respond to inquiries propounded with a view to ascertain whether certain trade-marks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed. A copy of these rules with this paragraph marked will be regarded as a courteous answer to all such inquiries.

44 FORMS.

The following forms illustrate the manner of preparing papers for applications for registration of trade-marks. Their use is not absolutely required, but as they have been made to conform to the conditions of the law, applicants will find their business facilitated by following them closely:

(1) *Letter of Advice.*

To the Commissioner of Patents:

The undersigned presents herewith a fac-simile of his lawful trade-mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office in accordance with the law in such cases made and provided.

A. B.

(2) *Statement by an Individual.*

To all whom it may concern:

Be it known that I, A. B., a citizen of the United States, residing at Baltimore, Maryland, and doing business at No. — —— St., in said city, have adopted for my use a trade-mark for whisky, of which the following is a full, clear, and exact specification:

My trade-mark consists of the word-symbol Moonshine. This has generally been arranged as shown in the accompanying fac-simile, which represents a rude still-house surrounded by hills and forests. Three men are engaged variously about, and the scene is illuminated partly by the light of the fire, partly by the moon, which appears in the heavens. Underneath the picture appears the word "Moonshine" in ornamental letters; but the style of lettering is unimportant, and the entire picture may be omitted or changed at pleasure without materially affecting the character of my trade-mark, the essential feature of which is the word-symbol Moonshine.

This trade-mark I have used continuously in my business since July 4, 1876. The class of merchandise to which this trade-mark is appropriated is distilled liquors, and the particular description of goods comprised in said class upon which I use it is whisky. It is my practice to apply my trade-mark to the bottles containing the liquor by means of suitable labels, on which it is printed in color, as above described. The word is sometimes also blown into the bottles.

A. B.

Witnesses:
C. D.
E. F.

45 (3) *Statement by a Firm.*

To all whom it may concern:

Be it known that we, C. D. & Co., a firm domiciled in Brooklyn, Kings county, State of New York, and doing business at No. — —— St., in said city, have adopted for our use a trade-mark for men's overalls, of which the following is a full, clear, and exact specification:

Our trade-mark consists of the arbitrary word Teuton. This has generally been arranged as shown in the accompanying fac-simile, in which it appears in plain block capitals, printed in black, in a hor-

izontal line. But other forms of type may be employed, or it may be differently arranged or colored, without materially altering the character of our trade-mark, the essential feature of which is the word Teuton.

The trade-mark has been used continuously in business by us and those from which we derive our title since July 11, 1840.

This class of merchandise to which this trade-mark is appropriated is wearing apparel, and the particular description of goods comprised in such class on which it is used by us is men's overalls. It has been our practice to mark our trade-mark on the inside of the waistband of the goods with a stencil, or to print it upon tags which are secured to the goods in any desired manner. C. D. & CO.

Witnesses:

D. E.

F. G.

(4) *Statement by a Corporation.*

To all whom it may concern:

Be it known that the Rocky Mountain Mill Company, a corporation organized under the laws of the State of South Dakota, and located in the city of Garfield, Hancock county, in said State, and doing business in said city of Garfield, and also at Chicago, Illinois, has adopted for its use a trade-mark for wheat flour, of which the following is a full, clear, and exact specification:

The trade-mark of said company consists of a representation of a Rocky Mountain sheep and the words Big Horn. These have generally been arranged as shown in the accompanying fac-simile, in which the animal named, popularly known as the "Big Horn," is represented in an erect attitude upon a cliff or rock. In the background are mountains covered with forests, with distant white peaks; upon the sky portion are the words Big Horn, and arranged in a circle about the whole are the words Rocky Mountain Mill Company in plain capital letters. But these words may be omitted, and the various accessories of the picture may be varied at pleasure, or altogether omitted, without materially altering the character of the said trade-mark, the essential features of which are the words Big Horn and the representation of a Rocky Mountain sheep.

This trade-mark has been continuously used by said corporation since about the middle of October, 1884.

The class of merchandise to which this trade-mark is appropriated is flour, and the particular description of goods comprised in such class on which it is used by the said company is wheat
46 flour. It is usually affixed to the goods by printing it on the bags, or stenciling it on the heads of barrels in which the flour is packed. ROCKY MOUNTAIN MILL COMPANY,

By G. F., *President.*

Witnesses:*

J. H.

L. K.

* If the corporation have a seal it may be used to authenticate the signature of the officer.

(5) *Declaration.*

STATE OF ——, }
County of ——, } *ss:*

A. B., being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that he has at this time a right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that it is used by him in commerce between the United States and foreign nations or Indian tribes, and particularly with —— —— (here name one or more foreign nations or Indian tribes, or both, as the case may be;) and that the description and fac-similes presented for record truly represent the trade-mark sought to be registered.

A. B.

Sworn and subscribed before me, a ——, this — day of ——, 18—.

G. H., *J. P.*

If the application is made by a firm or corporation, this declaration should be modified accordingly. Thus—

For a Firm.

A. B., being duly sworn, deposes and says that he is a member of the firm, the applicant named, etc.; * * * that the trade-mark is used by the said firm in commerce, etc.

For a Corporation.

A. B., being duly sworn, deposes and says that he is secretary (or other officer) of the corporation, the applicant named in the foregoing statement, etc.; * * * that the trade-mark is used by said corporation in commerce, etc.

(6) *Amendment.*

To the Commissioner of Patents:

In the matter of my application for registration of trade-mark for watches, No. 5319, filed June 11, 1876, I desire to amend my statement as follows:

Page 1, line 16, cancel the words "the arbitrary word zenith," and insert in the place thereof the following: The representation of a five-pointed star, having the word zenith printed across its face.

Same page, line 20, erase "about four years" and insert since July 1st, 1872.

A. B.
By P. & Q.,
His Attorneys.

Dated Geneva, Switzerland, October 1, 1876.

47 *Motion to Quash, &c. Filed October* 9, 1893.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner,
vs.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent.
} At Law. No. 34714.

Now comes the relator, by its attorneys, and moves the court to quash the return made to the alternative writ herein issued, and direct the issuance of a peremptory writ, the said return being insufficient to justify the want of compliance with the mandatory part of the said alternative writ.

The grounds of this motion are the following, among others:

1. The said return sets up no fact inconsistent with the allegations of the petition, to which it is in answer, except as the same is sought to be deduced by construction of law, thus raising no issue different from those already disposed of on consideration of the demurrer which was interposed to the said petition in answer to the rule to show cause that was herein issued.

2. It is not competent for the respondent to set up in said return (so as to make an issue thereon for trial by this court, if such he has attempted) that the relator, by its officers and agents, has not, as a matter of fact, used its trade-mark aforesaid in commerce with foreign nations:

(*a*) Because the record herein, to wit, the official opinion of the respondent, shows that the express ground of the respondent's refusal to register was the inability of its officers and agents to take it (the relator) into foreign trade, the said inability resulting, according to said opinion, from the terms and provisions of the law under which the relator claimed to be engaged in trade;

(*b*) Because the said record, to wit, the official opinion aforesaid, expressly states and admits that one case of relator's liquors were sold in Canada by the agents of the relator, and no demand or request was made by the respondent upon the relator to show a larger sale in the way of foreign commerce; and, the said opinion showing that the respondent based his action upon the construction of a statute, thereby waiving inquiry or proof in regard to foreign sales, if any he was authorized to make in regard thereto outside or beyond the legal declaration required of relator by the trade-mark law, it is now too late for him to seek to ascertain the quantum of relator's foreign trade;

(*c*) Because it is apparent from the reading of the return aforesaid that the respondent's denial of a foreign trade to the relator is made as the result of a construction put by the respondent upon the statute under which the relator is engaged in trade;

(*d*) And because the return does not set up that the refusal of the respondent to register was the result of an insufficient foreign trade,

but of an utter absence of such trade; and such contention, in the full light of the record, amounts but to an insistance by the respondent that this court by entertaining these proceedings is permitting a ratification of acts which, according to the peculiar nopplicant of the respondent, are *ultra vires* and which he (the resp es that the does not think ought to be approved in any such w right to the
48 3. No material fact alleged in the petition is der person, firm, return except as the denial is a matter resting upon ertical form tion of law.

4. No fact (apart from legal construction) is alleged in said return, the existence of which, if established, would defeat the relator's right to the relief herein sought.

THE STATE OF SOUTH CAROLINA, *Relator*,
By JOHN ALTHEUS JOHNSON,
JAMES EDGAR SMITH,
Its Attorneys.

MONDAY, *October* 23, *A. D.* 1893.

Session resumed pursuant to adjournment, Bradley, justice, presiding.

Order Quashing Return, &c.

THE UNITED STATES *ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner,
vs.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent.
} At Law. No. 34714.

This cause coming on to be further heard upon the return herein filed to the alternative writ that was herein issued, and the motion to quash the said return and issue a peremptory writ, and the same having been argued by counsel,

It is thereupon, upon consideration by the court, ordered, this 23d day of October, A. D. 1893, that the said motion to quash be, and the same hereby is, granted; and it is also further ordered, adjudged, and decreed that the relator is entitled to the registration at the Patent Office of the United States of its trade-mark, according to the statement and declaration now on file in the said office and set forth and exhibited in the petition herein, to wit, the word "Palmetto" as used in connection with chemically pure distilled liquors.

And the clerk of this court is hereby directed to issue a peremptory writ of mandamus to the respondent, John S. Seymour, Commissioner of Patents, commanding him to register the said trade-mark of the relator in conformity with the act of Congress approved March 3, 1881, entitled "An act to authorize the registration of trade-marks and protect the same," and to make return to the office of the clerk of this court within twenty (20) days from this day showing that he, the Commissioner aforesaid, has in all respects obeyed the commands of the said writ.

A. C. BRADLEY, *Justice.*

Opinion of Justice Bradley.

Supreme Court of the District of Columbia.

UNITED STATES *ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner,
v.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent.

The relator, The State of South Carolina, has filed its petition in this matter, praying a writ of mandamus directing John S.
49 Seymour, the Commissioner of Patents, to register a certain trade-mark which is fully described in the petition. Upon filing the petition, a rule to show cause was granted, and, upon the return day, the respondent filed his demurrer setting up as the principal ground thereof the claim that, by the petition, it appears that the act of the Commissioner, which is sought to be compelled by this proceeding, was one involving judgment and discretion, and therefore not the subject of mandamus.

The petition, in addition to the statement of the facts upon which the relator bases its claim to relief, refers to and makes a part of it the various acts of the Patent Office in relation to its application for registration from the time it was filed, including the reason given by the principal examiner for rejecting the application, and the opinion of the Commissioner of Patents given at the time of his final rejection.

The petition, in its fourth paragraph, alleges that—

"The trade-mark aforesaid is lawfully used as such by the petitioner in foreign commerce; it is not merely the name of the petitioner; it is not identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, and it does not so nearly resemble any other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; there is no dispute between the petitioner and any previous registrant of a trade-mark, or any applicant for registration; but the trade-mark of the petitioner aforesaid is altogether lawful, and the claim of the petitioner thereto, as owner and user thereof, is altogether just and legal; and the plain duty of the Commissioner of Patents in the premises is to register the said trade-mark."

The demurrer was overruled, and an alternative writ of mandamus granted. To that writ the respondent has made answer.

The peculiar character of the answer and the apparent argumentative confusion of matters of fact with matters of law render it necessary to take it, by sections, and compare it with the petition to ascertain what is admitted and what is denied.

The petition, in its first paragraph, alleges that by virtue of an act of its General Assembly, approved December 24th, 1892, the State of South Carolina had assumed control of, and was then and is now, by virtue of said act, engaged in a traffic in intoxicating

liquors; that it had since July 1, 1893, bought and sold and otherwise handled in the way of trade certain kinds of pure and unadulterated liquors, and that, in connection with the sale of such liquors, it had adopted a certain trade-mark, and had thereby becat the owner of said trade-mark, as used in connection with such li the

The respondent, in answer to that paragraph, admits a kn to the of the act of the assembly of the State of South Carolina, firm, to, but denies that under and by virtue of that act the State of South Carolina was engaged in commerce with foreign nations at the time of its application for the registration of the trade-mark, and denies that the State of South Carolina was the owner of the alleged trade-mark used in commerce with foreign nations at the time of its application.

It is not denied that the trade-mark had been adopted and used as alleged in the first paragraph of the petition, and it is not denied that the relator owned such trade-mark in connection with such liquors.

The second paragraph of the petition avers that the petitioner's trade-mark is a valuable right which it is desirous of protecting to the full extent of the law. As to that the respondent answers that he has no knowledge as to the truth or falsity of the allegation.

50 The third paragraph of the petition avers that the trade-mark is used in commerce with foreign nations, and it then proceeds to state that, desiring to avail itself of the benefits of the act of Congress relating to the registration of trade-marks, it applied to the Commissioner of Patents for registration; that it has complied with all the requirements of the act; that it has paid into the Treasury of the United States the sum of twenty-five dollars, and filed with The Commissioner of Patents, the respondent, its statement and declaration as required by the act; and that it has in all respects complied with the provisions of the act and the regulations thereunder prescribed by the Commissioner of Patents. The statement and declaration, constituting the application, filed with the Commissioner, are inserted in full in the petition.

To this paragraph the respondent answers, admitting that the application had been filed by the relator for a certificate of registration, and that the fee of twenty-five dollars had been paid; that relator had filed its statement and declaration as required by the trade-mark act; but denying that the relator thereby complied with all the provisions of said trade-mark law, in that it was not the owner of a trade-mark, used in commerce with foreign nations, or with the Indian tribes.

In response to the fourth paragraph of the petition which has already been quoted at length, the respondent says that he denies that the trade-mark could be used in foreign commerce, for the reason that the State acts through its officers, its agents; that the State, through its agents, cannot use or become, by the illegal action of its agents, the owner of the alleged trade-mark in commerce with foreign nations, or with the Indian tribes, their authority being limited to purchases and sales within the State, and

therefore the relator is not the owner of the alleged trade-mark used in commerce with foreign nations or with Indian tribes, within the meaning of the trade-mark law, the State of South Carolina not being engaged in commerce with foreign nations or with the Indian tribes. He denies that the trade-mark is altogether lawful, and the claim of the petitioner just and legal, or that it is the plain duty of the Commissioner of Patents to register the trade-mark; but he admits all the other allegations of the fourth paragraph.

The fifth paragraph of the petition avers that the Commissioner of Patents has refused and still denies and refuses to register the trade-mark, thereby denying to the petitioner the plain right which, as owner of said trade-mark, it has to the registration under the law, and that the petitioner is thereby greatly injured and damaged, and has no other remedy in the premises than the one prayed for.

To this paragraph the respondent answers, admitting that he has refused and still refuses to register the trade-mark, because under the law it is his duty to decide the ownership of petitioner to the alleged trade-mark, as used in commerce with foreign nations or with the Indian tribes, and that in his sound judgment and discretion he has decided adversely to the registration, because the State of South Carolina is not the owner of the alleged trade-mark used in commerce with foreign nations or with the Indian tribes. He denies that by this refusal he has denied to the petitioner a plain right, and he further denies that the petitioner has been, at any time, so far as the respondent knows, the owner of a trade-mark used in commerce with foreign nations or with the Indian tribes. He denies that the petitioner is entitled to the registration of the trade-mark under the Federal trade-mark law. He denies that the court has jurisdiction to compel the respondent to register the trade-mark because the decision whether said trade-mark can law-
51 fully be registered or not, and whether the applicant is the owner of the trade-mark, involves discretionary duties upon the part of him, the respondent.

By paragraph six of the petition, as has been already stated, a copy of the trade-mark and of the request to the Commissioner of Patents to register it, and the subsequent communications received from the trade-mark examiner, and the opinion of the Commissioner of Patents, are referred to as filed with the petition and made a part of it. The respondent does not answer this paragraph.

It is clear by this answer that the respondent intends to be understood as having determined, as matter of fact, (1) that the State of South Carolina is not the owner of this trade-mark used in foreign commerce or in commerce with the Indian tribes, and (2) that it has never used this trade-mark in foreign commerce or in commerce with Indian tribes; but it is equally clear, not only by the careful reading of the answer itself, but by an inspection of the entire record, as made by the petition and the exhibits filed with it, that the respondent denies that the trade-mark has been used in foreign commerce by the applicant, or that the State is the owner of a trade-mark used in foreign commerce, because he construes the dispensary law

of the State of South Carolina, which is referred to in the petition and in the answer, as lacking in authority to the State to engage in foreign trade, and that, although he does not deny, as matter of fact, that the State of South Carolina, is the lawful owner of this trade-mark, as used in connection with the sale of liquors within the State limits, or that it has been used in foreign commerce by its agents, yet, as matter of law, he determines that the State agents cannot carry the State into trade, and therefore that the State is not engaged in trade, and does not own this trade-mark as used in foreign commerce.

It is the apparent purpose of the respondent to be understood as having decided adversely to the relator two questions which he claims are, by the act of Congress, committed to his judgment and discretion, and that his decision upon these two questions is a decision of fact. But, if the answer of the respondent be taken in connection with the action of the trade-mark examiner, and his own action, as indicated by the copy of his opinion filed with the petition, it will be seen that his refusal to register this trade-mark is based upon a conclusion of law, and not of fact. By the action of the examiner, a copy of which is filed as Exhibit D with the petition, it is plainly made to appear that upon his examination of the application for the registration of the trade-mark, the only basis of his rejection was that it was unique in the character of the applicant. He says: "There is no objection to the trade-mark presented; but the case is a novel one in respect to the character of the applicant. * * * The only objection that has been made is that a State of the American Union is not a corporation as contemplated in the act of March 3, 1881, for the registration and protection of trade-marks."

By Patent Office rule No. 10, relating to the registration of trade-marks, it is provided that "all applications for registration are considered in the first instance by the trade-mark examiner." By this action the examiner decided that the requirements of the act of Congress had been satisfied; that the office regulations had been complied with; and that, if a State can register a trade-mark, this applicant was entitled to register this trade-mark. He rejected the application solely on this ground. If he had not taken this position, it may be assumed from his relation to cases of trade-mark that this application would have been granted.

52 Upon an appeal being taken to the Commissioner, in person, after full argument, this ground of objection was abandoned by him as untenable, and he rejected the application upon a new ground. He says:

"It seems that a State of the American Union, having all the powers of an independent sovereign State except those surrendered to the Federal Government, has the inherent right, as a State, to engage in trade, domestic or foreign." He, however, proceeds to examine the legislation known as the dispensary act of the State of South Carolina, under which the right to engage in traffic in intoxicating liquors was conferred, and determines that, by that act, the agents of the State are not authorized to enter into foreign com-

merce. He says that "even if it should be held that the State could enter the field of commerce, it must be held, at the same time, that the State has not done so by the legislation before him." He says further "Neither the governor nor the State board of control provided for in this act can, by any act of theirs, even in the name of the State, take the State into trade." He concludes finally in these words: "It is considered that the State of South Carolina, notwithstanding the acts of its governor and State board of control, has no authorized trade in liquors outside its own limits; is not the owner of any trade-mark; has not, at this time, the right to the use of the trade-mark sought to be registered; and therefore the application is denied."

To sum up the answer, giving effect to admissions to be read between the lines, and regarding as admitted such averments of the petition as are not denied, it appears to me that it is conceded that the State of South Carolina has adopted and used the trade-mark in controversy in legitimate business within the limits of the State, and therefore is the owner of the trade-mark at common law. It is admitted that the agents of the State of South Carolina have used this trade-mark in connection with the sale of liquors to a foreign country, and that, if such had been the act of an individual or of a trading corporation, he or it would have a right, under the law, to register this trade-mark. It is admitted that all the requirements of the law and of the regulations of the Patent Office have been complied with by the relator, and it is effectively and plainly shown, although not frankly stated, that the only ground of the refusal of the respondent is that under the dispensary act, as construed by him, the officers of the State have no power or authority to carry the State into foreign trade, and that the State, whatever its officers may have done, had not used this trade-mark in foreign commerce.

So understanding the issue as made by the respondent, as the basis of his refusal to register the trade-mark for the relator, it becomes necessary to determine whether the refusal of the respondent is a denial of a legal right conferred by law upon the relator, or whether it is the determination of a question involving judgment and discretion committed to him by the law, and as such, therefore, not subject to the review or control of the court.

The act of March 3, 1881, provides that "owners" of trade-marks used in commerce with foreign nations or with the Indian tribes * * * may obtain registration of such trade-marks by complying with the following requirements:

1st. By causing to be recorded in the Patent Office a statement specifying certain facts, containing a description of the trade-mark, with fac-similes.

2d. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents.

53 Next, this act requires that the application described in the preceding section must be accompanied by a written declaration to the effect that the party has, at the time, a right to the use of the trade-mark sought to be registered, and that no other

person, firm, or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or with the Indian tribes; and that the description and fac-simile presented for registry truly represents the trade-mark sought to be registered. By section 3 it is provided that the time of the receipt of any such application shall be noted and recorded, and no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce, or in commerce with the Indian tribes as above mentioned; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.

This third section further provides that "In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between the applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases."

The respondent claims that he is to determine, under the provisions of this section, whether the alleged trade-mark appears to be lawfully used as such by the applicant in foreign commerce, and that the proper construction of that language imposes upon him the duty of ascertaining, not only whether the applicant has the lawful right to use the trade-mark as such, but also whether the applicant is, not only in fact but also lawfully, engaged in foreign trade, and using the trade-mark in foreign commerce. I do not apprehend that Congress ever intended to impose upon the Commissioner of Patents the burden of such an inquiry as the ascertainment and determination of the question whether the applicant was lawfully engaging in foreign commerce. As I understand it, the duty is imposed upon the Commissioner to ascertain, *prima facie*, whether the applicant is lawfully entitled to use the trade-mark sought to be registered, and, in the next place, to ascertain from the showing that is made to him whether that trade-mark, so lawfully used by the applicant, is used in foreign trade.

In the absence of any controversy over the ownership of the alleged trade-mark, arising either out of a claim of right to the same trade-mark by some other applicant, or out of information within the reach of the Commissioner of Patents as to the use of such trade-mark by some other person in a similar connection, the information upon which the Commissioner of Patents is to act is that which is contained within the statement and declaration required by the first and second sections of this act to be made and filed.

It is also claimed by the respondent that the provision that the Commissioner of Patents shall decide the question of the presumptive lawfulness of the claim to said trade-mark, means that the law

has conferred upon the Commissioner of Patents the discretionary power to reject the application for the registration of a trade-mark upon any ground that may seem to him meet and proper. It would seem, however, to be clear that the meaning of that pro-
54 vision, taken in connection with the succeeding and concluding part of the sentence, is this: That the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark when anything within his information indicates that the applicant has not a lawful right to claim the ownership, and whenever that ownership is disputed by another applicant, or a previous registrant. In these cases, the Commissioner of Patents shall decide the presumptive lawfulness of claim of ownership, and in such controversy, so far as possible, he must follow the practice of courts of equity of the United States. That this is the true construction of this section would appear to be supported by the provision of section 7, that the "registration of a trade-mark shall be *prima facie* evidence of ownership"—not *prima facie* evidence of use in foreign commerce, or *prima facie* evidence of ownership of a trade-mark that had been used, or was used, in foreign commerce; but *prima facie* evidence solely of ownership. That is to say, the trade-mark law, by conferring the right upon owners of trade-marks used in foreign commerce to register the same with the Commissioner of Patents upon complying with certain provisions of law conferred upon the registrant no new right of property in the trade-mark itself, but attached to his certificate of registration a mere presumption of ownership of the trade-mark—an ownership, not in the sense of having used the trade-mark in foreign commerce, but the ordinary ownership of a trade-mark used in connection with trade in a certain class of goods. This presumption is of value of the registrant, independently of any provision of law which authorizes suit to be instituted in the United States courts solely in the fact that the burden of proof is, by the law, in an action for the infringement of the registered trade-mark, imposed upon the defendant who desires to assail the right of ownership. It would seem to be clear that if Congress intended that the function of the Commissioner of Patents in the registration of a trade-mark should extend to the determination of any question beyond that of mere presumption of ownership, it would have provided that the effect of registration should be *prima facie* evidence of something more than ownership. The scope of the legal effect of registration must be as full in its elements as the duty of investigation. That registration does not determine even presumptively the fact of use in foreign commerce, appears clearly by the provisions of section 11: "That nothing in this act shall give cognizance to any court of the United States in any suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe," thereby imposing upon the registrant of a trade-mark, where the suit is between citizens of the same State and is brought in a court of the United States, the burden of establishing that the

trade-mark in controversy is used in foreign commerce, or in commercial intercourse with an Indian tribe.

Nowhere in this act is any duty of examination into the facts required to be stated in the application for registration imposed upon the Commissioner of Patents. The only matter that is expressly committed to his decision is "the presumptive lawfulness of claim to the alleged trade-mark," and that is in immediate connection with the provision that, in any dispute between the applicant and another claimant, he shall follow the practice of courts of equity.

Exactly why, in the absence of controversy or dispute between adverse claimants for the same right, the Commissioner of Patents should enter upon an investigation of the truth of any of the statements or declarations required by law to be made as conditions to registration is not perceived, unless it be for the purpose of rendering some labor in the nature of an equivalent for the fee of $25 required; for the United States confers no prerogative by the act of registration; it parts with nothing; the resident trade-mark owner has no clearer title, no more absolute right of property, with than without the act of registration.

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By paying his fee, the registrant receives a certificate that carries with it a presumption of ownership of the trade-mark, and entitles him to sue a citizen of his own State in a circuit court of the United States, provided he proves that the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe. In every other particular the rights of the owner of an unregistered trade-mark are as complete, his remedies for infringement are as full, and his use of the courts as free, as are those of a registrant.

The act of registration settles no right. Section 8 of the law provides that no suit shall be maintained under its provisions "when the trade-mark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained." Section 9 provides that "any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case."

The case of the grant of letters patent for inventions and discoveries, the duties imposed by law upon the Commissioner of Patents in that connection, and the effect of such grant, referred to in the argument for respondent as analogous to the matter in hand, appear to be quite different. By the issuance of letters patent, the exclusive right to manufacture and sell the thing patented is given for a term of years. A property right is created, which exists only by virtue of the law. Section 4893 of the Revised Statutes of the United States with reference to applications for patents is as follows:

"On the filing of any such application, and the payment of the

fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if, on such examination, it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

Here the duty of examination is expressly imposed upon the Commissioner of Patents, and the letters patent are to be granted only in the event it appears upon such investigation that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important. The presumptions that follow the grant of letters patent are as large and as numerous as are the elements of examination required of the Commissioner. The law imposes upon the person who assails such exclusive grant of property the burden of proving the lack of some one element essential to make the grant valid. The grant is the fruit of investigation which is "essentially judicial in its character." "That it was intended that the Commissioner of Patents, in issuing or withholding patents, in reissues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make." Butterworth *v.* Hoe, 112 U. S., 50, 59, 67.

56 These important functions of the Commissioner in the matter of granting letters patent are imposed by reason of the fact that there are two parties to every application for a patent, the public, who are the grantors, and derive advantage from the disclosure and use of the invention, and the patentee, who is rewarded for his invention by the grant of a limited monopoly. Butterworth *v.* Hoe; *ibid.*, 59.

Very different is the case of mere record of an arbitrary symbol adopted by a trader as a mark for his goods, the registration of which confers no benefit upon the public, is of value only to the registrant, and to him affords the scant benefit of a legal presumption of ownership. There does not appear to be any reason why the Commissioner should be called to the exercise of any judgment or discretion in the granting or refusing of such registration, and it would seem that the right of the owner to register his trade-mark, if he has used it in foreign commerce, is absolute upon compliance with the provisions of law.

Chief Justice Marshall, in his celebrated exposition of the law of mandamus as applied to the executive officers in the case of Marbury *v.* Madison (1 Cranch), after stating that "questions in their nature political, or which are by the constitution and laws submitted to the executive * * * where the head of a department acts in a case in which executive discretion is to be exercised * * * any application to a court to control in any respect his conduct would be rejected without hesitation," proceeds, "but where he is directed by law to do a certain act affecting the absolute right of individuals, in the performance of which he is not placed under the particular direction of the President, and the performance of which the President cannot lawfully forbid * * * as for ex-

ample to record a commission, or a patent for land, which has received all the legal solemnities, or to give a copy of such record; in such cases, it is not perceived on what ground the courts of the country are further excused from the duty of giving judgment, that right may be done to an injured individual, than if the same services were to be performed by one not at the head of a department." "It is not by the office of the person to whom the writ is directed, but by the nature of the thing to be done, that the propriety or impropriety of issuing a mandamus is to be determined."

I am of opinion that the duty of registration of a trade-mark by the Commissioner of Patents is such a one that, in a case where the right is denied to an applicant who has complied with the provisions of the law and the regulations of the Patent Office, its performance can be compelled by mandamus. Had the respondent in this matter admitted that the relator had made the statement and declaration required by law, paid the fee, and complied with the office regulations, but based his refusal to register the trade-mark exclusively upon the ground that in his judgment the relator, as a body politic, could not be included in the term "owner," used by the law in designating those who are entitled to its benefits, the writ prayed would necessarily follow, for the law fixes the right, and the respondent has no discretionary power, either wilfully or erroneously, to disregard it. That would have been this case had the Commissioner adhered to the examiner's reason for rejection. Does he occupy any stronger position when he makes all of these admissions, concedes that the relator is included among those who can claim the benefit of the act as an owner, but denies the registration because, in his judgment, although it appears by the oath of the chief executive of the State of South Carolina "that said trade-mark is used by the said State in commerce with foreign nations and par-
57 ticularly with Canada," the State of South Carolina is not authorized by the dispensary act to engage in foreign trade, and therefor it has not used the trade-mark in foreign commerce, whatever its agents may have done? The respondent says that the law has imposed upon him the duty of determining whether the relator used the trade-mark lawfully in foreign commerce, and he is therefore called upon to decide whether the relator could lawfully engage in foreign commerce. The language used in the law is "no alleged trade-mark shall be registered unless it appear to be lawfully used as such by the applicant in foreign commerce." Clearly this word "lawfully" relates to the character of the right of the applicant to the use of the trade-mark, and not to the character of the foreign commerce. It is the fact of use in foreign commerce that must appear in conjunction with the right to use as owner. If use in foreign commerce *de facto* appears, it is not within the province of the Commissioner to question whether such foreign commerce in the case of the relator is not *de jure*, or to adjudge that it is *ultra vires* the relator. That question must be left to the determination of the courts in a proper case, and to the people of the State of South Carolina. It is a matter in which the United States and the respondent, and the public generally,

have no interest or concern. How, then, does the matter stand? The relator owns the alleged trade-mark, uses it in its business, has used it in foreign commerce, has complied with the requirements of the trade-mark law and the regulations of the Patent Office. All of this appears in the record, notwithstanding the equivocal and argumentative denials of the respondent that the relator is the owner of the trade-mark as used in foreign commerce, and that relator used the same in foreign commerce, quite as plainly, though not as briefly, as it would appear had the respondent frankly stated (the fact) that his only ground of rejection was the want of authority in the relator to engage in foreign commerce. Concede that the respondent has discretion under the law to determine the question of ownership of the trade-mark, and the question of its use by the applicant in foreign commerce. He has exercised his discretion and finds the applicant in every particular element of requirement of fact and form entitled to registration, but he refuses to perform the act for an insufficient reason. It would serve no useful purpose to attempt to analyze the well-known decisions of the Supreme Court of the United States in cases of mandamus against executive officers, or to seek to draw the line between duties involving discretion and those merely ministerial. The law is well settled. The difficulty in such cases is not in the law, but in the facts "indicating the nature of the thing to be done."

Chief Justice Chase has thus defined a ministerial duty: "A ministerial duty, the performance of which may in a proper case be required of the head of a department by judicial process, is one in respect of which nothing is left to discretion. It is a simple, definite duty arising under conditions admitted or proved to exist and imposed by law." Miss. *v.* Johnson, 4 Wall., 475, 498.

In the case of Butterworth *v.* Hoe (*supra*) it was held that the Commissioner of Patents exercises quasi-judicial functions, and yet it appearing that the Commissioner had refused to receive the final fee, to prepare or issue the letters patent, or to take any further steps in the matter, because, having decided that the relator was entitled to his patent, his decision had been reversed by the Secretary of the Interior, the court held that the Secretary had no appellate power, or power in the premises, to review or reverse
58 the decision of the Commissioner, and that mandamus was the proper remedy. The court, by Justice Matthews, said (p. 68): "Some question is made as to the remedy. We think, however, that mandamus will lie, and that it was properly directed to the Commissioner of Patents. He had fully exercised his judgment and discretion when he decided that the relators were entitled to a patent. The duty to prepare it, to lay it before the Secretary for his signature, and to countersign it, were all that remained, and they were all purely ministerial. These duties he had failed to perform merely out of deference to the claim of the Secretary to reverse and set aside the decision on the merits in favor of the relators. This we have held not to be a valid excuse. The case falls clearly within the principles acted upon in Commissioner of Patents *v.* Whitely, 4 Wall., 522."

In the case mentioned the court held that the writ of mandamus "lies where there is a refusal to perform a ministerial act involving no exercise of judgment or discretion."

The nature of the act remaining to be performed by the respondent in the matter of the application of the relator does not involve discretion. He had exercised and exhausted his discretion. Nothing remained to be done but "a simple, definite duty arising under conditions admitted to * * * exist and imposed by law." This duty he has failed to perform because he says that he has decided that the act of engaging in foreign commerce is *ultra vires* the relator. I am of opinion that this is not "a valid excuse." The peremptory writ of mandamus will issue.

A. C. BRADLEY, *Justice.*

Order for Appeal, &c. Filed October 24, 1893.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Relatione* THE STATE OF SOUTH CAROLINA, Petitioner, *vs.* JOHN S. SEYMOUR, Respondent. } At Law. No. 34714. Precipe.

The clerk of said court will enter an appeal to the Court of Appeals, District of Columbia, from the order of the court quashing the return of respondent and judgment for peremptory writ of mandamus. The clerk will issue citation on said appeal and prepare transcript.

JOHN I. HALL,
LEVIN H. CAMPBELL,
Attorneys for John S. Seymour.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Relatione* THE STATE OF SOUTH CAROLINA *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } At Law. No. 34714.

The President of the United States to the relator, The State of South Carolina, Greeting:

You are hereby cited and admonished to be and appear at a Court of Appeals of the District of Columbia on the 6th day of November, A. D. 1893, pursuant to an appeal filed in the clerk's office of
59 the supreme court of the District of Columbia on the 24 day of October, 1893, wherein John S. Seymour, Commissioner of Patents, is appellant, and you are appellee, to show cause, if any there be, why the judgment rendered against the said appellant should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Edward F. Bingham, chief justice of the

supreme court of the District of Columbia, this 25 day of October, in the year of our Lord one thousand eight hundred and ninety-three.

[SEAL.] JOHN R. YOUNG, *Clerk.*

Service of the above citation accepted this 31 day of October, 1893.

JOHN ALTHEUS JOHNSON,
Attorney for Appellee.

In the Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia,* } ss:

I, John R. Young, clerk of the supreme court of the District of Columbia, do hereby certify the foregoing pages, numbered from 1 to 89, inclusive, to be a full, true, and correct transcript of the record of all the proceedings had in said court in cause No. 34714 at law, wherein The United States *ex rel.* The State of South Carolina is petitioner, and John S. Seymour, Commissioner of Patents, is respondent, as the same remains upon the files and records of said court.

In testimony whereof, I hereunto subscribe my name and affix the seal of said court, at the city of Washington, this 31 day of October, A. D. 1893.

[SEAL.] JOHN R. YOUNG, *Clerk.*

60 Court of Appeals, District of Columbia, January 4th, 1894.

JOHN S. SEYMOUR, Commissioner of Patents, Appellant,
vs.
THE U. S. *ex Rel.* THE STATE OF SOUTH CAROLINA. } No. 272.

The argument of this cause was commenced by Mr. L. H. Campbell, for the appellant, and continued by Mr. J. Altheus Johnson, for the appellees.

61 Court of Appeals, District of Columbia, January 5th, 1894.

JOHN S. SEYMOUR, Commissioner of Patents, Appellant,
vs.
THE U. S. *ex Rel.* THE STATE OF SOUTH CAROLINA. } No. 272.

The argument of this cause was continued by Mr. J. Edgar Smith, for the appellee, and concluded by Mr. John I. Hall, for the appellant.

62 Mr. Justice SHEPARD delivered the opinion of the court:

This case comes before us on appeal by the Commissioner of Patents from the judgment of the supreme court of the District of Columbia, in special term, ordering a peremptory writ of mandamus

to issue, commanding him to register a trade-mark on the application of the State of South Carolina.

On July 15, 1893, Benjamin R. Tillman, governor of the State of South Carolina, on behalf of said State, filed an application in the office of the Commissioner of Patents for the registration of a trade-mark used in the sale of intoxicating liquors consisting of the word "palmetto." A fac-simile of the label upon which this word is used was filed with the application. It has ornamented borders within which appears the word "palmetto," printed above the coat of arms of the State of South Carolina; underneath this is a[n] name band upon which may be printed the words "bourbon whiskey," "New England rum," or other designations according to the kind of intoxicating liquor contained in the package upon which the label may be applied.

The application is in the ordinary form recommended for use by private corporations by the rules and regulations of the Patent Office, and is verified by an affidavit in the following words: "Benjamin R. Tillman, being duly sworn, deposes and says that he is the governor of the State of South Carolina, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said State at this time has a right to the use of the trade-mark therein described; that no other person or firm or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto, as might be calculated to deceive; that the said trade-mark is used by the said State in commerce with foreign nations, or Indian tribes, and particularly with Canada; and that the description and fac-similes presented for record truly represent the trade-mark sought to be registered."

According to the rules of the office the application was submitted to the special examiner for investigation and report, who, without going into the merits, reported adversely on the ground that a State of the Union is not within the terms of the law permitting the registration of trade-marks, because it does not come within the designation of "person" or "corporation" as used therein.

The application then came before the Commissioner in person, and was presented with elaborate argument on behalf of the applicant. He refused it on August 30, 1893, with a written statement setting out his reasons therefore which concludes as follows: "It is considered that the State of South Carolina, notwithstanding the acts of the governor and the State board of control, has no authorized trade in liquors outside of its own limits, is not the owner of any trade-mark, has not at this time the use of the trade-mark sought to be registered, and therefore the application is denied."

Importance was sought to be attached to the report of the examiner by counsel for the relator on the argument, but we can see no good reason therefor. It is but the report of a partial examination made by a subordinate, and forms no part of the Commissioner's decision. In fact, he has expressly overruled the point made by the examiner and based his decision upon other and entirely dis-

tinct grounds which were not even alluded to in the examiner's report.

The Commissioner's decision shows that evidence was received by him in the course of his inquiry into the lawfulness of the State's claim to the use of the trade-mark: It is apparent that the dispensary act of South Carolina, under which the right to carry on trade in liquors is claimed by the State, was submitted for the consideration of the Commissioner, together with proof that the State board of control created by said act had adopted the trade-mark on July 1, 1893.

It appears also that proof was made with respect to the foreign commerce of the State in liquors, from the following paragraph of the decision:

"As the present legislation of Congress on trade-marks is restricted to those used in commerce with foreign nations, or the In-
63 dian tribes, the authorities have sold a case of the State's liquors, bearing this trade-mark, in Canada, and it is claimed that thus the trade-mark has been used in commerce with foreign nations."

After a motion for rehearing had been overruled by the Commissioner, this petition for mandamus was filed in the supreme court of the District. All the proceedings in the office of the Commissioner were made exhibits to the petition, including the elaborate printed arguments of the counsel for the applicant that had been submitted for his consideration.

Upon the service of the alternate writ, the Commissioner appeared and submitted a demurrer to the petition, which was overruled. He then made return by way of answer, setting out the grounds of his refusal to register substantially as contained in his decision, and questioning, as he had done by his demurrer, the right of the court to revise or control his action in the premises. This answer was held insufficient, on motion of the relator, and a peremptory mandamus ordered to issue to compel the Commissioner to register the trade-mark as applied for.

Several errors have been assigned, but the points upon which the case turns, and to which the argument has been directed, are raised in the third and sixth of the series. The third is to the point, that the duties of the Commissioner, as prescribed by law, are not ministerial simply, but are such as to call for the exercise of judgment and discretion, and that his decision having been made in the performance of this discretionary duty, is not subject to revision by the courts. The sixth is to the effect that the State of South Carolina is not entitled to have this trade-mark registered because she is not, and cannot be, lawfully engaged in foreign commerce.

There ought to be little difficulty in the determination of the true office of the mandamus as applied in the Federal courts. The decisions of the Supreme Court of the United States are numerous, and state with perfect agreement the principles which should govern the proceedings of the courts in applications therefor.

Mr. Justice Miller, speaking for the court in Gaines *v.* Thompson, 7 Wall., p. 348, said:

"The extent of the jurisdiction which may lawfully be asserted by the Federal courts over the officers of the executive departments of the Government, has been mooted in this court from the case of Marbury *v.* Madison down to the present time; and while the principles which should govern the action of the courts in that regard have been settled long since, the frequent application of late to this court and to other Federal courts, for the exercise of powers not belonging to them, shows that the question is one not generally understood."

And we might add, the number of cases reported since that time shows that this misunderstanding has not ceased to exist.

It is settled beyond question that mandamus will not lie save in a plain case, and where there is no other legal remedy. And this, it may be, has caused some of the prevailing misunderstanding of another and still more important principle, that is equally well settled, viz: that under no circumstances can the writ of mandamus be made to operate as a writ of error.

To the judiciary department is intrusted generally the interpretation of the laws, the determination of rights, and the application of remedies, and with the strong sense of their duties and obligations in this regard, it is sometimes difficult for the courts to properly appreciate the fact that the executive department is charged with perfectly independent duties, not alone by the supreme law, but also by legislation thereunder, which require the ascertainment of facts, involve the interpretation of laws, and in many respects call for the exercise of judgment and discretion by officers who are not required to be lawyers. And this independence is so complete, that no matter how gross an error may be committed, or however ill advised the action of an executive officer may be, in the execution of these duties, the courts are nevertheless powerless to interfere where no appeal to them is given. Public and private interests may suffer in instances, and rights may sometimes be denied; but these alone do not authorize the interference of the courts with the duties of executive officers.

Greater evils could not exist under our system of government than would follow the usurpation by the judiciary, of powers not intrusted to them.

Where the duty prescribed is plain and specific, admitting of no discretion, calling for the exercise of no judgment, and the officer charged therewith refuses to perform it, to the injury or the deprivation of the right of another, mandamus will lie to compel him to its performance. It will lie where the duties are discretionary, or even strictly judicial; never, however, to revise action that has been taken, but to compel reception and consideration, or the taking of jurisdiction, provided that, when action shall have been taken, the party aggrieved thereby would then have the right to appeal from the decision.

The two leading cases in the Supreme Court in which the question of mandamus to executive officers has been considered are Kendall *v.* Stokes, 12 Pet., 524, and Decatur *v.* Paulding, 14 Pet.,

497. In the first of these the mandamus was ordered, while in the second it was refused.

"The subsequent cases," said Bradley, J., in U. S. *ex rel.* Dunlap *v.* Black, 128 U. S., p. 45, "have followed the principles laid down in these and do little more than illustrate and apply them." * * * "The principle of law deducible from these two cases is not difficult to enounce. The court will not interfere with the executive officers of the Government in the exercise of their ordinary official duties, even where those duties require an interpretation of the law, the court having no appellate power for that purpose; but when they refuse to act in a case at all, or when, by special statute or otherwise, a mere ministerial duty is imposed upon them, that is, a service which they are bound to perform, without further question, then, if they refuse, a mandamus may be issued to compel them."

It is by the "nature of the thing to be done that the propriety or impropriety of issuing a mandamus is to be determined."

The distinction between official acts and duties that are ministerial, and those which are judicial or *quasi*-judicial, which
64 has been established by the great weight of authority, may be stated as follows: Where the law commands the doing of a specific thing and charges the officer with its execution in terms so plain and certain as to leave him no reasonable alternative but obedience, the act may be said to be ministerial simply. Where, on the other hand, the act involves the exercise of discretion in determining whether the right exists or a duty is required to be performed in the particular case, it ceases to be ministerial and becomes *quasi* judicial.

It is necessary now to examine the statute under which the right is claimed in this case, and to determine whether the duties prescribed therein for performance by the Commissioner, are ministerial simply, or discretionary.

In the first place, it may be said of the trade-mark act that no appeal lies to this court from the decision of the Commissioner refusing registration, as it does in the case of refusal of a patent. And we have recently held, in Einstein *v.* Sawhill, that the right of appeal does not exist from decisions made in cases of dispute between applicants for registration. In that case, Mr. Justice Morris, who spoke for the court, had occasion to review the legislation of Congress on the subject of trade-marks and explain the cause of the substitution of the elaborate legislation of previous years by the restricted act of March 3, 1881, which limits the registration of trade-marks to such only as may have been actually used in commerce with foreign nations or the Indian tribes.

Section 1 of this act provides that "owners of trade-marks used in commerce with foreign nations or with the Indian tribes," may obtain registration thereof by causing to be recorded in the Patent Office a statement specifying the name, location, citizenship, etc., of the party applying, the class of merchandise and description of goods in such class to which the mark is appropriated, a description of the trade-mark with fac-similes thereof, and the mode in which it is applied to goods, and the length of time during which it has

been used. In addition the applicant must pay a fee of twenty-five dollars and "comply with such regulations as may be prescribed by the Commissioner of Patents."

Section 2 requires that the application be accompanied by a declaration under oath, to the effect that the applicant has, at the time, the right to the use of the trade-mark; that no other person or firm etc., has the right to such use either in identical form, or in such near resemblance as might be calculated to deceive; that it is used in commerce with foreign nations or Indian tribes, and that the descriptions and fac-similies presented truly represent it.

Section 3 reads as follows:—"That the time of the receipt of any such application shall be noted and recorded. *But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with the Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered, or known trade-mark of another; and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration, the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark;* and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases."

The remaining sections of the statute are not of sufficient importance in the consideration of the question to be set out here, but may be referred to hereafter.

We think it plain that the duties of the Commissioner are something more than ministerial, and that they differ widely from the duties of a mere register of deeds, or receiver of papers for file, with which an attempt has been made to institute a comparison.

A trade-mark that may have been in undisputed use for years in domestic trade, and invested with all the characteristics of a trade-mark good at common law, is nevertheless not a trade-mark in the sense of this statute unless it shall have been lawfully used in commerce with foreign nations or the Indian tribes. The Commissioner is required to decide "the presumptive lawfulness of claim to the alleged trade-mark." This, in connection with the preceeding portion of the third section aforesaid, can mean nothing less than that in all cases he shall inquire, first, if the applicant has actually used the trade-mark in lawful commerce with foreign nations or with the Indian tribes, and then, if he has the right to the use of it at all.

If he finds that the "alleged trade-mark" is the name of the applicant, or any other name which cannot be lawfully converted into a trade-mark at common law, or that it is identical with the trade-mark of another, registered or unregistered, or is a deceptive imitation of another, or that it is not the property of the applicant, he cannot admit it to registration though he may be satisfied that the applicant has used it in regular commerce with foreign nations

or the Indian tribes. So likewise, he may be satisfied with the lawfulness of the applicant's ownership and right to the use, but unless it be made to appear also that he has lawfully used it in actual commerce with foreign nations or the Indian tribes, the registration must be denied.

No provision is made as to how the Commissioner shall inform himself with respect to the existence of these conditions; but the fact that he is authorized to make regulations and that applicants are required to comply with them, would seem necessarily to imply that he is left free to institute the necessary inquiry in his own way. This he appears to have done in this case, for his decision refers to matters of fact considered by him, which do not appear in the application and verification thereof. Certain rules and regulations have been made by the Commissioner, as shown in the record, and by one of these he has added to the requirements of section 2 in this, that the verification of the application must show not only in general that the trade-mark is lawfully used in commerce with foreign nations or the Indian tribes, but also
65 one or more of these, by name, with which the commerce is carried on. This regulation has been in force for a long time, and was followed in this case without question; for in the verification of relator's application it is said: "The said trade-mark is used in commerce with foreign nations, or Indian tribes, and particularly with Canada."

Why require this specification of the name of one or more of the foreign nations or Indian tribes with which commerce is had, unless it is to aid the Commissioner in the investigation of the truth of the statement should he deem the same necessary or proper? The particular and only value of this required specification consists in the facility which it may afford the Commissioner in ascertaining if the trade-mark is lawfully so used.

It is contended that, inasmuch as the last clause of section 3 provides for the manner of trial as in courts of equity, so far as applicable, in the event of disputes with a previous registrant, or a rival applicant, it necessarily covers and provides for the only contingency in which the Commissioner is authorized to exercise any discretion whatever. This clause only provides the practice that shall prevail in the event that an actual contest shall be made by rival registrants or applicants, and is in nowise inconsistent with the idea that where there is no contest, the Commissioner may make the necessary inquiry into the existence of all the facts necessary to registration, in any manner that he may deem adequate to that end. "The presumptive lawfulness of claim" which he is called on to decide is in express accord with the provision of section 7, which makes the registration "*prima facie* evidence of ownership."

This limitation of the effect of the Commissioner's decision is claimed also as supporting the relator's contention. But we can see nothing either in its letter or spirit which goes to show that the Commissioner's action in the premises is to be without the exercise of discretion. His determination, either with or without contest, is not made conclusive for the better reason, and one more in

accord with the spirit of our institutions, that it would be unwise and probably unjust, to leave the final determination of what may be a valuable right of property, without respect to the registration, to an executive officer from whose decision there is no appeal.

The contention of the relator, in its last analysis, is that when a verified application is presented to the Commissioner, and there is no contest depending between the applicant and other parties, there is nothing left to his discretion, and it becomes his imperative duty to issue the certificate of registration.

The reasonable interpretation of the law, in our opinion, is that if there be a contest the Commissioner shall try the same in accordance with the practice of courts of equity, so far as applicable. But if there be no contest between opposing parties, he may accept the sworn declaration as sufficient if he have no cause to suspect its untruth; or he may, in the exercise of his discretion, inquire into the truth of its allegations. And in the event that he should have reasonable ground to suspect that an imposition has been attempted, it would seem to be nothing more nor less than his duty to make an investigation.

The weakness of relator's contention is further illustrated by the preceding clause of the same section which expressly prohibits the registration of a trade-mark, which is not lawfully used in foreign commerce, or which is identical with a registered or known trade-mark of another, or which so closely resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.

If Congress had intended to make the duty of the Commissioner, where the application is uncontested, ministerial only, it would seem that, instead of requiring him to deny registration if certain facts appeared, it would have commanded him to issue the certificate without question upon the presentation of the verified application.

Counsel for relator admitted, on the argument, that it has been the custom of the successive Commissioners to keep in the office, as far as practicable, all trade-marks in use that have not been registered, for the purpose of comparison with those presented for registration, and to deny registration when it was apparent that the applicant had adopted one of these known trade-marks, or a deceptive imitation thereof, even though the owner of the same made no appearance and entered no objection; nor would they deny that it was his duty to do so.

The Commissioner being, as we have seen, required to deny registration where the alleged trade-mark is the counterfeit or deceptive resemblance of another, or where it is not lawfully used in commerce with foreign nations or the Indian tribes, how is he then to discover this counterfeit, or unlawfulness of use, if he is not authorized to look beyond the application and verified statement, and determine, *aliunde*, the rightfulness of the claim to registration?

Suppose an application is presented to the Commissioner, the allegations of which he knows to be untrue, is he, notwithstanding this knowledge, to register the falsehood and give presumptive law-

fulness to the fraud? For example, the application in this case (inadvertently, of course, and probably through following a printed form), states that this trade-mark is used in commerce with the Indian tribes as well as with Canada. Now suppose this application had stated solely that the trade-mark applied for was used in commerce with the Indian tribes, would the Commissioner be bound to register it, notwithstanding the laws of the United States expressly prohibit commerce in liquors with these tribes? Suppose the laws of Canada, in which, as evidence of commerce, it was shown, a case of the liquors stamped with this trade-mark had been sold, should be found to prohibit the importation of liquors, or the sale thereof within her territorial limits, would the Commissioner be compelled to disregard the fact and abet the violation of the laws of a friendly nation, by registering the trade-mark?

If a private corporation, through its president, should apply for the registration of a trade-mark with due formality, and the Commissioner, upon examination, should find that it was prohibited by law from carrying on commerce outside of the State of its
66 creation, would he be required to ignore this knowledge and give effect to the unlawful use of the trade-mark by the corporate agents?

In this case the State of South Carolina presented a copy of its dispensary act to the Commissioner as the authority of the State board of control for selling a case of the State's liquors in Canada. The Commissioner, upon inspection of the law, concluded that by its terms the State was confined exclusively to the sale of liquors within her own limits, and that her officers had no power to carry on commerce in liquors in her name with Canada, or any other foreign nation. Grant that his decision on this and other points was erroneous; still, the construction of these laws was a matter submitted to his discretion, and for the exercise thereof he is not responsible to the judicial power.

That the action of the head of a department in construing a law for his guidance, is not subject to revision by mandamus was expressly ruled in Decatur *v.* Paulding, 14 Pet., 497, where Taney, C. J., speaking for the court, said:

"The duty required by the resolution was to be performed by him (the Secretary of the Navy) as the head of one of the executive departments of the Government, in the ordinary discharge of his official duties. In general, such duties, whether imposed by act of Congress or by resolution, are not mere ministerial duties. The head of an executive department of the Government, in the administration of the various and important concerns of his office, is continually required to exercise judgment and discretion. He must exercise his judgment in expounding the laws and resolutions of Congress, under which he is from time to time required to act. If he doubts, he has a right to call on the Attorney General to assist him with his counsel; and it would be difficult to imagine why a legal adviser was provided by law for the heads of the departments as well as for the President, unless their duties were regarded as executive, in which judgment and discretion were to be exercised.

If a suit should come before this court, which involved the construction of any of these laws, the court certainly would not be bound to adopt the construction given by the head of a department. And if they supposed his judgment to be wrong they would, of course, so pronounce their judgment. But their judgment upon the construction of a law must be given in a case in which they have jurisdiction, and in which it is their duty to interpret the act of Congress, in order to ascertain the rights of the parties in the cause before them. The court could not entertain an appeal from the decision of one of the Secretaries, nor revise his judgment in any case where the law authorized him to exercise discretion or judgment. Nor can it, by mandamus, act directly upon the officer, and guide or control his judgment or discretion in the matters committed to his care, in the ordinary discharge of his official duties. The case before us illustrates these principles and shows the difference between executive and ministerial acts."

In that case the widow of Commodore Decatur claimed and received a pension under a general act of Congress, and claimed another under the provisions of a special resolution for her benefit. There was no dispute over the facts. The Secretary, under his construction of the law, denied the pension, and the court refused the mandamus. What is said in that case of the Secretary applies equally to the Commissioner of Patents, who is at the head of a department.

In U. S., *ex rel.* Dunlap *v.* Black, which we have cited above, mandamus to the Commissioner of Pensions was applied for. The relator, through ignorance or misapprehension, made application for a pension under an act of 1877, and was raised at thirty-six dollars per month, when his disabilities were such as clearly to entitle him, had he applied under the act of 1874, to fifty dollars per month. By act of 1880, it was provided that all those at the date of the act receiving pensions at fifty dollars per month, as provided in the act of 1874, should receive seventy-two dollars per month from January 17, 1878. Relator's application for this increase was denied, but he was then placed on the roll under the act of 1874, entitling him to fifty dollars per month. The Commissioner denied his claim on the technical ground that, not having been actually rated under the act of 1874, he was not entitled to the benefit of the act of 1880, though he found that "the degree of helplessness which has been shown was that contemplated by the law." The supreme court of the District of Columbia refused to issue the mandamus, and on writ of error their judgment was affirmed. After quoting from Decatur *v.* Paulding the passage quoted hereinabove, and laying down the rule deducible from that case, and Kendall *v.* Stokes, Bradley, justice, said:

"Judged by this rule the present case presents no difficulty. The Commissioner of Pensions did not refuse to act or decide. He did act and decide. He adopted an interpretation of the law adverse to the relator, and his decision was confirmed by the Secretary of the Interior as evidenced by his signature of the certificate." (This confirmation, however, had nothing to do with the question, for if the

Commissioner's act was ministerial, his was necessarily so too.) "Whether, if the law were properly before us for consideration, we should be of the same opinion, or of a different opinion, is of no consequence in the decision of this case. We have no appellate power over the Commissioner, and have no right to revise his decision. That decision and his action taken thereon were made and done in the exercise of his official functions. They were by no means merely ministerial."

The case at bar, in our opinion, presents a stronger case for the denial of the writ than either Decatur *v.* Paulding, or U. S. *v.* Black, or the recent case of Redfield *v.* Windom, 137 U. S., 636, in each of which it was denied.

There are only three cases in the Supreme Court, to which our attention has been called, where the mandamus has been ordered:

(1.) Kendall *v.* Stokes, 12 Pet., 524. In this case the law required the Postmaster General to enter to the credit of a contractor such sum as the solicitor should report to him for that purpose. There was no possible room for the exercise of discretion.

(2.) Butterworth *v.* Hooe, 112 U. S., 50. Here the Commissioner of Patents found all the facts in favor of the applicant and ordered patent to issue. An appeal was taken to the Secretary of the
67 Interior, who reversed him. In deference to the decision, the Commissioner withheld the patent. It was held that the Secretary had no jurisdiction over the Commissioner's decisions, and as the Commissioner had already determined every question in favor of the applicant, nothing remained to be done but to deliver the patent, which was a purely ministerial act.

(3.) U. S. *v.* Schurz, 102 U. S., 378. In this case a patent to land had been made out and signed and only lacked delivery. *Held*, that applicant's right had been settled, and he was entitled to the possession.

To these may be added Marbury *v.* Madison, 1 Cr., 137, in which the court apparently would have issued the writ had it not found itself without jurisdiction. Marbury had been appointed to an office by President Adams; the Senate had confirmed him; his commission had been made out and signed by the President, and nothing remained to be done beyond its delivery. There is no similarity between the facts of those cases and of this. The distinction is plain and unmistakable.

We are clearly of the opinion that the duties imposed upon the Commissioner of Patents by the trade-mark act are not ministerial, but that their proper discharge requires the exercise of judgment and discretion, and that therefore his action cannot be controlled in this proceeding.

In view of the suggestion by counsel that applications for other trade-marks on behalf of the relator are waiting presentation upon the decision of this case; and because from what has been said we may have created the impression that we deem the decision of the Commissioner to the effect that the State could not engage in foreign commerce erroneous; and as the question has been fully argued.

we will express ourselves briefly on the second proposition, though its decision is not absolutely necessary.

It would seem to be the practice of those who desire the registration of newly adopted trade-marks, to ship a package of merchandise labeled therewith to some foreign country, and upon its sale there to lose the affidavit that the same is used in foreign commerce. Whether an isolated case of such consignment and sale would constitute commerce with a foreign nation within the meaning of the law, is a question which was not argued and we will pass it by without decision, assuming, for the purpose of this case only, that it would.

The power of the State of South Carolina to engage in foreign commerce for the purpose of revenue or profit, through an express act of her legislature, is a question that we are not called upon to decide. We do hold, however, that the executive officers of the State cannot engage her in trade without the express authority of the legislature, and we do not understand that this power is seriously claimed. The dispensary law, which was enacted December 24, 1892, and took effect July 1, 1893, clearly has its foundation in an attempt to exercise the police power of the state for the prevention of the evils which attend the indiscriminate sale of intoxicating liquors; the collection of revenue is an incidental feature thereof. If the expressed object of the law were the making of profit through trade in liquors, and the suppression of the evils of private traffic therein were only an incident, the question would be presented, whether the legislature of a State, without express constitutional authority, has the power to collect money, by the exercise of its sovereign power of taxation, for the purpose of using it in ordinary trade with the view to prospective profit. If such were the question we would have no hesitation in saying that no such power exists.

The constitution of South Carolina provides that: "Every act or resolution having the force of law, shall relate to but one subject and that shall be expressed in the title." The title of the dispensary act is: "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this State except as herein permitted." It would be an unnecessary consumption of time to undertake a synopsis even of this lengthy act. We can find nothing whatever in it to justify an inference that it was intended to give authority for trade in liquors outside the limits of the State. Every part of it relates exclusively to sales, as expressed in the title, "within this State." The State commissioner is required to purchase the liquors for sale in the state and put them upon the market through the county dispensers, under the most stringent regulations to prevent abuse. If a non-resident should desire to buy any of the state's liquors, he cannot order it sent to him by the commissioner or one of the dispensers. By a strained and doubtful construction he might procure it through some resident agent, who might possibly be allowed to make the necessary sworn application, procure a limited quantity of the liquor, and then, as his own act, ship it to his principal. But this, if permissible at all, would hardly constitute foreign or interstate trade in the article.

If then, as seems to have been proved before the commissioner, a case of the State's liquors was sent to Canada and sold there by the State commissioner, it was not authorized by the law, and was not the act of the State but of the officer. This distinction between the acts of the State and the acts of its officers without the authority of a valid law, is clearly stated in the able opinion of Lamar, justice, speaking for the court in Pennoyer *v.* McConnaughey, 140 U. S., 1.

The Commissioner did not err in the conclusion that the trade-mark applied for had not been lawfully used in foreign commerce.

It follows from what has been said that the judgment appealed from should be reversed, and the relator's petition dismissed, and it is so ordered.

68 Court of Appeals of the District of Columbia. February Term, 1894.

JOHN S. SEYMOUR, Commissioner of Patents, Appellant,
vs.
THE UNITED STATES *ex Rel.* THE STATE OF SOUTH CAROLINA. } No. 272.

Appeal from the supreme court of the district of Columbia.

This cause came on to be heard on the record from the supreme court of the District of Columbia and was argued by counsel.

On consideration whereof it is now here ordered and adjudged by this court that the judgment of the said supreme court in this cause be, and the same is hereby, reversed with costs: and it is further ordered that the petition of the relator be, and the same is hereby, dismissed.

Per MR. JUSTICE SHEPARD.

February 5, 1894.

[Endorsed:] Court of Appeals of the District of Columbia. No. —. — term, 189–. Judgment.

69 Court of Appeals, District of Columbia, February 12th, 1894.

JOHN S. SEYMOUR, Commissioner of Patents, Appellant,
vs.
THE UNITED STATES *ex Rel.* THE STATE OF SOUTH CAROLINA. } No. 272.

On motion of Mr. J. Altheus Johnson, for the appellee, it is ordered by the court that a writ of error to remove this cause to the Supreme Court of the United States be, and the same is hereby, allowed on giving bond in the sum of $500.00.

70 Know all men by these presents that we, The State of South Carolina, as principal, and Benjamin R. Tillman, Osmund W. Buchanan, and William D. Mayfield, as sureties, are held and firmly bound unto John S. Seymour, Commissioner of Patents,

in the full and just sum of five hundred dollars ($500.00), to be paid to the said John S. Seymour, Commissioner of Patents, his certain attorney or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents.

Sealed with our seals and dated this 24th day of February, in the year of our Lord one thousand eight hundred and ninety-four.

Whereas lately, at a Court of Appeals of the District of Columbia, in a suit depending in said court between the said John S. Seymour, Commissioner of Patents, appellant, and The United States *ex relatione* the State of South Carolina, appellee, a judgment was rendered against the said appellee, and the said appellee having obtained a writ of error and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit and a citation directed to the said appellant, citing and admonishing him to be and appear at a Supreme Court of the United States, to be holden at Washington, within 30 days from the date thereof:

Now, the condition of the above obligation is such that if the said appellee shall prosecute its writ of error to effect and answer all costs if it fail to make its plea good, then the above obligation to be void; else to remain in full force and virtue.

B. R. TILLMAN. [SEAL.]
O. W. BUCHANAN. [SEAL.]
W. D. MAYFIELD. [SEAL.]

Sealed and delivered in presence of—
W. T. MIXSON.

Approved by—

MARTIN F. MORRIS,
Associate Justice, Court of Appeals, D. C.

71 SOUTH CAROLINA,)
Richland County.)

I, Albert M. Boozer, clerk of the supreme court of the State of South Carolina, do hereby certify that in my opinion the within bond is good and the surety thereto is sufficient. This 21st day of February, 1894.

[SEAL.] ALBERT M. BOOZER,
Clerk of Supreme Court of South Carolina.

72 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the honorable the judges of the Court of Appeals of the District of Columbia, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals before you, or some of you, between John S. Seymour, Commissioner of Patents, appellant and the United States *ex relatione* The State of South Carolina, appellee, a manifest error hath happened, to the great damage of the said appellee, as by its complaint appears, we,

being willing that error, if any hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court at Washington within 30 days from the date hereof, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the laws and customs of the United States should be done.

Seal Court of Appeals, District of Columbia.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 24th day of February, in the year of our Lord one thousand eight hundred and ninety-four.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

73 UNITED STATES OF AMERICA, *ss:*

To John S. Seymour, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States at Washington within 30 days from the date hereof, pursuant to a writ of error filed in the clerk's office of the Court of Appeals of the District of Columbia, wherein The United States *ex relatione* The State of South Carolina is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error, as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Richard H. Alvey, chief juustice of Court of Appeals of the District of Columbia, this 5th day of March, in year of our Lord one thousand eight hundred and ninety-four.

R. H. ALVEY,
Ch. Justice.

Service hereof accepted this 5th of March, 1894.

LEVIN H. CAMPBELL,
Of Counsel for Def't in Error.

[Endorsed:] Court of Appeals, District of Columbia. Filed Mar. 5, 1894. Robert Willett, clerk.

74 Court of Appeals of the District of Columbia.

I, Robert Willett, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing is a true and complete transcript of the record and all proceedings in said Court of Appeals in the case of John S. Seymour, Commissioner of Patents,

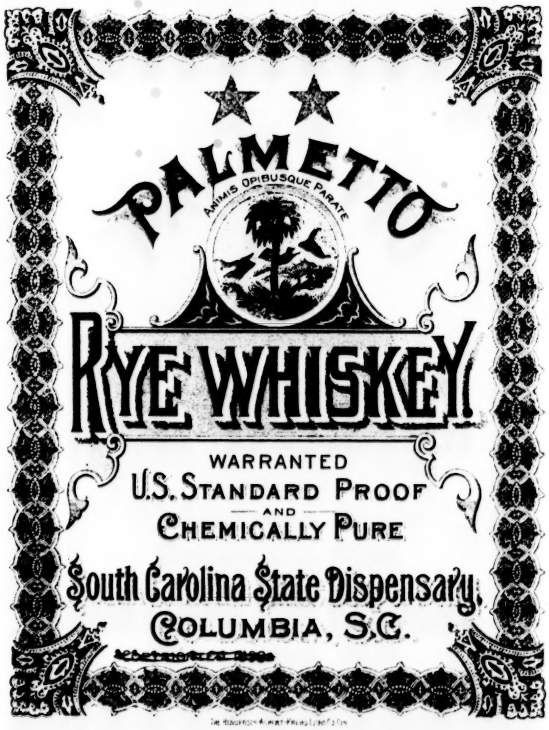
appellant, *vs.* The United States *ex rel.* The State of South Carolina, No. 272, February term, 1894, as the same remain upon the files and records of said Court of Appeals.

Seal Court of Appeals, District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals at the city of Washington this 10th day of March, A. D. 1894.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: Case No. 15,524. District of Columbia Court of Appeals. Term No., 1140. The United States *ex relatione* The State of South Carolina, plaintiff in error, *vs.* John S. Seymour, Commissioner of Patents. Filed March 10, 1894.



It is hereby agreed by and between counsel that

Office Supreme Court U. S.
FILED.
APR 9 1894
JAMES H. McKENNEY,
CLERK.

153-353

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1893.

AT LAW, NO. 1140.

THE UNITED STATES, Ex Rel. THE STATE OF SOUTH CAROLINA, Appellant,

vs.

JOHN S. SEYMOUR,

Commissioner of Patents, Appellee.

Appeal from the Court of Appeals of the District of Columbia.

MOTION TO DISMISS FOR WANT OF JURISDICTION.

JOHN I. HALL,
LEVIN H. CAMPBELL,
Counsel for Commissioner of Patents.

WASHINGTON:
GOVERNMENT PRINTING OFFICE.
1894.

In the Supreme Court of the United States.

OCTOBER TERM, 1893.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Plff. in Error,*
vs.
JOHN S. SEYMOUR, *Commissioner of Patents, Deft. in Error.*
At Law, No. 1140.

Copy of notice of motion and brief of argument.

To Mr. J. Altheus Johnson, counsel for the State of South Carolina, plaintiff in error, No. 408 Fifth street, Washington, D. C.

Sir: You will please take notice that on Monday, the 9th day of April, A. D. 1894, at the opening of the Court, or as soon thereafter as counsel can be heard, a motion, of which the annexed is a copy, will be submitted to the Supreme Court of the United States for the decision of the Court thereon. A copy of the brief of argument which will accompany the motion is also attached hereto.

JOHN I. HALL,
LEVIN H. CAMPBELL,
Counsel for the Commissioner of Patents.

Washington, D. C., March 21, A. D. 1894.

Motion.

In the Supreme Court of the United States.

October Term, A. D. 1894.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Plff. in Error,*
vs.
JOHN S. SEYMOUR, *Commissioner of Patents, Deft. in Error.*
} *At Law, No. 1140.*

Comes now John S. Seymour, Commissioner of Patents, the defendant in error, by his counsel, appearing specially in that behalf, and moves the Court to dismiss the appeal in the above-entitled cause for want of jurisdiction, because—

(*a*) The matter in dispute, exclusive of costs, does not exceed the sum of $5,000: no right of property, nor right of any kind which exceeds the sum of $5,000, or can be calculated or stated in money, being in dispute.

(*b*) No question is presented in the cause involving the *validity* of a patent or copyright, or a treaty or statute of or an authority exercised under the United States.

JOHN I. HALL,
LEVIN H. CAMPBELL,
Counsel for the Commissioner of Patents, the Defendant in Error.

Acknowledgment of Service.

Service of a copy of the aforegoing letter of notice and motion; and the brief of argument, accompanying the motion, is herewith acknowledged on this 21st day of March, A. D. 1894.

J. ALTHEUS JOHNSON,
Counsel for the State of South Carolina, the Plaintiff in Error.

Brief of Argument.

WHAT THE APPEAL IS.

This is an appeal from the judgment of the Court of

Appeals of the District of Columbia reversing the judgment and order of the Supreme Court of the District of Columbia ordering a writ of mandamus to be issued on the petition of the United States at the relation of the State of South Carolina, directed to John S. Seymour, Commissioner of Patents, requiring him to register an alleged trade-mark consisting of the word, "Palmetto," as applied to intoxicating liquors, on an application for the registration of said trade-mark, filed in the Patent Office, in the name of the State of South Carolina. The Supreme Court of the District of Columbia ordered the writ of mandamus to be issued, and the Court of Appeals of the District of Columbia reversed the order and dismissed the relator's petition for the writ.

STATEMENT OF THE CASE.

In July, 1893, an application for the registration of an alleged trade-mark, consisting of the word "Palmetto," to be applied to intoxicating liquors, was filed in the Patent Office, at Washington, D. C., in the name of the State of South Carolina, signed by B. R. Tillman, Governor of the State of South Carolina. Accompanying the application, or filed on behalf of the State of South Carolina during the process of examination of the application, was a copy of the so-called dispensary law of the State of South Carolina, approved December 23, 1892. This law was relied on to prove the authority of the State of South Carolina to adopt, use, and own a trade-mark, and to engage in foreign commerce in the traffic of intoxicating liquors. The title of the law is: "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within the State, except as herein provided." The act is so lengthy that it will not be set out here, as it is unnecessary that the Court should have the act before them to decide this motion. However, briefly summarizing such portions of the act as have any bearing on the merits of the application for the registration of the trade-mark, section 1 restricts the traffic in intoxicating liquors within the limits laid down in the act; section 2 provides for a State commissioner of liquor, who shall purchase all liquors for lawful sale in the State, to be

sold as prescribed in the act. In all purchases or sales of liquors made by him he shall attach a certificate to each package of liquor, when the same is shipped to him from the place of purchase or by him to the county dispensers, certified by his official signature and seal, which certificate shall state that the liquors in said package have been purchased by him *for sale within the State*, or to be shipped out of the State (this latter clause refers to manufacturers selling to parties outside of the State, section 6.) He shall furnish a quarterly statement of all liquors sold by him and to whom sold; sec. 3. He shall before shipping any liquor to the *county dispensers* put the same in packages; sec. 6. County dispensers shall *alone* be *authorized to sell* and dispense liquors; provided *manufacturers* in the State may sell to the commissioner and to parties outside of the State. (See last clause of section 2, supra, as to the *proviso*); sec. 9. Oath, required of county dispenser, that he will not sell to *any person not known to him personally, or duly identified*, nor to any minor, intoxicated person, or person in the habit of becoming intoxicated, * * * and make return showing the *true signature* to every request received and granted upon taking the oath; sec. 11. *Before selling* or delivering any liquor to any person, a *request* must be presented to the county dispenser, in ink, dated of the true date, stating age and residence of the signer for whom and whose use the liquor is required, the quantity and kind requested, and his or her true name and residence, and the *request* shall be signed by the applicant in own true name and signature, *attested* by the county dispenser or his clerk who receives and files the request, in his own true name and signature and in his own handwriting; or if the applicant is not so *personally known* to said dispenser, before filling the order or delivering the liquor, he shall require identification, and the statement of a reliable and trustworthy person of good character and habits, known personally to him, that the applicant is not a minor and is not in the habit of using intoxicating liquors to excess; sec. 12. *Requests* for the *purchase of liquor* shall be made upon blanks furnished by the county auditor to the county dispensers. The blanks shall be in books like bank checks. The county dispenser shall preserve the ap-

plication in the original form and book, except the filling of the blanks therein. A State board of control is also established, of which the Governor of the State of South Carolina is a member, whose duties are to superintend generally the administration of the law.

The Commissioner of Patents, upon an examination of the application for the registration of the alleged trade-mark, "Palmetto," claimed in the application to have been appropriated to intoxicating liquors by the State of South Carolina, refused to register the alleged trade-mark to the said State of South Carolina, as applied for, on the ground, as it is expressed in the opinion of his refusal, that "It is considered that the State of South Carolina, notwithstanding the acts of its Governor and State board of control, has no authorized trade in intoxicating liquors outside its own limits, is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered, and, therefore, the application is denied," as will more fully appear in the opinion, of which the following is a copy:

Opinion of the Commissioner of Patents refusing registration.

Appeal is taken from the refusal of the examiner to register a trade-mark applied for in the name of the State of South Carolina, consisting of the word Palmetto, to be applied to bottles and other receptacles containing intoxicating liquors, by means of suitable labels upon which the trade-mark is to be printed, together with the arms of the State, the name of the liquor, and the words, "Warranted U. S. Standard Proof and Chemically Pure, South Carolina State Dispensary, Columbia, S. C.," it being understood that all these words except Palmetto may be omitted, and that the various accessories of ornamentation and arrangement may be varied at pleasure, or altogether omitted.

It is the intention of the State officers that the State shall enter markets outside the State and outside the Union as a vendor of liquors for profit. As the present legislation of Congress on trade-marks is restricted to those used in commerce with foreign nations, or with the Indian tribes, the authorities have sold a case of the State liquors bearing this trade-mark in Canada, and it is claimed that thus the trade-mark has been used by the State in commerce with foreign nations.

It also appears that the trade-mark was adopted on the 1st day of July, 1893, by the State board of control created by the act approved December 24, 1892.

It was claimed in argument that the State in this regard possesses the full rights of a trading corporation, and that it followed from the nature of a State that it might undertake a business of this character to be conducted outside as well as within its own limits, and that apart from its general powers authority was found in the provisions of its recent liquor legislation to enable the State to do this.

The examiner held otherwise, and therefore refused to register the trade-mark.

A State may become a partner in a commercial company, and when it does so "it divests itself, so far as concerns the transactions of that company, of its sovereign character, and takes that of a private citizen. Instead of communicating to the company its privileges and its prerogatives, it descends to a level with those with whom it associates itself, and takes the character which belongs to its associates, and to the business which is to be transacted." (U. S. Bank *v.* Planters' Bank, 9 Wheaton, 904–907.)

If a State may be a member of a corporation it was urged that it might resolve itself into a trading corporation, in the particular intent proposed, without associates, while in other respects it retained the characteristics or essentials of a sovereign State.

The Republic of France enjoys the monopoly of the trade in tobaccos and tobacco products, it owns manufactories of powder, of arms, of matches, of tapestry, and of porcelain, among them the celebrated manufactory of Sevres. Belgium manufactures guns for its own use as well as for sale in the markets of the world. Nor are State trade-marks unknown in foreign jurisprudence. An instructive passage occurs in an authority on trade-marks, Nouveau Traité des Marques de Fabrique et de Commerce, par Alexandre Braum, 1880, page 249:

"What of a State? The question whether a State is competent to claim its trade-mark as a producer or manufacturer has been presented repeatedly before our courts and tribunals and those of other countries. It has been decided in the affirmative. Why, indeed, if a State may engage in an industry, has it not, as every trader, in consideration of the performance of the usual formalities, the right to certify the origin of products coming from its manufactories? So the court of cassation has declared that the State of Belgium, inasmuch as it manufactures guns to arm the soldiery, ought to be considered as a regular manufacturer. (Cass. B., 5 mai, 1870, État belge c. Gerard, Ancion et Ce., P. B., 1870, I, 265.) What is to prevent, therefore,

besides the official stamp, which attests that its arms have passed the board of approval, the impress of a mark showing that they are of its own make?

"It has been decided: 1°. That the French Administration is properly allowed, in our (the Belgium) jurisdiction, the character of a private manufacturer, whose trade-mark is susceptible of protection on condition that the outward sign of its product (cigarettes) has been regularly registered at the Registry of the Tribunal of Commerce in Brussels, in the same way as all other foreign producers. (Cass. B., 26 dec. 1876, Proc. génér., Spies et État français c. Kiss et consorts, P. B., 77, I, 54); 2°. That the usurpation or imitation of a trade-mark, such as that the French State places upon the cigarettes made and sold by it, falls within the application of the German law of November 30, 1874, especially when the registration of that mark has been regularly made and published conformably to that law (Trib. de 1re instance de dresde, 3 mars 1877, État français c. Taenbrich, Pataille, 77, 199)."

Quoting by translation from the Dictionary of Industrial Property (Trade-marks), by Maillard de Marafy, vol. 3, page 602:

"The State, as well as private individuals, may have to appeal, on its own account, to the laws concerning trade-marks, trade and proprietary names. The State possesses, indeed, generally, manufactories, forests, mineral springs, industrial monopolies of every kind, tobacco, powder, matches, &c. In like manner it may have to affix its seal to authenticate brands, guarantee the validity of licenses of enterprises granted by itself; in a word, to make demands or suits upon usurpations or counterfeits."

It seems that a State of the American Union, having all the powers of an independent sovereign State except those surrendered to the Federal Government, has the inherent right as a State to engage in trade, domestic or foreign. Whether this may be done without limitation, or whether it may be done where it is necessary to invoke the power to tax, in order to provide the capital for embarking in trade, I do not now consider. Nor is it necessary to discuss the implied limitations upon the executive, the legislative, and the judicial branches of the governments of the States laid down in a line of cases of which the Loan Association *v.* Topeka (20 Wall., 655–663) is one. Nor is it necessary to point out how this might be done, if it may be done at all, or whether an express grant of power in the State constitution would be necessary or would be effectual to inaugurate such policy. It is certain that a lawful trade in liquors outside the State must be established in some effectual manner before the State can become the owner of a trade-mark

which would be entitled to registration in its name in the Patent Office under the law of 1881.

The question now arises, has the State of South Carolina taken upon itself the character of a trading corporation in intoxicating liquors outside its own limits or with foreign nations?

The application for this trade-mark is made by the governor in the name of the State, and the State legislation under which this action is taken is before me. Its significant title is, "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this State, except as herein provided."

A critical analysis of the act shows it to be a stringent measure of State regulation, within the State, of a traffic considered open to abuse in private hands. The comprehensive language of the first section definitely restricts the traffic within the limits laid down in the act. The State commissioner purchases the liquors and furnishes them to the county dispensers, to be sold as the act prescribes: "In all purchases or sales of intoxicating liquors made by said commissioner, as contemplated in this act, the commissioner shall cause a certificate to be attached to each and every package containing said liquors when the same is shipped to him from the place of purchase, or by him to the county dispensers, certified by his official signature and seal, which certificate shall state that the liquors contained in said package have been purchased by him for sale within the State of South Carolina, or to be shipped out of the State, under the laws of said State." (Part of section 2.)

The expression "to be shipped out of the State" evidently refers to the traffic, elsewhere permitted in the act, to manufacturers located within the State, who may sell outside the State, provided the certificate of the State commissioner is obtained and affixed to every package.

Section 18 appropriates the sum of fifty thousand dollars, if so much be necessary, for the purpose of purchasing and of supplying liquors to be distributed to county dispensers under the provisions of the act.

Every one of its minute provisions may be given its full and appropriate meaning by construing the whole act as a measure for the suppression of the liquor traffic in South Carolina by private individuals, and to substitute therefor its complete control by the State through local public dispensers. It is only by strained constructions that any phrases in the act may be held to look to the establishment of an outside traffic of any kind, excepting in the purchase of the liquors to be dispensed. Nor is there anything in the general or special objects of the statute to show that the State intended to descend to the level of a trading corpora-

tion outside its own limits in and by the same public act whereby it prohibits both individuals and private corporations, and, by necessary construction, other States themselves, if they should attempt to act as private corporations in this particular, from entering for the purpose of this traffic the domain of South Carolina. If it should be held that the State could enter the field of commerce in traffic in intoxicating liquors outside its own limits, it must at the same time be held that the State has not done so in or by the legislation before me.

The State speaks by its constitution and public acts. Its law-making power, including within that term the power by which constitutions are made as well as laws, is alone the repository of the sovereign and governmental powers of the State. That power is alone competent to initiate and define the policy of the State. Neither the governor nor the State board of control provided for in this act can by any acts of theirs, even in the name of the State, take the State into trade.

The provisions of the trade-mark law of 1881 are that owners of trade-marks used in commerce with foreign nations or with Indian tribes, may obtain registration, but the application must be accompanied by a declaration "to the effect that such party has at the time a right to the use of the trade-mark sought to be registered."

It is considered that the State of South Carolina, notwithstanding the acts of its governor and State board of control, has no authorized trade in liquors outside its own limits, is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered, and therefore the application is denied.

JOHN S. SEYMOUR,

AUGUST 30, 1893. *Commissioner.*

What followed.

Upon the refusal of the Commissioner of Patents to register the alleged trade-mark as applied for, one D. A. Townsend, signing his name, as Attorney-General of the State of South Carolina, in the name of the State of South Carolina, petitioned the Supreme Court of the District of Columbia, in special term, for an alternative writ of mandamus, directed to John S. Seymour, Commissioner of Patents, commanding him to register the trade-mark, as applied for, or else to show cause before that Court for his failure to do so. All of which will more fully appear from the following copy of the

petition and rule to show cause, omitting all exhibits to the petition, they not being of importance to reach a decision of this motion.

Petition for mandamus.

In the Supreme Court of the District of Columbia.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Petitioner*, *vs.* JOHN S. SEYMOUR, *Commissioner of Patents, Respondent.* } *At Law. No. 34714.*

To the Honorable Justice of the Supreme Court of the District of Columbia, holding a special term of the said court for the trial of causes at law:

The petitioner, the State of South Carolina, a body politic and corporate, and one of the Commonwealths that constitute the United States of America, by Daniel A. Townsend, its attorney-general, represents to your honor as follows:

1. The petitioner, under and by virtue of an act of its general assembly, approved by its governor December 24, 1892, assumed control of and is at present, under and by virtue of the said act, engaged in a traffic in intoxicating liquors. Through its officers and agents, as authorized in the said act, and since July 1, 1893, the petitioner has bought and sold and otherwise handled in the way of trade, in the manner provided in the said act, certain kinds of pure and unadulterated liquors. In connection with the said liquors and the sale thereof, and as a means of designating the same, the petitioner adopted and used a certain trade-mark, and thereby became and was the owner of the said trade-mark as used in connection with such liquors, and it has remained such owner to the present time.

2. The petitioner's trade-mark, adopted as aforesaid, has become famous, and constitutes a valuable right which the petitioner is desirous of protecting to the full extent of the law enacted for the protection of trade-marks.

3. The trade-mark aforesaid is used in commerce with foreign nations; and the petitioner, desirous to avail itself of the benefits of the act of the Congress of the United States approved March 3, 1881, applied to the Commissioner of Patents for the registration thereof under the said act. The petitioner has complied in this regard with all the requirements of the said act. On July 15, 1893, it paid in to

the Treasury of the United States the sum of twenty-five (25) dollars and filed with the Commissioner of Patents, John S. Seymour, aforesaid, its statement and declaration as required by the said act, and in all respects complied with the provisions of the said act and the regulations thereunder prescribed by the Commissioner of Patents. Its statement and declaration, so filed, are in the words following, to wit:

To all whom it may concern:

Be it known that the State of South Carolina, one of the Commonwealths composing the United States of America, possessed in this regard of the full rights of a corporation, and doing business at its capital city of Columbia, in the County of Richland, State aforesaid, has adopted for its use a trade-mark for chemically pure distilled liquors of which the following is a full, clear, and exact specification:

The said trade-mark consists of the word "Palmetto." This has generally been arranged as shown in the accompanying facsimile, in which the said word Palmetto appears in ornamental type, curved above a representation of a portion of the State coat of arms, showing the palmetto tree growing in foothills. The said representation is inclosed within an annulus, and between the annulus and the curved word Palmetto appear the words of the motto, "Animis opibusque parati." The annulus above referred to is supported by an ornamental bracket, which rests upon a name-band having shade lines from side to side, and ending in ornamental scroll work. Upon the said name-band appears, as in the facsimile, the name of the particular distilled liquor inclosed within the receptacle to which the trade-mark is applied, to wit, "Bourbon Whisky;" or the words "Gin, Rye Whisky, New England Rum, Jamaica Rum, California Brandy, Blackberry Brandy," or the like may be used in place thereof when other liquors are to be designated.

In the facsimiles herewith presented this name is printed in ornamental type, shaded in high relief. Below the name-band appears the word "warranted," printed in plain capitals upon a line, and below this word appear the words "U. S. standard proof," printed in shaded capitals, below which appears the conjunction "and," preceded and followed by a dash, and below this are the words "chemically pure," printed in the same style as the words "U. S. standard proof." Below all of this are the words indicating the origin of the article, "South Carolina State dispensary," under which is "Columbia, S. C."

Above the curved word Palmetto are placed stars to indicate the quality of the article inclosed.

The whole is usually inclosed in an ornamental border which imitates lathe scroll work.

It is to be understood that all the words above described, excepting the one word Palmetto, may be omitted, and the various accessories of ornamentation and arrangement may be varied at pleasure or altogether omitted, and the said word Palmetto and its accessories may be printed in any style of type, in any method of arrangement, and in any color without materially altering the character of the said trade-mark, the essential feature of which is the word "Palmetto."

This trade-mark has been continuously used by the said State since the first day of July in the year of our Lord 1893.

The class of merchandise to which this trade-mark is appropriated is intoxicating liquors, and the particular description of goods comprised in such class on which it is used by the said State are chemically pure distilled liquors.

It has been the practice to apply the said trade-mark to the bottles, flasks, jugs, kegs, and other receptacles containing the liquors by means of suitable labels, on which it is printed as above described. The trade-mark may also be used by attaching the said labels to baskets, crates, barrels, boxes, hogsheads, and the like in which the articles may be packed, or it may be branded upon the said receptacles, blown into any and all glass receptacles, stamped or molded upon stone or earthenware, or used in any of the many well-known ways.

The said trade-mark Palmetto may be used upon letter heads, bill heads, posters, dodgers, and the like, and generally in all ways known in the art of advertising.

In testimony whereof I, Benjamin R. Tillman, Governor of the State of South Carolina have hereto affixed my signature in the presence of two witnesses, and have caused the seal of the State of South Carolina to be hereto attached.

STATE OF SOUTH CAROLINA,
By B. R. TILLMAN,
Governor of the State of South Carolina.

W. H. ELLERBE,
Comptroller-General.
D. A. TOWNSEND,
Attorney-General.
By the Governor:
J. E. TINDALL,
Secretary of State, State of South Carolina.
[SEAL OF STATE OF S. C.]

STATE OF SOUTH CAROLINA,
County of Richland, to wit:

Benjamin R. Tillman, being duly sworn, deposes and says that he is the Governor of the State of South Carolina, the applicant named in the foregoing statement; that he verily

believes that the foregoing statement is true; that the said State at this time has a right to the use of the trade-mark therein described; that no other person, or firm, or corporation has the right to such use either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the said trade-mark is used by the said State in commerce with foreign nations or Indian tribes, and particularly with Canada; and that the description and facsimiles presented for record truly represent the trade-mark sought to be registered.

B. R. TILLMAN,
Gov. S. C.

Subscribed and sworn to before me this 13th day of July, in the year of our Lord, 1893.

[SEAL.] N. K. PERRY,
Notary Public, S. C.

4. The trade-mark aforesaid is lawfully used as such by the petitioner in foreign commerce; it is not merely the name of the petitioner; it is not identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, and it does not so nearly resemble any other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; there is no dispute between the petitioner and any previous registrant of a trade-mark or any applicant for registration; but the trade-mark of the petitioner aforesaid is altogether lawful and the claim of the petitioner thereto as owner and user thereof is altogether just and legal; and the plain duty of the Commissioner of Patents in the premises is to register the said trade-mark, thus admitting the petitioner as the owner of the said mark to the benefits of the trade-mark statute aforesaid.

5. Yet the Commissioner of Patents has refused, and still continues to refuse to register the trade-mark aforesaid, thereby denying to the petitioner a plain right which as owner of the said trade-mark it has to the registration thereof under the statute aforesaid; and the petitioner is thereby greatly injured and damaged, and petitioner has no other remedy in the premises than the one herein prayed for.

6. The petitioner files herewith a copy of its trade-mark (A) herein mentioned and of the request (B) to the Commissioner of Patents to register the same; it files also a communication (C) received from the trade-mark examiner, dated July 28, 1893, and a copy of his answer (D) to the Commissioner dated August 1, 1893; it likewise files a copy of the answer (E) made by its attorneys before the Patent

Office to the said communication, as also a copy of the brief (F) by them filed with the Commissioner of Patents on appeal to him in person; it files also a copy of the opinion (G) of the Commissioner dated August 30, 1893, refusing to register the said trade-mark, and likewise a copy of the argument (H) made by its attorneys on a rehearing of the case and the Commissioner's answer (I) thereto, dated September 6, 1893, the said papers being marked exhibits A, B, C, D, E, F, G, H, and I, respectively.

Wherefore, your petitioner prays that an alternative writ of mandamus may issue from this honorable Court directed to the respondent, the said John S. Seymour, Commissioner of Patents, commanding him to register the said trade-mark as provided in the said statute of March 3, 1881, or else to appear before this honorable Court on a day appointed by your honor and show cause for his failure so to register.

THE STATE OF SOUTH CAROLINA,
By D. A. TOWNSEND,
Its Attorney-General.

STATE OF SOUTH CAROLINA, }
County of Richland, } *ss:*

Daniel A. Townsend, a citizen of the State of South Carolina, being first duly sworn, deposes and says that he is the Attorney-General of the State of South Carolina; that he is acquainted with the contents of the foregoing petition by the said State, which in the name of the said State he has subscribed; and that the matters and things set forth in the said petition are true, as he verily believes.

D. A. TOWNSEND.

Subscribed and sworn to before me this 8th day of September A. D. 1893.

[SEAL.] J. A. SAWYER,
Notary Public, S. C.

EXHIBIT A.—Filed September 11, 1893.

[Eight facsimiles labels.]

EXHIBIT B.—Filed September 11, 1893.

To the Commissioner of Patents:

Herewith is presented a facsimile of the lawful trade-mark of the State of South Carolina and I have to request that the same, together with the accompanying statement and declaration, be registered in the United States Patent Office, in accordance with the law in such cases made and provided.

And the State has appointed John Altheus Johnson and James Edgar Smith its attorneys, with full power of substitution and revocation, to prosecute this aplication, to make alterations and amendments therein, and to transact all business in the Patent Office connected therewith.

B. R. TILLMAN,
Governor of the State of South Carolina.

Rule to show cause.

In the Supreme Court of the District of Columbia.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Petitioner.*
vs.
JOHN S. SEYMOUR, *Commissioner of Patents, Respondent.*
No. 34714. At Law.

Upon reading the petitition for mandamus in the above entitled cause, and considering the same, it is ordered, this 11th day of September, 1893, that the respondent, John S. Seymour, Commissioner of Patents, show cause, on Tuesday, the 19th instant, at 10 o'clock a. m., before me at the special term of this Court, why the said writ should not issue as prayed by the petitioner; provided a copy of this order and of the petition be served upon the said respondent on or before the 14th instant.

A. C. BRADLEY,
Justice.

Marshal's return.

Served copy of the within order and petition filed therewith on the within-named John S. Seymour, Commissioner of Patents, September 12, 1893.

D. M. RANSDELL,
Marshal.

Commissioner filed a demurrer.

The Commissioner of Patents demurred to the petition for the writ of mandamus, alleging that the petition was bad in substance, in that it showed that the Commissioner of Patents had completely and finally acted on the application and that the Court could not interfere to revisé, modify, or reverse his decision of refusal to register the alleged

trade-mark as applied for, his duty thereon under the trade-mark law of 1881 being discretionary. The demurrer was overruled, and the alternative writ ordered to issue as prayed in the petition, as will appear from the following copy of the order:

Order overruling demurrer, etc.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Petitioner*, *vs.* JOHN S. SEYMOUR, *Commissioner of Patents, Respondent.* } *At Law.* *No. 34711.*

This cause, coming on to be heard upon the rule to show cause herein issued, the petition, with its exhibits, and the demurrer thereto filed, and the same having been argued by counsel, it is thereupon, upon consideration by the Court, ordered and adjudged this 3d day of October, A. D. 1893, that the said demurrer be, and the same hereby is, overruled; and it is also further ordered that an alternative writ of mandamus issue to the respondent, John S. Seymour, Commissioner of Patents, as prayed in the said petition, commanding him to register, as provided in the act of Congress of March 3, 1881 (21 Stat. at L., 502), the trade-mark of the petitioner, the State of South Carolina, the said writ to be returnable on Saturday, the 7th instant, at 10 o'clock a. m.

A. C. BRADLEY,
Justice.

Return of Commissioner.

The Commissioner of Patents then made return by way of answer, setting out the grounds of his refusal to register the trade-mark as applied for substantially as contained in his decision of rejection, and also questioning, as he had done by his demurrer, the right of the Court to revise, modify, or reverse his decision in the premises and to issue the writ of mandamus to him, his duties in the treatment of the application for the registration of the alleged trade-mark, being discretionary, under the trade-mark act of 1881, 21 Stat. at L., 502, as will fully appear from a copy of the return herewith made.

Return of respondent to alternative writ of mandamus.

In the Supreme Court of the District of Columbia.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Petitioner*, *vs.* JOHN S. SEYMOUR, *Commissioner of Patents, Respondent.* } *At Law. No. 34714.*

Respondent's answer.

The respondent, John S. Seymour, Commissioner of Patents, respectfully makes return to the alternative writ of the honorable the Supreme Court of the District of Columbia, made in the above-entitled case, commanding him to register a trade-mark as petitioned for in the petition, or in default thereof to appear before the said Supreme Court to show cause why he refuses so to do:

1. The respondent admits a knowledge of the act of the general assembly of the State of South Carolina, approved by its Governor, December 24, 1892, and entitled "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this State, except as herein provided," a copy of which act is hereto attached and made a part of his answer herein, but the respondent denies that under and by virtue of said act, or in any other way, so far as he has information and belief, that the petitioner, the State of South Carolina, was engaged in commerce with foreign nations or with Indian tribes at the time of its application for the registration of the said alleged trade-mark, and denies that the State of South Carolina was the owner of the said alleged trade-mark used in commerce with foreign nations or with the Indian tribes at the time of its application for the registration of the said alleged trade-mark, under the Federal trade-mark law, in connection with liquors dispensed or to be dispensed under the said act of its general assembly.

2. As to the second paragraph of the petition, the respondent states that he has no knowledge as to the truth or falsity of its allegations, other than as will appear by the record herein.

3. As to the averments of the third paragraph of the petition, respondent admits the filing of an application by relator for a certificate of registration of a trade-mark and of payment of the fee of twenty-five dollars ($25) into the Treasury of the United States, and its statement and dec-

laration, as required by the trade-mark act of March 3, 1881, but denies that the relator thereby complied with all the provisions of the said trade-mark law, in that the relator was not the owner of the trade-mark used in commerce with foreign nations or with Indian tribes.

4. As to the statements in the fourth paragraph, the respondent denies (*a*) that the alleged trade-mark could be used by the relator in foreign commerce, for the reason that a State acts through its officers, its agents. The agent designated by the State of South Carolina to purchase and sell liquors is "a commissioner," provided for by the act. His authority is limited to purchases and sales within the State, and the State, through its agent, can not use nor become, by the illegal action of its agent, the owner of the alleged trade-mark in commerce with foreign nations or Indian tribes, and therefore the relator is not the owner of the alleged trade-mark used in commerce with foreign nations or with the Indian tribes, within the meaning of the trade-mark law, the State of South Carolina not being engaged in commerce with foreign nations or with the Indian tribes; (*b*) the respondent denies that the trade-mark "is altogether lawful and the claim of the petitioner thereto is altogether just and legal, and the plain duty of the Commissioner of Patents in the premises is to register the said trade-mark, thus admitting the petitioner, as the owner of the said mark, to the benefits of the trade-mark statute aforesaid" (the act of March 3, 1881). (*c*) As to the other allegations in the fourth paragraph, the respondent admits their truth.

5. As to the allegations of the fifth paragraph, the respondent admits that he has refused and still continues to refuse to register a trade-mark in the petition mentioned, because under the trade-mark law it is his duty to decide the ownership of petitioner to the alleged trade-mark, as used in commerce with foreign nations or with Indian tribes, and he, the respondent, has, upon a just and thorough examination of the application for the registration of the alleged trade-mark, in his sound judgment and discretion, decided adversely to the registration of the alleged trade-mark, because the State of South Carolina is not the owner of the alleged trade-mark used in commerce with foreign nations or with the Indian tribes. The respondent denies that by his refusal to register the alleged trade-mark, he thereby denied to the petitioner a plain right. He denies further that the petitioner was at the time of the refusal to register its alleged trade-mark, or at this hour, so far as the respondent knows, the owner of a trade-mark used in commerce with foreign nations or with Indian tribes. As to the remaining statements in the fifth paragraph, the respondent neither affirms nor denies them, but puts the petitioner to their proof.

The respondent, for further answer, denies that the petitioner was at the time of its application for the registration nor since, so far as the respondent is aware, entitled to have its alleged trade-mark registered under the Federal trade-mark law.

The respondent, further answering, denies that this Court has jurisdiction to compel the respondent to register the alleged trade-mark to the relator, because the decision, whether said alleged trade-mark can lawfully be registered or not, and whether the applicant is the owner of the said alleged trade-mark, *i. e.*, a trade-mark used in commerce with foreign nations or with Indian tribes, involves discretionary duties upon the part of him, the respondent.

The respondent, for further answer, states that under paragraph two, section one, of the trade-mark act of 1881, he is authorized to prescribe regulations for the conduct of proceedings in the Patent Office, and in pursuance of such authority he established and promulgated rules, designed to be in strict accordance with the provisions of the Federal trade-mark law for the proceedings before the Patent Office for the registration of trade-marks under the Federal trade-mark act of March 3, 1881, a copy of said rules being hereto attached and made a part of this answer.

The respondent, for further answer, states that if the act of registration which he is required to perform under the trade-mark law were solely ministerial and such as this Court might compel him to perform, it is yet submitted that, upon the merits of petitioner's case, the relator is not entitled to the relief prayed for. The State of South Carolina is not the owner of a trade-mark used in commerce with foreign nations or with the Indian tribes, and consequently not entitled to have the alleged trade-mark registered.

Wherefore your respondent prays the judgment of your honor whether this Court has jurisdiction in the premises, and, if so, whether the facts in the case as contained in the record and the law in the pleadings show a right in the relator to have a writ of mandamus in its behalf as prayed for, and that he be hence dismissed.

JOHN S. SEYMOUR,
Commissioner of Patents,
By JOHN I. HALL, and
LEVIN H. CAMPBELL,
His Attorneys.

Motion to quash Commissioner's answer.

The State of South Carolina moved the Court to quash

the return to the alternative writ, in a motion of which the following is a copy:

Motion to quash, etc.

In the Supreme Court of the District of Columbia.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Petitioner*,
vs.
JOHN S. SEYMOUR, *Commissioner of Patents, Respondent.*
} *At Law.* *No. 34714.*

Now comes the relator, by its attorneys, and moves the court to quash the return made to the alternative writ herein issued, and direct the issuance of a peremptory writ, the said return being insufficient to justify the want of compliance with the mandatory part of the said alternative writ.

The grounds of this motion are the following among others:

1. The said return sets up no fact inconsistent with the allegations of the petition, to which it is in answer, except as the same is sought to be deduced by construction of law, thus raising no issue different from those already disposed of on consideration of the demurrer which was interposed to the said petition in answer to the rule to show cause that was herein issued.

2. It is not competent for the respondent to set up in said return (so as to make an issue thereon for trial by this court, if such he has attempted) that the relator, by its officers and agents, has not, as a matter of fact, used its trade-mark aforesaid in commerce with foreign nations:

(*a*) Because the record herein, to wit, the official opinion of the respondent, shows that the express ground of the respondent's refusal to register was the inability of its officers and agents to take it (the relator) into foreign trade, the said inability resulting, according to said opinion, from the terms and provisions of the law under which the relator claimed to be engaged in trade;

(*b*) Because the said record, to wit, the official opinion aforesaid, expressly states and admits that one case of relator's liquors were sold in Canada by the agents of the relator, and no demand or request was made by the respondent upon the relator to show a larger sale in the way of foreign commerce; and, the said opinion showing that the respondent based his action upon the construction of a statute, thereby waiving inquiry or proof in regard to foreign

sales, if any he was authorized to make in regard thereto outside or beyond the legal declaration required of relator by the trade-mark law, it is now too late for him to seek to ascertain the *quantum* of relator's foreign trade;

(*c*) Because it is apparent from the reading of the return aforesaid that the respondent's denial of a foreign trade to the relator is made as the result of a construction put by the respondent upon the statute under which the relator is engaged in trade;

(*d*) And because the return does not set up that the refusal of the respondent to register was the result of an insufficient foreign trade, but of an utter absence of such trade; and such contention, in the full light of the record, amounts but to an insistence by the respondent that this Court by entertaining these proceedings in permitting a ratification of acts which, according to the peculiar notions of the respondent, are *ultra vires* and which he (the respondent) does not think ought to be approved in any such way.

3. No material fact alleged in the petition is denied in said return except as the denial is a matter resting upon construction of law.

4. No fact (apart from legal construction) as alleged in said return, the existence of which, if established, would defeat the relator's right to the relief herein sought.

THE STATE OF SOUTH CAROLINA,
Relator.

By JOHN ALTHEUS JOHNSON,
JAMES EDGAR SMITH,
Its Attorneys.

The motion was granted by the Court and the return quashed, as will appear from the following copy of the Order therein:

Order quashing return, etc.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Petitioner,*
vs.
JOHN S. SEYMOUR, *Commissioner of Patents, Respondent.*
} *At Law.* *No. 34714.*

This cause coming on to be further heard upon the return herein filed to the alternative writ that was herein issued, and the motion to quash the said return and issue a peremptory writ, and the same having been argued by counsel.

It is thereupon, upon consideration by the Court, ordered, this 23d day of October, A. D. 1893, that the said motion to quash be, and the same hereby is, granted; and it is also further ordered, adjudged, and decreed that the relator is entitled to the registration at the Patent Office of the United States of its trade-mark, according to the statement and declaration now on file in the said office and set forth and exhibited in the petition herein, to wit, the word "Palmetto" as used in connection with chemically pure distilled liquors.

And the clerk of this Court is hereby directed to issue a peremptory writ of mandamus to the respondent, John S. Seymour, Commissioner of Patents, commanding him to register the said trade-mark of the relator in conformity with the act of Congress approved March 3, 1881, entitled "An act to authorize the registration of trade-marks and protect the same," and to make return to the office of the clerk of this Court within twenty (20) days from this day showing that he, the Commissioner aforesaid, has in all respects obeyed the commands of the said writ.

A. C. BRADLEY,
Justice.

Opinion of Justice Bradley.

Supreme Court of the District of Columbia.

THE UNITED STATES, *ex rel.* THE STATE OF SOUTH CAROLINA, *Petitioner*,
vs.
JOHN S. SEYMOUR, *Commissioner of Patents, Respondent.*

The relator, the State of South Carolina, has filed its petition in this matter, praying a writ of mandamus directing John S. Seymour, the Commissioner of Patents, to register a certain trade-mark which is fully described in the petition. Upon filing the petition, a rule to show cause was granted, and, upon the return day, the respondent filed his demurrer setting up as the principal ground thereof the claim that, by the petition, it appears that the act of the Commissioner, which is sought to be compelled by this proceeding, was one involving judgment and discretion, and therefore not the subject of mandamus.

The petition, in addition to the statement of the facts upon which the relator bases its claim to relief, refers to and makes a part of it the various acts of the Patent Office in relation to its application for registration from the time it

was filed, including the reason given by the principal examiner for rejecting the application, and the opinion of the Commissioner of Patents given at the time of his final rejection.

The petition, in its fourth paragraph, alleges that—

"The trade-mark aforesaid is lawfully used as such by the petitioner in foreign commerce; it is not merely the name of the petitioner; it is not identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, and it does not so nearly resemble any other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; there is no dispute between the petitioner and any previous registrant of a trade mark, or any applicant for registration; but the trade-mark of the petitioner aforesaid is altogether lawful, and the claim of the petitioner thereto, as owner and user thereof, is altogether just and legal; and the plain duty of the Commissioner of Patents in the premises is to register the said trade-mark."

The demurrer was overruled, and an alternative writ of mandamus granted. To that writ the respondent has made answer.

The peculiar character of the answer and the apparent argumentative confusion of matters of fact with matters of law render it necessary to take it by sections and compare it with the petition to ascertain what is admitted and what is denied.

The petition, in its first paragraph, alleges that by virtue of an act of the General Assembly, approved December 24, 1892, the State of South Carolina had assumed control of, and was then and is now, by virtue of said act, engaged in a traffic in intoxicating liquors; that it had since July 1, 1893, bought and sold and otherwise handled in the way of trade certain kinds of pure and unadulterated liquors, and that, in connection with the sale of such liquors, it had adopted a certain trade-mark, and had thereby become the owner of said trade-mark, as used in connection with such liquors

The respondent, in answer to that paragraph, admits a knowledge of the act of the Assembly of the State of South Carolina referred to, but denies that under and by virtue of that act the State of South Carolina was engaged in commerce with foreign nations at the time of its application for the registration of the trade-mark, and denies that the State of South Carolina was the owner of the alleged trade-mark used in commerce with foreign nations at the time of its application.

It is not denied that the trade-mark had been adopted and used as alleged in the first paragraph of the petition,

and it is not denied that the relator owned such trade-mark in connection with such liquors.

The second paragraph of the petition avers that the petitioner's trade-mark is a valuable right which it is desirous of protecting to the full extent of the law. As to that, the respondent answers that he has no knowledge as to the truth or falsity of the allegation.

The third paragraph of the petition avers that the trade-mark is used in commerce with foreign nations, and it then proceeds to state that, desiring to avail itself of the benefits of the act of Congress relating to the registration of trade-marks, it applied to the Commissioner of Patents for registration; that it has complied with all the requirements of the act; that it has paid into the Treasury of the United States the sum of twenty-five dollars, and filed with the Commissioner of Patents, the respondent, its statement and declaration as required by the act; and that it has in all respects complied with the provisions of the act and the regulations thereunder prescribed by the Commissioner of Patents. The statement and declaration, constituting the application, filed with the Commissioner, are inserted in full in the petition.

To this paragraph the respondent answers, admitting that the application had been filed by the relator for a certificate of registration, and that the fee of twenty-five dollars had been paid; that relator had filed its statement and declaration as required by the trade-mark act; but denying that the relator thereby complied with all the provisions of said trade-mark law, in that it was not the owner of the trade-mark used in commerce with foreign nations or with the Indian tribes.

In response to the fourth paragraph of the petition, which has already been quoted at length, the respondent says that he denied that the trade-mark could be used in foreign commerce, for the reason that the State acts through its officers, its agents; that the State, through its agents, can not use or become, by the illegal action of its agents, the owner of the alleged trade-mark in commerce with foreign nations or with the Indian tribes, their authority being limited to purchases and sales within the State, and, therefore, the relator is not the owner of the alleged trade-mark, used in commerce with foreign nations or with the Indian tribes, within the meaning of the trade-mark law, the State of South Carolina not being engaged in commerce with foreign nations or with the Indian tribes. He denies that the trade-mark is altogether lawful, and the claim of the petitioner just and legal, or that it is the plain duty of the Commissioner of Patents to register the trade-mark; but he admits all the other allegations of the fourth paragraph.

The fifth paragraph of the petition avers that the Commissioner of Patents has refused and still denies and refuses to register the trade-mark, thereby denying to the petitioner the plain right which, as owners of said trade-mark, it has to the registration under the law, and that the petitioner is thereby greatly injured and damaged, and has no other remedy in the premises than the one prayed for.

To this paragraph the respondent answers, admitting that he has refused and still refuses to register the trade-mark, because under the law it is his duty to decide the ownership of petitioner to the alleged trade-mark, as used in commerce with foreign nations or with the Indian tribes, and that in his sound judgment and discretion he has decided adversely to the registration, because the State of South Carolina is not the owner of the alleged trade-mark used in commerce with foreign nations or with the Indian tribes. He denies that by this refusal he has denied to the petitioner a plain right, and he further denies that the petitioner has been, at any time, so far as the respondent knows, the owner of a trade-mark used in commerce with foreign nations or with the Indian tribes. He denies that the petitioner is entitled to the registration of the trade-mark under the Federal trade-mark law. He denies that the Court has jurisdiction to compel the respondent to register the trade-mark because the decision whether said trade-mark can lawfully be registered or not, and whether the applicant is the owner of the trade-mark, involves discretionary duties upon the part of him, the respondent.

By paragraph six of the petition, as has been already stated, a copy of the trade-mark and of the request to the Commissioner of Patents to register it, and the subsequent communications received from the trade-mark examiner, and the opinion of the Commissioner of Patents, are referred to as filed with the petition and made a part of it. The respondent does not answer this paragraph.

It is clear by this answer that the respondent intends to be understood as having determined, as matter of fact (1) that the State of South Carolina is not the owner of this trade mark used in foreign commerce or in commerce with the Indian tribes, and (2) that it has never used this trade-mark in foreign commerce or in commerce with Indian tribes; but it is equally clear, not only by the careful reading of the answer itself, but by an inspection of the entire record, as made by the petition and the exhibits filed with it, that the respondent denies that the trade-mark has been used in foreign commerce by the applicant, or that the State is the owner of a trade-mark used in foreign commerce, because he construes the dispensary law of the State of South Carolina, which is referred to in the petition and in

the answer, as lacking in authority to the State to engage in foreign trade, and that, although he does not deny, as matter of fact, that the State of South Carolina is the lawful owner of this trade-mark, as used in connection with the sale of liquors within the State limits, or that it has been used in foreign commerce by its agents, yet, as matter of law, he determines that the State agents can not carry the State into trade, and, therefore, that the State is not engaged in trade, and does not own this trade-mark as used in foreign commerce.

It is the apparent purpose of the respondent to be understood as having decided adversely to the relator two questions which he claims are, by the act of Congress, committed to his judgment and discretion, and that his decision upon these two questions is a decision of fact. But, if the answer of the respondent be taken in connection with the action of the trade-mark examiner, and his own action, as indicated by the copy of his opinion filed with the petition, it will be seen that his refusal to register this trade-mark is based upon a conclusion of law, and not of fact. By the action of the examiner, a copy of which is filed as Exhibit D with the petition, it is plainly made to appear that upon his examination of the application for the registration of the trade-mark, the only basis of his rejection was that it was unique in the character of the applicant. He says: "There is no objection to the trade-mark presented; but the case is a novel one in respect to the character of the applicant. * * * The only objection that has been made is that a State of the American Union is not a corporation as contemplated in the act of March 3, 1881, for the registration and protection of trade-marks."

By Patent Office Rule No. 10, relating to the registration of trade-marks, it is provided that "All applications for registration are considered in the first instance by the trade-mark examiner." By this action the examiner decided that the requirements of the act of Congress had been satisfied; that the office regulations had been complied with; and that, if a State can register a trade-mark, this applicant was entitled to register this trade-mark. He rejected the application solely on this ground. If he had not taken this position, it may be assumed from his relation to cases of trade-mark that this application would have been granted.

Upon an appeal being taken to the Commissioner, in person, after full argument, this ground of objection was abandoned by him as untenable, and he rejected the application upon a new ground. He says:

"It seems that a State of the American Union, having all the powers of an independent sovereign State except those surrendered to the Federal Government, has the inherent

right, as a State, to engage in trade, domestic or foreign." He, however, proceeds to examine the legislation known as the dispensary act of the State of South Carolina, under which the right to engage in traffic in intoxicating liquors was conferred, and determines that, by that act, the agents of the State are not authorized to enter into foreign commerce. He says that "even if it should be held that the State could enter the field of commerce, it must be held, at the same time, that the State has not done so by the legislation before him." He says further "Neither the Governor nor the State board of control provided for in this act can, by any act of theirs, even in the name of the State, take the State into trade." He concludes finally in these words: "It is considered that the State of South Carolina, notwithstanding the acts of its Governor and State board of control, has no authorized trade in liquors outside its own limits; is not the owner of any trade-mark; has not, at this time, the right to the use of the trade-mark sought to be registered; and, therefore, the application is denied."

To sum up the answer, giving effect to admissions to be read between the lines, and regarding as admitted such averments of the petition as are not denied, it appears to me that it is conceded that the State of South Carolina has adopted and used the trade-mark in controversy in legitimate business within the limits of the State, and, therefore, is the owner of the trade-mark at common law. It is admitted that the agents of the State of South Carolina have used this trade-mark in connection with the sale of liquors to a foreign country, and that, if such had been the act of an individual or of a trading corporation, he or it would have a right, under the law, to register this trade-mark. It is admitted that all the requirements of the law and of the regulations of the Patent Office have been complied with by the relator, and it is effectively and plainly shown, although not frankly stated, that the only ground of the refusal of the respondent is that under the dispensary act, as construed by him, the officers of the State have no power or authority to carry the State into foreign trade, and that the State, whatever its officers may have done, had not used this trade-mark in foreign commerce.

So understanding the issue as made by the respondent, as the basis of his refusal to register the trade-mark for the relator, it becomes necessary to determine whether the refusal of the respondent is a denial of a legal right conferred by law upon the relator, or whether it is the determination of a question involving judgment and discretion committed to him by the law, and as such, therefore, not subject to the review or control of the Court.

The act of March 3, 1881, provides that "owners" of trade-

marks used in commerce with foreign nations or with the Indian tribes * * * may obtain registration of such trade-marks by complying with the following requirements:

1. By causing to be recorded in the Patent Office a statement specifying certain facts, containing a description of the trade-mark, with facsimiles.

2. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents.

Next, this act requires that the application described in the preceding section must be accompanied by a written declaration to the effect that the party has, at the time, a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or with the Indian tribes; and that the description and facsimile presented for registry truly represents the trade-mark sought to be registered. By section 3 it is provided that the time of the receipt of any such application shall be noted and recorded, and no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce, or in commerce with the Indian tribes as above mentioned; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.

This third section further provides that "in an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between the applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases."

The respondent claims that he is to determine, under the provisions of this section, whether the alleged trade-mark appears to be lawfully used as such by the applicant in foreign commerce, and that the proper construction of that language imposes upon him the duty of ascertaining, not only whether the applicant has the lawful right to use the trade-mark as such, but also whether the applicant is, not only in fact but also lawfully, engaged in foreign trade, and using the trade-mark in foreign commerce. I do not apprehend that Congress ever intended to impose upon the Com-

missioner of Patents the burden of such an inquiry as the ascertainment and determination of the question whether the applicant was lawfully engaging in foreign commerce. As I understand it, the duty is imposed upon the Commissioner to ascertain, prima facie, whether the applicant is lawfully entitled to use the trade-mark sought to be registered, and, in the next place, to ascertain from the showing that is made to him whether that trade-mark, so lawfully used by the applicant, is used in foreign trade.

In the absence of any controversy over the ownership of the alleged trade-mark, arising either out of a claim of right to the same trade-mark by some other applicant, or out of information within the reach of the Commissioner of Patents as to the use of such trade-mark by some other person in a similar connection, the information upon which the Commissioner of Patents is to act is that which is contained within the statement and declaration required by the first and second sections of this act to be made and filed.

It is also claimed by the respondent that the provision that the Commissioner of Patents shall decide the question of the presumptive lawfulness of the claim to said trade-mark, means that the law has conferred upon the Commissioner of Patents the discretionary power to reject the application for the registration of a trade-mark upon any ground that may seem to him meet and proper. It would seem, however, to be clear that the meaning of that provision, taken in connection with the succeeding and concluding part of the sentence, is this: That the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark when anything within his information indicates that the applicant has not a lawful right to claim the ownership, and whenever that ownership is disputed by another applicant, or a previous registrant. In these cases the Commissioner of Patents shall decide the presumptive lawfulness of claim of ownership, and in such controversy, so far as possible, he must follow the practice of courts of equity of the United States. That this is the true construction of this section would appear to be supported by the provision of section 7, that the "registration of a trade-mark shall be prima facie evidence of ownership"—not prima facie evidence of use in foreign commerce, or prima facie evidence of ownership of a trade-mark that had been used, or was used, in foreign commerce; but prima facie evidence solely of ownership. That is to say, the trade-mark law, by conferring the right upon owners of trade-marks used in foreign commerce to register the same with the Commissioner of Patents upon complying with certain provisions of law conferred upon the registrant no new right of property in the trade-mark itself, but attached to his cer-

tificate of registration a mere presumption of ownership of the trade-mark—an ownership, not in the sense of having used the trade-mark in foreign commerce, but the ordinary ownership of a trade-mark used in connection with trade in a certain class of goods. This presumption is of value to the registrant, independently of any provision of law which authorizes suit to be instituted in the United States courts solely on the fact that the burden of proof is, by the law, in an action for the infringement of the registered trade-mark, imposed upon the defendant who desires to assail the right of ownership. It would seem to be clear that if Congress intended that the function of the Commissioner of Patents in the registration of a trade-mark should extend to the determination of any question beyond that of mere presumption of ownership, it would have provided that the effect of registration should be prima facie evidence of something more than ownership. The scope of the legal effect of registration must be as full in its elements as the duty of investigation. That registration does not determine even presumptively the fact of use in foreign commerce, appears clearly by the provisions of section 11: "That nothing in this act shall give cognizance to any court of the United States in any suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe," thereby imposing upon the registrant of a trade-mark, where the suit is between citizens of the same State and is brought in a court of the United States, the burden of establishing that the trade-mark in controversy is used in foreign commerce or in commercial intercourse with an Indian tribe.

Nowhere in this act is any duty of examination into the facts required to be stated in the application for registration imposed upon the Commissioner of Patents. The only matter that is expressly committed to his decision is "the presumptive lawfulness of claim to the alleged trade-mark," and that is in immediate connection with the provision that, in any dispute between the applicant and another claimant, he shall follow the practice of the courts of equity.

Exactly why, in the absence of controversy or dispute between adverse claimants for the same right, the Commissioner of Patents should enter upon an investigation of the truth of any of the statements or declarations required by law to be made as conditions to registration is not perceived, unless it be for the purpose of rendering some labor in the nature of an equivalent for the fee of $25 required; for the United States confers no prerogative by the act of registration; it parts with nothing; the resident trade-mark owner

has no clearer title, no more absolute right of property, with than without the act of registration.

By paying his fee, the registrant receives a certificate that carries with it a presumption of ownership of the trade-mark, and entitles him to sue a citizen of his own State in a circuit court of the United States, provided he proves that the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe. In every other particular the rights of the owner of an unregistered trade-mark are as complete, his remedies for infringement are as full, and his use of the courts as free, as are those of a registrant.

The act of registration settles no right. Section 8 of the law provides that no suit shall be maintained under its provisions "when the trade-mark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained." Section 9 provides that "any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fradulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case."

The case of the grant of letters patent for inventions and discoveries, the duties imposed by law upon the Commissioner of Patents in that connection, and the effect of such grant, referred to in the argument for respondent as analogous to the matter in hand, appear to be quite different. By the issuance of letters patent, the exclusive right to manufacture and sell the thing patented is given for a term of years. A property right is created, which exists only by virtue of the law. Section 4893 of the Revised Statutes of the United States with reference to applications for patents is as follows:

"On the filing of any such application, and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if, on such examination, it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

Here the duty of examination is expressly imposed upon the Commissioner of Patents, and the letters patent are to be granted only in the event it appears upon such investigation that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and im-

portant. The presumptions that follow the grant of letters patent are as large and as numerous as are the elements of examination required of the Commissioner. The law imposes upon the person who assails such exclusive grant of property the burden of proving the lack of some one element essential to make the grant valid. The grant is the fruit of investigation which is "essentially judicial in its character." "That it was intended that the Commissioner of Patents, in issuing or withholding patents, in reissues, interferences, and extensions, should exercise quasi judicial functions, is apparent from the nature of the examinations and decisions he is required to make." Butterworth *v.* Hoe, 112 U. S., 50, 59, 67.

These important functions of the Commissioner in the matter of granting letters patent are imposed by reason of the fact that there are two parties to every application for a patent, the public, who are the grantors, and derive advantage from the disclosure and use of the invention, and the patentee, who is rewarded for his invention by the grant of a limited monopoly. Butterworth v. Hoe; Ibid., 59.

Very different is the case of mere record of an arbitrary symbol adopted by a trader as a mark for his goods, the registration of which confers no benefit upon the public, is of value only to the registrant, and to him affords the scant benefit of a legal presumption of ownership. There does not appear to be any reason why the Commissioner should be called to the exercise of any judgment or discretion in the granting or refusing of such registration, and it would seem that the right of the owner to register his trade-mark, if he has used it in foreign commerce, is absolute upon compliance with the provisions of law.

Chief Justice Marshall, in his celebrated exposition of the law of mandamus as applied to the executive officers in the case of Marbury *v.* Madison (1 Cranch), after stating that "questions in their nature political, or which are by the constitution and laws submitted to the executive * * * where the head of a department acts in a case in which executive discretion is to be exercised * * * any application to a court to control in any respect his conduct would be rejected without hesitation," proceeds, "but where he is directed by law to do a certain act affecting the absolute right of individuals, in the performance of which he is not placed under the particular direction of the President, and the performance of which the President can not lawfully forbid * * * as for example to record a commission, or a patent for land, which has received all the legal solemnities, or to give a copy of such record; in such cases, it is not perceived on what ground the courts of the country are further excused from the duty of giving judgment, that right

may be done to an injured individual, than if the same services were to be performed by one not at the head of a department." "It is not by the office of the person to whom the writ is directed, but by the nature of the thing to be done, that the propriety or impropriety of issuing a mandamus is to be determined."

I am of opinion that the duty of registration of a trade-mark by the Commissioner of Patents is such a one that, in a case where the right is denied to an applicant who has complied with the provisions of the law and the regulations of the Patent Office, its performance can be compelled by mandamus. Had the respondent in this matter admitted that the relator had made the statement and declaration required by law, paid the fee, and complied with the office regulations, but based his refusal to register the trade-mark exclusively upon the ground that in his judgment the relator, as a body politic, could not be included in the term "owner," used by the law in designating those who are entitled to its benefits, the writ prayed would necessarily follow, for the law fixes the right, and the respondent has no discretionary power, either wilfully or erroneously, to disregard it. That would have been this case had the Commissioner adhered to the examiner's reason for rejection. Does he occupy any stronger position when he makes all of these admissions, concedes that the relator is included among those who can claim the benefit of the act as an owner, but denies the registration because, in his judgment, although it appears by the oath of the chief executive of the State of South Carolina "that said trade-mark is used by the said State in commerce with foreign nations and particularly with Canada," the State of South Carolina is not authorized by the dispensary act to engage in foreign trade, and, therefore, it has not used the trade-mark in foreign commerce, whatever its agents may have done? The respondent says that the law has imposed upon him the duty of determining whether the relator used the trade-mark lawfully in foreign commerce, and he is, therefore, called upon to decide whether the relator could lawfully engage in foreign commerce. The language used in the law is "no alleged trade-mark shall be registered unless it appear to be lawfully used as such by the applicant in foreign commerce." Clearly this word "lawfully" relates to the character of the right of the applicant to the use of the trade-mark, and not to the character of the foreign commerce. It is the fact of use in foreign commerce that must appear in conjunction with the right to use as owner. If use in foreign commerce de facto appears, it is not within the province of the Commissioner to question whether such foreign commerce in the case of the relator is not *de jure*, or to adjudge that it is *ultra vires*

the relator. That question must be left to the determination of the courts in a proper case, and to the people of the State of South Carolina. It is a matter in which the United States and the respondent, and the public generally, have no interest or concern. How, then, does the matter stand? The relator owns the alleged trade-mark, uses it in its business, has used it in foreign commerce, has complied with the requirements of the trade-mark law and the regulations of the Patent Office. All of this appears in the record, notwithstanding the equivocal and argumentative denials of the respondent that the relator is the ower of the trade-mark as used in foreign commerce, and that relator used the same in foreign commerce, quite as plainly, though not as briefly, as it would appear had the respondent frankly stated (the fact) that his only ground of rejection was the want of authority in the relator to engage in foreign commerce. Concede that the respondent has discretion under the law to determine the question of ownership of the trade-mark, and the question of its use by the applicant in foreign commerce. He has exercised his discretion and finds the applicant in every particular element of requirement of fact and form entitled to registration, but he refuses to perform the act for an insufficient reason. It would serve no useful purpose to attempt to analyze the well-known decisions of the Supreme Court of the United States in cases of mandamus against executive officers, or to seek to draw the line between duties involving discretion and those merely ministerial. The law is well settled. The difficulty in such cases is not in the law, but in the facts "indicating the nature of the thing to be done."

Chief Justice Chase has thus defined a ministerial duty: "A ministerial duty, the performance of which may, in a proper case, be required of the head of a department by judicial process, is one in respect of which nothing is left to discretion. It is a simple, definite duty arising under conditions admitted or proved to exist and imposed by law." Miss. *v.* Johnson, 4 Wall., 475, 498.

In the case of Butterworth *v.* Hoe (supra) it was held that the Commissioner of Patents exercises quasi judicial functions, and yet it appearing that the Commissioner had refused to receive the final fee, to prepare or issue the letters patent, or to take any further steps in the matter, because, having decided that the relator was entitled to his patent, his decision had been reversed by the Secretary of the Interior, the Court held that the Secretary had no appellate power or power in the premises, to review or reverse the decision of the Commissioner, and that mandamus was the proper remedy. The Court, by Justice Matthews, said (p. 68): "Some question is made as to the remedy. We think,

however, that mandamus will lie, and that it was properly directed to the Commissioner of Patents. He had fully exercised his judgment and discretion when he decided that the relators were entitled to a patent. The duty to prepare it, to lay it before the Secretary for his signature, and to countersign it, were all that remained, and they were all purely ministerial. These duties he had failed to perform merely out of deference to the claim of the Secretary to reverse and set aside the decision on the merits in favor of the relators. This we have held not to be a valid excuse. The case falls clearly within the principles acted upon in Commissioner of Patents *v.* Whitely, 4 Wall., 522."

In the case mentioned the Court held that the writ of mandamus "lies where there is a refusal to perform a ministerial act involving no exercise of judgment or discretion."

The nature of the act remaining to be performed by the respondent in the matter of the application of the relator does not involve discretion. He had exercised and exhausted his discretion. Nothing remained to be done but "a simple, definite duty arising under conditions admitted to * * * exist and imposed by law." This duty he has failed to perform because he says that he has decided that the act of engaging in foreign commerce is *ultra vires* the relator. I am of opinion that this is not "a valid excuse." The peremptory writ of mandamus will issue.

A. C. BRADLEY,
Justice.

The Commissioner appeals.

From the order and judgment of the Supreme Court of the District of Columbia, in special term, directing a peremptory writ to issue to him, the Commissioner of Patents appealed to the Court of Appeals of the District of Columbia, to correct the said order and judgment.

The assignments of error to the Court will appear in the opinion of the Court of Appeals.

Decision of the Court of Appeals.

The Court of Appeals for the District of Columbia reversed the order and judgment of the Supreme Court of the District of Columbia and dismissed the petition for the writ of mandamus to issue to command the Commissioner of Patents to register the alleged trade-mark, as applied for.

Court of Appeals of the District of Columbia.

THE UNITED STATES *ex rel.* THE STATE OF SOUTH CAROLINA,
vs.
JOHN S. SEYMOUR,
Commissioner of Patents.

Decided February 5, 1894.

SHEPHARD, J.:

This case comes before us on appeal by the Commissioner of Patents from the judgment of the Supreme Court of the District of Columbia, in special term, ordering a peremptory writ of mandamus to issue, commanding him to register a trade-mark on the application of the State of South Carolina.

On July 15, 1893, Benjamin R. Tillman, Governor of the State of South Carolina, on behalf of said State, filed an application in the office of the Commissioner of Patents for the registration of a trade-mark used in the sale of intoxicating liquors, consisting of the word "Palmetto."

A facsimile of the label upon which this word is used was filed with the application. It has ornamented borders, within which appears the word "Palmetto," printed above the coat of arms of the State of South Carolina. Underneath this is a "name-band," upon which may be printed the words "Bourbon Whisky," "New England Rum," or other designations, according to the kind of intoxicating liquor contained in the package upon which the label may be applied.

The application is in the ordinary form recommended for use by private corporations by the rules and regulations of the Patent Office, and is verified by an affidavit in the following words:

> Benjamin R. Tillman, being duly sworn, deposes and says that he is the Governor of the State of South Carolina, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said State at this time has a right to the use of the trade-mark therein described; that no other person or firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the said trade-mark is used by the said State in commerce with foreign nations or Indian tribes, and particularly with Canada, and that the description and facsimiles presented for record truly represent the trade-mark sought to be registered.

According to the rules of the office, the application was submitted to the special examiner for investigation and report, who, without going into the merits, reported adversely on the ground that a State of the Union is not within the

terms of the law permitting the registration of trade-marks, because it does not come within the designation of "person" or "corporation" as used therein.

The application then came before the Commissioner in person, and was presented with elaborate argument on behalf of the applicant. He refused it on August 30, 1893, with a written statement setting out his reasons therefor, which concludes as follows:

> It is considered that the State of South Carolina, notwithstanding the acts of its Governor and State board of control, has no authorized trade in liquors outside its own limits, is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered, and therefore the application is denied.

Importance was sought to be attached to the report of the examiner by counsel for the relator on the argument; but we can see no good reason therefor. It is but the report of a partial examination made by a subordinate, and forms no part of the Commissioner's decision.

In fact, he has expressly overruled the point made by the examiner, and based his decision upon other and entirely distinct grounds which were not even alluded to in the examiner's report.

The Commissioner's decision shows that evidence was received by him in the course of his inquiry into the lawfulness of the State's claim to the use of the trade-mark. It is apparent that the dispensary act of South Carolina, under which the right to carry on trade in liquors is claimed by the State, was submitted for the consideration of the Commissioner, together with proof that the State board of control created by said act had adopted the trade-mark on July 1, 1893.

It appears also that proof was made with respect to the foreign commerce of the State in liquors, from the following paragraph of the decision:

> As the present legislation of Congress on trade-marks is restricted to those used in commerce with foreign nations or with the Indian tribes, the authorities have sold a case of the State liquors, bearing this trade-mark, in Canada, and it is claimed that thus the trade-mark has been used by the State in commerce with foreign nations.

After a motion for rehearing had been overruled by the Commissioner, this petition for mandamus was filed in the Supreme Court of the District.

All the proceedings in the office of the Commissioner were made exhibits to the petition, including the elaborate printed arguments of the counsel for the applicant that had been submitted for his consideration.

Upon the service of the alternate writ the Commissioner appeared and submitted a demurrer to the petition, which

was overruled. He then made return by way of answer, setting out the grounds of his refusal to register substantially as contained in his decision, and questioning, as he had done by his demurrer, the right of the Court to revise or control his action in the premises.

This answer was held insufficient on motion of the relator, and a peremptory mandamus ordered to issue to compel the Commissioner to register the trade-mark as applied for.

Several errors have been assigned; but the points upon which the case turns, and to which the argument has been directed, are raised in the third and sixth of the series.

The third is to the point that the duties of the Commissioner, as prescribed by law, are not ministerial simply, but are such as to call for the exercise of judgment and discretion, and that his decision, having been made in the performance of this discretionary duty, is not subject to revision by the courts.

The sixth is to the effect that the State of South Carolina is not entitled to have this trade-mark registered because she is not, and can not be, lawfully engaged in foreign commerce.

There ought to be but little difficulty in the determination of the true office of the mandamus as applied in the Federal courts.

The decisions of the Supreme Court of the United States are numerous and state with perfect agreement the principles which should govern the proceedings of the courts in applications therefor.

Mr. Justice Miller, speaking for the court in Gaines *v.* Thompson (7 Wall., p. 348), said:

> The extent of the jurisdiction which may lawfully be asserted by the Federal courts over the officers of the executive departments of the Government, has been mooted in this Court from the case of Marbury *v.* Madison down to the present time; and while the principles which should govern the action of the courts in that regard have been settled long since, the frequent application of late to this Court and to other Federal courts, for the exercise of powers not belonging to them, shows that the question is one not generally understood.

And we might add the number of cases reported since that time shows that this misunderstanding has not ceased to exist.

It is settled beyond question that mandamus will not lie, save in a plain case and where there is no other legal remedy. And this, it may be, has caused some of the prevailing misunderstanding of another—a still more important—principle, that is equally well settled—viz, that under no circumstances can the writ of mandamus be made to operate as a writ of error.

To the judiciary department is intrusted, generally, the

interpretation of the laws, the determination of rights, and the application of remedies, and with the strong sense of their duties and obligations in this regard it is sometimes difficult for the courts to properly appreciate the fact that the executive department is charged with perfectly independent duties, not alone by the supreme law, but also by legislation thereunder, which require the ascertainment of facts, involve the interpretation of laws, and in many respects call for the exercise of judgment and discretion by officers who are not required to be lawyers. And this independence is so complete that no matter how gross an error may be committed or however ill-advised the action of an executive officer may be in the execution of these duties the courts are, nevertheless, powerless to interfere where no appeal to them is given. Public and private interests may suffer in instances, and rights may sometimes be denied; but these alone do not authorize the interference of the courts with the duties of executive officers.

Greater evils could not exist under our system of government than would follow the usurpation by the judiciary of powers not intrusted to them.

Where the duty prescribed is plain and specific, admitting of no discretion, calling for the exercise of no judgment, and the officer charged therewith refuses to perform it, to the injury or the deprivation of the right of another, mandamus will lie to compel him to its performance. It will lie where the duties are discretionary or even strictly judicial, never, however, to revise action that has been taken, but to compel reception and consideration or the taking of jurisdiction, provided that when action shall have been taken the party aggrieved thereby would then have the right to appeal from the decision.

The two leading cases in the Supreme Court in which the question of mandamus to executive officers has been considered are Kendall *v.* Stokes (12 Pet., 524), and Decatur *v.* Paulding (14 Pet., 497). In the first of these the mandamus was ordered, while in the second it was refused.

The subsequent cases—

said Justice Bradley, in U. S., *ex rel.* Dunlap *v.* Black (128 U. S., p. 45)—

have followed the principles laid down in these and do little more than illustrate and apply them * * * The principle of law deducible from these two cases is not difficult to enounce. The Court will not interfere with the executive officers of the Government in the exercise of their ordinary official duties, even when those duties require an interpretation of the law, the Court having no appellate power for that purpose; but when they refuse to act in this case at all, or when by special statute or otherwise a mere ministerial duty is imposed upon them—that is, a service which they

are bound to perform without further question—then, if they refuse, a mandamus may be issued to compel them.

It is by—

the nature of the thing to be done that the propriety or impropriety of issuing a mandamus is to be determined.

The distinction between official acts and duties that are ministerial and those which are judicial or *quasi* judicial, which has been established by the great weight of authority, may be stated as follows: Where the law commands the doing of a specific thing and charges an officer with its execution in terms so plain and certain as to leave him no reasonable alternative but obedience, the act may be said to be ministerial simply. Where, on the other hand, the act involves the exercise of discretion in determining whether the right exists, a duty is required to be performed in the particular case and it ceases to be ministerial and becomes *quasi* judicial.

It is necessary now to examine the statute under which the right is claimed in this case and to determine whether the duties prescribed therein for performance by the Commissioner are ministerial simply or discretionary.

In the first place it may be said of the trade-mark act that no appeal lies to this court from the decision of the Commissioner refusing registration as it does in the case of refusal of a patent, and we have recently held in Einstein *v.* Sawhill (65 O. G., 1918), that the right of appeal does not exist from decisions made in cases of dispute between applicants for registration. In that case Mr. Justice Morris, who spoke for the Court, had occasion to review the legislation of Congress on the subject of trade-marks and explain the cause of the substitution of the elaborate legislation of previous years by the restricted act of March 3, 1881, which limits the registration of trade-marks to such only as may have been actually used in commerce with foreign nations or the Indian tribes.

Section 1 of this act provides that—

owners of trade-marks used in commerce with foreign nations or with the Indian tribes may obtain registration thereof by causing to be recorded in the Patent Office a statement specifying the name, location, citizenship, etc., of the party applying, the class of merchandise and description of goods in each class to which the mark is appropriated, a description of the trade-mark, with facsimiles thereof, and the mode in which it is applied to goods, and the length of time during which it has been used. In addition the applicant must pay a fee of twenty-five dollars and comply with such regulations as may be prescribed by the Commissioner of Patents.

Section 2 requires that the application be accompanied by a declaration under oath to the effect that the applicant has at the time the right to the use of the trade-mark; that

no other person or firm, etc., has the right to such use, either in identical form or in such near resemblance as might be calculated to deceive; that it is used in commerce with foreign nations or Indian tribes, and that the description and facsimiles presented truly represent it.

Section 3 reads as follows:

That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with the Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power, nor which is merely the name of the applicant, nor which is identical with a registered or known trade-mark of another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the public or to deceive purchasers. In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark, and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

The remaining sections of the statute are not of sufficient importance in the consideration of the question to be set out here, but may be referred to hereafter.

We think it plain that the duties of the Commissioner are something more than ministerial and that they differ widely from the duties of a mere register of deeds or receiver of papers for file, with which an attempt has been made to institute a comparison.

A trade-mark that may have been in undisputed use for years in domestic trade and invested with all the characteristics of a trade-mark good at common law is, nevertheless, not a trade-mark in the sense of this statute unless it shall have been lawfully used in commerce with foreign nations or the Indian tribes. The Commissioner is required to decide "the presumptive lawfulness of claim to the alleged trade-mark." This, in connection with the preceding portion of the third section aforesaid, can mean nothing less than that in all cases he shall inquire, first, if the applicant has actually used the trade-mark in lawful commerce with foreign nations or with the Indian tribes, and then if he has the right to the use of it at all.

If he finds that the "alleged trade-mark" is the name of the applicant or any other name which can not lawfully be converted into a trade-mark at common law, or that it is identical with the trade-mark of another, registered or unregistered, or is a deceptive imitation of another, or that it is not the property of the applicant, he can not admit it to registration, though he may be satisfied that the applicant has used it in regular commerce with foreign nations or the Indian tribes.

So, likewise, he may be satisfied with the lawfulness of the applicant's ownership and right to the use: but unless it be made to appear, also, that he has lawfully used it in actual commerce with foreign nations or the Indian tribes the registration must be denied.

No provision is made as to how the Commissioner shall inform himself with respect to the existence of these conditions; but the fact that he is authorized to make regulations and that applicants are required to comply with them would seem necessarily to imply that he is left free to institute the necessary inquiry in his own way. This he appears to have done in this case, for his decision refers to matters of fact considered by him which do not appear in the application and verification thereof. Certain rules and regulations have been made by the Commissioner, as shown in the record, and by one of these he has added to the requirements of section 2 in this, that the verification of the application must show not only in general that the trade-mark is lawfully used in commerce with foreign nations or the Indian tribes, but also one or more of these, by name, with which the commerce is carried on. This regulation has been in force for a long time, and was followed in this case without question, for in the verification of relator's application it is said—

> the said trade-mark is used in commerce with foreign nations or Indian tribes, and particularly with Canada.

Why require this specification of the name of one or more of the foreign nations or Indian tribes with which commerce is had unless it is to aid the Commissioner in the investigation of the truth of the statement should he deem the same necessary or proper?

The particular and only value of this required specification consists in the facility which it may afford the Commissioner in ascertaining if the trade-mark is lawfully so used.

It is contended that, inasmuch as the last clause of section 3 provides for the manner of trial as in courts of equity, so far as applicable, in the event of dispute with a previous registrant or a rival applicant, it necessarily covers and provides for the only contingency in which the Commissioner is authorized to exercise any discretion whatever.

This clause only provides the practice that shall prevail in the event that an actual contest shall be made by rival registrants or applicants, and is in no wise inconsistent with the idea that where there is no contest the Commissioner may make the necessary inquiry into the existence of all the facts necessary to registration in any manner that he may deem adequate to that end. "The presumptive lawfulness of claim," which he is called on to decide, is in express

accord with the provision of section 7, which makes the registration "*prima facie* evidence of ownership."

This limitation of the effect of the Commissioner's decision is claimed also as supporting the relator's contention; but we can see nothing, either in its letter or spirit, which goes to show that the Commissioner's action in the premises is to be without the exercise of discretion. His determination, either with or without contest, is not made conclusive for the better reason, and one more in accord with the spirit of our institutions, that it would be unwise, and probably unjust, to leave the final determination of what may be a valuable right of property, without respect to the registration, to an executive officer from whose decision there is no appeal.

The contention of the relator in its last analysis is that when a verified application is presented to the Commissioner, and there is no contest depending between the applicant and other parties, there is nothing left to his discretion, and it becomes his imperative duty to issue the certificate of registration.

The reasonable interpretation of the law, in our opinion, is that if there be a contest the Commissioner shall try the same in accordance with the practice of courts of equity, so far as applicable.

But if there be no contest between opposing parties he may accept the sworn declaration as sufficient if he have no cause to suspect its untruth, or he may, in the exercise of his discretion, inquire into the truth of its allegations; and in the event that he should have reasonable ground to suspect than an imposition has been attempted it would seem to be nothing more nor less than his duty to make an investigation.

The weakness of relator's contention is further illustrated by the preceding clause of the same section, which expressly prohibits the registration of a trade-mark which is not lawfully used in foreign commerce, or which is identical with a registered or known trade-mark of another, or which so closely resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

If Congress had intended to make the duty of the Commissioner, where the application is uncontested, ministerial only, it would seem that instead of requiring him to deny registration if certain facts appeared, it would have commanded him to issue the certificate without question upon the presentation of the verified application.

Counsel for relator admitted on the argument that it has been the custom of the successive Commissioners to keep in the office, as far as practicable, all trade-marks in use

that have not been registered, for the purpose of comparison with those presented for registration, and to deny registration where it was apparent that the applicant had adopted one of these known trade-marks, or a deceptive imitation thereof, even though the owner of the same made no appearance and entered no objection, nor would they deny that it was his duty to do so.

The Commissioner being, as we have seen, required to deny registration where the alleged trade-mark is the counterfeit or deceptive resemblance of another, or where it is not lawfully used in commerce with foreign nations or the Indian tribes, how is he then to discover this counterfeit or unlawfulness of use if he is not authorized to look beyond the application and verified statement and determine, *aliunde*, the rightfulness of the claim to registration?

Suppose an application is presented to the Commissioner the allegations of which he knows to be untrue. Is he, notwithstanding this knowledge, to register the falsehood and give presumptive lawfulness to the fraud? For example, the application in this case—inadvertently, of course, and probably through following a printed form—states that this trade-mark is used in commerce with the Indian tribes, as well as with Canada. Now, suppose this application had stated solely that the trade-mark applied for was used in commerce with the Indian tribes. Would the Commissioner be bound to register it, notwithstanding the laws of the United States expressly prohibit commerce in liquors with these tribes?

Suppose the laws of Canada, in which as evidence of commerce it was shown a case of liquors stamped with this trade-mark had been sold, should be found to prohibit the importation of liquors or the sale thereof within her territorial limits. Would the Commissioner be compelled to disregard the fact and abet the violation of the laws of a friendly nation by registering the trade-mark?

If a private corporation, through its president, should apply for the registration of a trade-mark with due formality, and the Commissioner, upon examination, should find that it was prohibited by law from carrying on commerce outside of the State of its creation, would he be required to ignore this knowledge and give effect to the unlawful use of the trade-mark by the corporate agents?

In this case the State of South Carolina presented a copy of its dispensary act to the Commissioner as the authority of the State board of control for selling a case of the State's liquors in Canada.

The Commissioner, upon inspection of the law, concluded that by its terms the State was confined exclusively to the sale of liquors within her own limits, and that her officers

had no power to carry on commerce in liquors in her name with Canada or any other foreign nation.

Grant that his decision on this and other points was erroneous; still the construction of these laws was a matter submitted to his discretion, and for the exercise thereof he is not responsible to the judicial power.

That the action of a head of a department, in construing a law for his guidance, is not subject to revision by mandamus was expressly ruled in Decatur *v.* Paulding (14 Pet., 497), where Chief Justice Taney, speaking for the Court, said:

> The duty required by the resolution, was to be performed by him (the Secretary of the Navy) as the head of one of the executive departments of the Government, in the ordinary discharge of his official duties. In general such duties whether imposed by act of Congress or by resolution, are not mere ministerial duties. The head of an executive department of the Government, in the administration of the various and important concerns of his office is continually required to exercise judgment and discretion. He must exercise his judgment in expounding the laws and resolutions of Congress, under which he is from time to time required to act. If he doubts, he has a right to call on the Attorney-General to assist him with his counsel; and it would be difficult to imagine why a legal adviser was provided by law for the heads of the departments, as well as for the President, unless their duties were regarded as executive, in which judgment and discretion were to be exercised. If a suit should come before this Court, which involved the construction of any of these laws, the Court certainly would not be bound to adopt the construction given by the head of a department. And if they supposed his judgment to be wrong they would, of course, so pronounce their judgment. But their judgment upon the construction of a law must be given in a case in which they have jurisdiction, and in which it is their duty to interpret the act of Congress in order to ascertain the rights of the parties in the cause before them. The Court could not entertain an appeal from the decision of one of the Secretaries, nor revise his judgment in any case where the law authorized him to exercise discretion or judgment. Nor can it by mandamus act directly upon the officer, and guide or control his judgment or discretion in the matters committed to his care, in the ordinary discharge of his official duties. The case before us illustrates these principles and shows the difference between executive and ministerial acts.

In that case the widow of Commodore Decatur claimed and received a pension under a general act of Congress and claimed another under the provisions of a special resolution for her benefit. There was no dispute over the facts. The Secretary, under his construction of the law, denied the pension and the Court refused the mandamus. What is said in that case of the Secretary applies equally to the Commissioner of Patents, who is at the head of a department.

In U. S. *ex rel.* Dunlap *v.* Black, which we have cited above, mandamus to the Commissioner of Pensions was applied for. The relator, through ignorance or misapprehension, made application for a pension under an act of 1877 and was rated at thirty-six dollars per month, when

his disabilities were such as clearly to entitle him, had he applied under the act of 1874, to fifty dollars per month. By act of 1880 it was provided that all those at the date of the act receiving pensions at fifty dollars per month, as provided in the act of 1874, should receive seventy-two dollars per month from January 17, 1878.

Relator's application for this increase was denied; but he was then placed on the roll under the act of 1874, entitling him to fifty dollars per month. The Commissioner denied his claim on the technical ground that, not having been actually rated under the act of 1874, he was not entitled to the benefit of the act of 1880, though he found that "the degree of helplessness which has been shown, was that contemplated by the law." The Supreme Court of the District of Columbia refused to issue the mandamus and on writ of error their judgment was affirmed. After quoting from Decatur *v.* Paulding the passage quoted hereinabove and laying down the rule deducible from that case and Kendall *v.* Stokes, Justice Bradley said:

> Judged by this rule the present case presents no difficulty. The Commissioner of Pensions did not refuse to act or decide. He did act and decide. He adopted an interpretation of the law adverse to the relator and his decision was confirmed by the Secretary of the Interior as evidenced by his signature of the certificate.

This confirmation, however, had nothing to do with the question, for if the Commissioner's act was ministerial his was necessarily so too.

> Whether if the law were properly before us for consideration we should be of the same opinion, or of a different opinion, is of no consequence in the decision of this case. We have no appellate power over the Commissioner and no right to revise his decision. That decision and his action taken thereon were made and done in the exercise of his official functions. They were by no means merely ministerial.

The case at bar, in our opinion, presents a stronger case for the denial of the writ than either Decatur *v.* Paulding or U. S. *v.* Black or the recent case of Redfield *v.* Windom (137 U. S., 636), in each of which it was denied.

There are only three cases in the Supreme Court to which our attention has been called where the mandamus has been ordered. (1) Kendall *v.* Stokes (12 Pet., 524.) In this case the law required the Postmaster-General to enter to the credit of a contractor such sum as the solicitor should report to him for that purpose. There was no possible room for the exercise of discretion. (2) Butterworth *v.* Hoe (29 O. G., 615; 112 U. S., 50.) Here the Commissioner of Patents found all the facts in favor of the applicant and ordered patent to issue. An appeal was taken to the Secretary of the Interior, who reversed him. In deference to this decision the Commis-

sioner withheld the patent. It was held that the Secretary had no jurisdiction over the Commissioner's decisions, and as the Commissioner had already determined every question in favor of the applicant nothing remained to be done but to deliver the patent, which was a purely ministerial act. (3) U. S. *v.* Schurz (102 U. S., 378.) In this case a patent to land had been made out and signed, and only lacked delivery. Held that applicant's right had been settled, and he was entitled to the possession.

To these may be added Marbury *v.* Madison (1 C., 137), in which the Court apparently would have issued the writ had it not found itself without jurisdiction. Marbury had been apointed to an office by President Adams; the Senate had confirmed him; his commission had been made out and signed by the President, and nothing remained to be done beyond its delivery. There is no similarity between the facts of those cases and of this. The distinction is plain and unmistakable.

We are clearly of the opinion that the duties imposed upon the Commissioner of Patents by the trade-mark act are not ministerial, but that their proper discharge requires the exercise of judgment and discretion, and that therefore, his action can not be controlled in this proceeding.

In view of the suggestion by counsel that applications for other trade-marks on behalf of the relator are waiting presentation upon the decision of this case, and because from what has been said we may have created the impression that we deem the decision of the Commissioner, to the effect that the State could not engage in foreign commerce, erroneous, and as the question has been fully argued, we will express ourselves, briefly, on the second proposition, though its decision is not absolutely necessary.

It would seem to be the practice of those who desire the registration of newly-adopted trade-marks to ship a package of merchandise labeled therewith to some foreign country, and upon its sale there to base the affidavit that the same is used in foreign commerce. Whether an isolated case of such consignment and sale would constitute commerce with a foreign nation within the meaning of the law is a question which was not argued, and we will pass it by without decision, assuming for the purpose of this case only that it would.

The power of the State of South Carolina to engage in foreign commerce, for the purpose of revenue or profit, through an express act of her Legislature, is a question that we are not called upon to decide. We do hold, however, that the executive officers of the State can not engage her in trade without the express authority of the Legislature, and we do not understand that this power is seriously

claimed. The dispensary law, which was enacted December 24, 1892, and took effect July 1, 1893, clearly has its foundation in an attempt to exercise the police power of the State for the prevention of the evils which attend the indiscriminate sale of intoxicating liquors. The collection of revenue is an incidental feature thereof. If the expressed object of the law were the making of profit through trade in liquors, and the suppression of the evils of private traffic therein were only an incident, the question would be presented whether the Legislature of a State, without express constitutional authority, has the power to collect money, by the exercise of its sovereign power of taxation, for the purpose of using it in ordinary trade with the view to prospective profit.

If such were the question, we would have no hesitation in saying that no such power exists.

The constitution of South Carolina provides that—

> every act or resolution having the force of law shall relate to but one subject, and that shall be expressed in the title.

The title of the dispensary act is:

> An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this State, except as herein permitted.

It would be an unnecessary consumption of time to undertake a synopsis even of this lengthy act. We can find nothing whatever in it to justify an inference that it was intended to give authority for trade in liquors outside the limits of the State. Every part of it relates exclusively to sales, as expressed in the title, "within this State." The State commissioner is required to purchase the liquors for sale in the State and put them upon the market, through the county dispensers, under the most stringent regulations to prevent abuse. If a non-resident should desire to buy any of the State's liquors, he can not order it sent to him by the commissioner or one of the dispensers. By a strained and doubtful construction he might procure it through some resident agent, who might possibly be allowed to make the necessary sworn application, procure a limited quantity of the liquor, and then, as his own act, ship it to his principal; but this, if permissible at all, would hardly constitute foreign or interstate trade in the article.

If then, as seems to have been proved before the Commissioner, a case of the State's liquors was sent to Canada and sold there by the State commissioner, it was not authorized by the law, and was not the act of the State, but of the officer. This distinction between the acts of the State and the acts of its officers without the authority of a valid law is clearly stated in the able opinion of Justice Lamar, speak-

ing for the Court, in Pennoyer *v.* McConnaughey (140 U. S., 1).

The Commissioner did not err in the conclusion that the trade-mark applied for had not been lawfully used in foreign commerce.

It follows from what has been said that the judgment appealed from should be reversed and the relator's petition dismissed, and it is so ordered.

The Relator appeals.

From this final judgment of the Court of Appeals this appeal is taken by the State of South Carolina, the plaintiff in error.

No money nor property right involved—the interpretation of a statute the issue.

It is proper to note here that the foregoing record discloses no dispute between the litigants involving "money," nor right of property whose value can be stated or fixed in money; indeed, it is seriously questionable if any right of *property* at all is involved, for the statutory right to apply for the registration of a trade-mark, aye, even the registration itself of the mark, can hardly be correctly and legally denominated and classed as a *property* right. The registration of a trade-mark in the Patent Office is made by the trade-mark statute *evidence* of *prima facie* ownership of the mark, but it is not in any degree the mark itself nor the right of *property* in the mark. This distinction between the *statutory privilege* of applying for and of obtaining the *registration* of a trade-mark and the *right of property in the trade-mark itself*, which distinction is real and true and at the foundation of the Federal trade-mark statute is well to be kept in mind during the examination of the right, if any, of the relator to appeal to this Court. (Lamont v. U.S., 146 U.S. 553; Abadie v. U.S., 149 U.S. 261,

The record reveals that the plaintiff in error, through and by her counsel, contend for one *interpretation* of the *trade-mark statute* as bearing upon the powers of the Commissioner of Patents to refuse to register an alleged trade-mark, while the Commissioner construes the statute differently and re-

"Such controversy as may be carried on in the Patent Office under the act of 1881 is controversy as to the evidences of the right, not as to the right itself." (Einstein v. Sawhill, 65 Off. Gazette Patent Office, 1920, 1. 10, et seq.)

jects the correctness of the relator's interpretation. This is the whole *dispute* between the parties. One insists upon one construction and the other upon another and a different construction of the law. The *validity* of the trade-mark *statute* is not questioned, nor is the validity of the *authority* of the Commissioner of Patents in dispute. Both suitors admit that he is *validly* authorized under and by the trade-mark statute to examine applications for the registration of trade-marks, to allow such applications as are within the requirements of the statute and to refuse such as are without the statute, but the dispute arose on the question as to whether the relator's application is within or without the statute. The relator interprets the statute and insists that it is within the law; the Commissioner construes the law and announces that it is without the statute. The whole dispute arose and and rests upon the interpretation of a statute and not its validity.

POINTS OF LAW.

"From Wiscart *v.* D'Auchy, 3 Dall., 321, to American Const. Co. *v.* Jacksonville, T. & K. W. R. Co., 148 U. S., 372, it has been held in an uninterrupted series of decisions that this Court exercises appellate jurisdiction only in accordance with the acts of Congress upon that subject," so spoke Mr. Chief Justice Fuller for the Court, in the decision in the case of Colorado Cent. Consolidated Min. Co. *v.* Turck, 150 U. S., 138.

Act of February 9, 1893, establishing the Court of Appeals of the District of Columbia, etc.

By an act approved February 9, 1893, entitled "An act to establish a Court of Appeals for the District of Columbia and for other purposes" (27 Stat. L., p. 434, ch. 74), it is provided, among other things, that there shall be, and is thereby, established in the District of Columbia a court to be known as the Court of Appeals of the District of Columbia. Section 8, of this act, is as follows, to wit:

"SEC. 8. That any final judgment or decree of the said Court of Appeals may be re-examined and affirmed, reversed,

or modified by the Supreme Court of the United States, upon writ of error or appeal, in all causes in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the same manner and under the same regulations as heretofore provided for in cases of writs of error on judgment or appeals from decrees rendered in the Supreme Court of the District of Columbia; and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty or statute of or an authority exercised under the United States."

Under this section (8) the appeal in this case is taken. If the matter in dispute in this cause exceeds the sum of $5,000; or without regard to the sum of money, if the suit draws into question the validity of a patent or copyright, or of a treaty or statute of or an authority exercised under the United States, and if the judgment of the Court of Appeals rendered herein is such as would have been appealable from the Supreme Court of the District of Columbia to this Court, then only is this appeal sustainable. In order to maintain that this Court has jurisdiction of the appeal, the appellant in error must show (1) that the matter in dispute exceeds the sum of $5,000, or (2) that the issue in controversy is the validity of a statute of or authority under the United States, or (3) again, that the judgment rendered would have been appealable "under the same regulations as heretofore provided for in cases of appeals from decrees rendered in the Supreme Court of the District of Columbia." 23 Stat. L., p. 443.

All three of these points can be discussed in treating of the act of Congress providing for writs of error and appeals from judgments and decrees rendered in the Supreme Court of the District of Columbia, 23 Stat. L., p. 443, supra. The act will be copied before beginning the examination of it.

CHAP. 355. An act regulating appeals from the Supreme Court of the District of Columbia and the supreme courts of the several Territories.

Be it enacted, etc., That no appeal or writ of error shall hereafter be allowed from any judgment or decree in any suit at law or in equity in the Supreme Court of the District of Columbia, or in the Supreme Court of any of the Ter-

ritories of the United States, unless the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars.

Sec. 2. That the preceding section shall not apply to any case wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty, or statute of, or an authority exercised under, the United States; but in all such cases an appeal or writ of error may be brought without regard to the sum or value in dispute. Approved March 3, 1885, 23 Stat. L. 443.

It will be observed at the outset that the provisions of this act, and those of section 8 of the act establishing the Court of Appeals of the District of Columbia, are identical in substance. If there is any difference at all between them, it is simply of phraseology. The words, "in the same manner and under the same regulations as heretofore provided for in cases of writs of error on judgment or appeals from decrees rendered in the Supreme Court of the District of Columbia," interjected into section 8, would seem not to add to nor to take from the subject-matter of the section (8), but only to inform the practitioner that the practice in taking appeals from the new Court of Appeals to the Supreme Court of the United States, is the same in manner and under the same regulations as heretofore provided for in appeals from the Supreme Court of the District of Columbia.

As the act of March 3, 1885, and section 8 of the act of February 9, 1893, are the same in substance, it is immaterial which one we examine, but as the act of 1885 has been judicially examined and passed upon, it rather than section 8 will be reviewed.

Act of March 3, 1885, section 1.

As to section 1: It is respectfully submitted that in order to give this Court jurisdiction under section 1 of the act of March 3, 1885, "the matter in dispute" must be a sum of money which exceeds the sum of $5,000, or some property right, the value of which can be ascertained and computed to exceed the sum of $5,000 by the ordinary rules of business. The words and meaning of the section (1) are plain.

They give the right of appeal and revision in those cases only (*a*) where the sum of money in dispute exceeds $5,000, or (*b*) where the right of property involved has an ascertained or at least ascertainable money value which exceeds the sum of $5,000.

There is no sum of money involved in the decision of the Court of Appeals in this case. Nor was there any right of property in issue. The petition for mandamus stated that the trade-mark "constitutes a valuable *right* which the petitioner is desirous of protecting to the full extent of the law enacted for the protection of trade-marks" (Pet., par. 2), and that the Commissioner of Patents has refused to register the trade-mark, thereby denying a plain *right* to the petitioner, to the injury and damage of the petitioner. (Pet., par. 5.) The matter in dispute in this cause is whether the writ of mandamus will lie to command the Commissioner of Patents to register the alleged trade-mark as applied for. No money value can be fixed on the issue or non-issue of the writ. Even if the right to apply for registration or the right to have registration of a trade-mark could be defined as a "right of property," still its value in money is not susceptible of calculation. The registration in intrinsic worth to the petitioner may be possessed of a high degree of utility in administering its dispensary law, but its exchangeable value which disposes people to give money for it, and which is the kind of value meant in the statute in estimating whether it exceeds the sum of five thousand dollars, is practically nothing. In any event, the mere denial of registration is a mere intangible effect and its money loss thereby is indeterminable and incalculable. It is impossible to give any practical rule by which the benefit the State may gain or the damage it may suffer from the refusal of the Commissioner of Patents to register her alleged trade-mark can be estimated. Smith *v.* Adams, 130 U. S., 167 (176, l. 15.) Cameron v. U.S., 146 U.S. 533,

Mr. Justice Gray, speaking for this Court, in Kurtz *v.* Moffitt, 115 U. S., 487 (494) said: "To assist in determining whether a writ of *habeas corpus* is a suit at law or in equity where the matter in dispute exceeds the sum or value of five

hundred dollars, it will be convenient to refer to the use and the interpretation of like words in earlier acts defining the jurisdiction of the national courts." And after reviewing numerous authorities interpreting like words in earlier acts, he made this announcement, "From this review of the statutes and decisions, the conclusion is inevitable that a jurisdiction, conferred by Congress upon any court of the United States, of suits at law or in equity in which the matter in dispute exceeds the sum or value of a certain number of dollars, includes *no case* in which the right of neither party is capable of being valued in money" (p. 498, l. 6 *et al*).

As has been pointed out nothing appears of record to show the money value of the matter in dispute. Street *v.* Ferry, 119 U. S., 386, l. 19. In truth, the question whether a writ of mandamus, which is the matter in dispute, can be issued to command the Commissioner of Patents to register the alleged trade-mark as applied for, has no money value and can have no money value by reason of its very nature. It involves not money but the means, if any there be, to enforce an alleged right.

"In order to give this Court jurisdiction," said the Chief Justice, in Cross *v.* Burke, 146 U. S., 82 (88, l. 9), "under the act of March 3, 1885, the matter in dispute must be money, or some right, the value of which in money can be calculated and ascertained."

Section 2.—Cases involving Patents, etc.

Nor is an action for a writ of mandamus to command the Commissioner of Patents to register a trade-mark, and the judgment of the Court of Appeals thereon, a case within the provisions of section 2 of the act March 3, 1885, nor of section 8 of the act of February 9, 1893. In re Craft, 124 U. S., 370 (374).

This action does not involve the validity of a patent, nor copyright, nor treaty, nor statue, nor authority of the United States. The only inquiry for the Court of Appeals to make and judgment to render in this case were, will a writ of man-

damus lie to command the Commissioner of Patents to register the alleged trade-mark applied for? The authority of the Commissioner to act under the trade-mark law was not in issue; the correctness, or to put it stronger, the legality of his interpretation of the law was drawn into question. The act of the Commissioner in refusing the registration did not involve the validity of the exercise of an authority under the United States. No more so than the act of this Court in deciding this motion will involve the validity of the exercise of an authority under the United States. The Commissioner was not acting for the Government of the United States, nor exercising an authority under it, except in the broad sense of deciding on an application for the registration of a trade-mark under its trade-mark statutes. Balto. & Potomac R. R. Co. *v.* Hopkins, 130 U. S., 211; District of Columbia *v.* Gannon, 130 U. S., 227. Mr. Justice Harlan, in rendering the decision in the case of Clough *v.* Curtis, 134 U. S., 361 (370, ll. 1–7), said of the decision in the case of Balto. & Potomac R. R. Co. *v.* Hopkins, *supra*, "It was held therein that the words in the act of March 3, 1885, 23 Stat., L. 443, c. 355, the validity of a statute of or an authority exercised under the United States do not embrace a case, which depends only on a *judicial* construction of an act of Congress, there being no denial of the power of Congress to pass the act, or of the right to enjoy whatever privileges are granted by it." In the same case of Clough *v.* Curtis, the Justice continued (p. 369), "the alternative writ of mandamus herein proceeds on the ground that a body of persons claimed, but without right, to be respectively the lawful Council and House of Representatives of the Territory, usurped the legislative power conferred by Congress upon the legislative assembly of the Territory, and passed enactments purporting to be laws of such Territory. In each case is directly drawn in question the *lawful existence* of these bodies as the Council and House of Representatives of the Territory, and consequently, the authority which they have assumed, as the legislative assembly of the Territory, to exercise under the United States." W. Y. R. C. v. Dis. of C. 146 U. S. 227.

In this present case the lawful *existence* of the authority of the Commissioner of Patents is not drawn in dispute.

"The distinction is palpable between a denial of the validity of the authority and a denial of a title, right, privilege, or immunity claimed under it." B. &. P. R. R. Co. *v.* Hopkins, *supra* (p. 223, ll. 6–8).

The contention by the State of South Carolina that the Commissioner of Patents erroneously interpreted the trade-mark law as empowering him to render the decision that he did against the registration of the alleged trade-mark, and the judgment of the Court of Appeals that he did not erroneously interpret the trade-mark law as to his powers thereunder, do not in any manner or degree draw into issue "the validity of an authority exercised under the United States." U. S. *v.* Lynch, 137 U. S., 280 (286, l. 22, *et seq*).

Said the Court in this case, "The validity of the statute is not drawn in question every time rights claimed under such statute are controverted, nor is the validity of an authority every time an act done by such authority is disputed. The validity of a statute or the validity of an authority is drawn in question when the existence, or constitutionality, or legality of such statute or authority is denied, and the denial forms the subject of direct inquiry." (U. S. *v.* Lynch, p. 285.) Cook Co. Nat'l Bk. 138 U.S. 653, 11 S. Ct. 440.

The authority of the Commissioner of Patents is not thus denied here, nor the validity of his authority questioned, but what is claimed by the State of South Carolina is that in the exercise of his authority in respect to the rejection of the application for the registration of its alleged trade-mark, he erred in refusing to register the trade-mark in view of the interpretation of the trade-mark statute by the counsel for the State of South Carolina. The contention of the State is, that the interpretation the Commissioner of Patents puts upon the trade-mark act as regards his powers thereunder is obviously incorrect. But, it is respectfully submitted, that it does not follow, because the decision of the Commissioner of Patents may have been erroneous and its confirmation by the Court of Appeals error, that the assertion of the State to that effect raises a cognizable controversy as to the Commissioner's authority to proceed at all. The language of the

Court in U. S. *v.* Lynch, 137 U. S. 286, l. 28 *et seq.*, fits this present case exactly: "What the relator sought was an order coercing these officers to proceed in a particular way, and this order the Supreme Court of the District declined to grant. If we were to reverse that judgment upon the ground urged, it would not be for want of power in the auditor to audit the account, and in the comptroller to revise and pass upon it, but because those officers had disallowed what they might have allowed and erroneously construed what needed no construction. This would not in any degree involve the validity of their authority."

In every reported case of this Court where jurisdiction has been retained, "the existence or validity of the authority was primarily involved."

The attention of the Court is directed at this point to the fact that the trade-mark act of 1881 contemplates that the action of the Commissioner of Patents on an application for the registration of a trade-mark shall be conclusive and final. No appeal from his decision is provided for. Notwithstanding that, the relator under the cover of a mandamus proceeding virtually appealed from the decision of the Commissioner to the Supreme Court of the District of Columbia, and has had in turn the decisions of that tribunal and of the Court of Appeals of the District of Columbia, and now seeks to obtain the review and judgment of this Court on the action of the Commissioner in refusing its application for registration. And all this has been accomplished by attacking his *interpretation* of the trade-mark statute.

To emphasize this by an illustration, borrowed from the duties and powers of the Commissioner of Patents under the patent laws, to make clearer, if possible, that the State of South Carolina has no right of appeal in this case: We will imagine a case wherein the Commissioner of Patents has rejected an application for a patent, and the applicant has petitioned the District Court for a writ of mandamus, and has been refused, could it be successfully maintained that the decision of the Court denying the petition involved "the validity of a patent right (no patent having been granted)

or an authority exercised under the United States." Most certainly not. Why then is the attempt made to persuade this Court that it has jurisdiction of an action in mandamus for the registration of a trade-mark, when even the word "trade-mark" is omitted from the statute providing for appeals?

It is respectfully submitted that this case does not come within either of the sections of the act of March 3, 1885, nor of section eight of the act of February 9, 1893, as the case may be, and therefore the appeal should be dismissed. U. S. *ex rel.* Trask *v.* Wanamaker, 147 U. S. 149 (150).

It is hardly necessary to say that this appeal can not fall within the provisions of R. S., sec. 699, which gives this court jurisdiction, "without regard to the sum or value in dispute, for the review of any final judgment at law or final decree in equity of any Circuit Court, or of any District Court acting as a Circuit Court, in any case brought on account of the deprivation of any right, privilege, or immunity secured by the Constitution of the United States, or of any right or privilege of a citizen of the United States." French *v.* Hopkins, 124 U. S., 524; Cross *v.* Burke, 146 U. S., 82.

The burden of establishing jurisdiction is on the plaintiff in error. The State must show, as a matter of fact, that the value of the matter in dispute exceeds the sum of $5,000 or, as a matter of law, that the judgment appealed from involves the validity of a statute of or an authority exercised under the United States. Wilson *v.* Blair, 119 U. S., 387 (388).

Respectfully submitted.

JOHN I. HALL,
LEVIN H. CAMPBELL,
Counsel for the Commissioner of Patents.

Supreme Court, U. S.
FILED.
APR 9 1894
JAMES H. McKENNEY,
CLERK.

153-353

IN THE

Supreme Court of the United States.

THE UNITED STATES, *ex relatione*
THE STATE OF SOUTH CAROLINA,
Plaintiff in Error.

vs.

JOHN S. SEYMOUR,
Commissioner of Patents,
Defendant in Error.

No. 1140;
October Term,
1893.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

"PALMETTO" TRADE-MARK CASE.

BRIEF IN BEHALF OF THE PLAINTIFF IN ERROR IN OPPOSITION TO THE MOTION TO DISMISS FOR WANT OF JURISDICTION.

JOHN ALTHEUS JOHNSON,
Counsel for Plaintiff in Error,
the State of South Carolina.

JOHN F. SHEIRY, PRINTER, 625 D STREET.

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THE STATE OF SOUTH CAROLINA,
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BRIEF IN BEHALF OF THE PLAINTIFF IN ERROR IN OPPOSITION TO THE MOTION TO DISMISS FOR WANT OF JURISDICTION.

The Plaintiff in Error on July 1, 1893, under and by virtue of an act of its General Assembly, approved December 24, 1892, assumed control within its borders of the traffic in intoxicating liquors. It assumed to subject to chemical analysis all the liquors that it handled, and to expose to sale such only as were certified by its proper officials to be chemically pure; and, in connection with its trade in these goods,

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it adopted and used a trade-mark. Desiring the benefit of Federal registration as offered to owners of trade-marks by the act of Congress of March 3, 1881 (21 St. at L., 502), the Plaintiff in Error, on July 15, 1893, filed its application at the Patent Office for the registration of its trade-mark. The application set forth the applicant's ownership of the mark; and it set forth also the use of the mark by the applicant in foreign commerce. (The application is set forth in paragraph 3 of the relator's petition for a mandamus, pp. 2 to 4 of the printed record herein.)

If dispute arise or exist concerning the ownership of a trade-mark offered for registration, the statute declares that (for the purposes of registry) the Commissioner of Patents shall decide the dispute—"shall decide the presumptive lawfulness of claim to the alleged trade-mark." But no dispute or controversy whatever of this character arose or existed in the case of the Plaintiff in Error. There was no prior registrant, nor any applicant for registration, whose claim in any manner conflicted with the claim of the Plaintiff in Error as the owner of the mark that was offered for registration. The mark did not trench upon any known or registered trade-mark. Indeed, the fact of ownership, as distinguished from the use of the mark in foreign commerce, was not in any wise questioned; nor was the character of the mark as being in itself a proper trade-mark for the class of goods to which applied in any wise questioned. But the Commissioner of Patents assumed to pass upon the legal character of the foreign sales and to declare that the officers and agents of the Plaintiff in Error were acting *ultra vires* when they sold to residents of foreign countries. The Commissioner assumed to say that the Plaintiff in Error was without a foreign trade—a requisite o registration under the trade-mark statute—and he thereupon declined to register the trade-mark. This absence of a foreign trade, it is to be noted, is not the absence in foreign countries of goods bearing the trade mark of the Plaintiff in

Error, sold in the usual and legitimate way to residents of such countries; but the absence of authority on the part of the State officials to make such sales. In other words, the Commissioner of Patents, as the registrar of trade-marks, undertook to sit in judgment upon the acts of the accredited agents and representatives of the Plaintiff in Error in the making of sales and to say that, if the proposing purchaser lived within the borders of the State, they were authorized to sell to him; but that, if he lived beyond the limits of the State, they were not authorized to sell; and that, though they actually did sell in the latter cases, such sales did not constitute a foreign commerce.

In the view of counsel for the Plaintiff in Error, no such question as the legal character of the sales made to residents of foreign jurisdictions is committed, by the trade-mark statute, to the judgment or official determination of the recording officer. The statute does not in terms confer such power upon him and the effect attaching to the act of registration does not indicate any such power. Neither the act of recording, nor the certificate of registration, proves anything whatever as to either the fact or the character of a foreign trade.

We are not now seeking to discuss the case on its merits; our purpose is simply to develop the point, relied upon by the relator from the beginning (and sustained by the Supreme Court of the District of Columbia), that the Commissioner of Patents was wholly without jurisdiction to pass upon the legal competency of foreign sales as constituting foreign commerce.

Counsel for the defendant in error very suavely speak as though the question in this case was simply whether the Commissioner of Patents had rightly construed the trade-mark statute. "The Plaintiff in Error," they say (pp. 49–50 of their brief), "contends for one interpretation of the statute, while the Commissioner construes the statute differently and rejects the correctness of the relator's interpretation. One insists upon one construction and the other upon another and

a different construction. The whole dispute arose and rests upon the interpretation of a statute."

The question is not simply whether the Commissioner of Patents has properly interpreted a statute. If counsel for the relator had believed that the interpretation of the statute was committed to the judgment of the Commissioner, and that the Commissioner had simply erred in his interpretation of it, this case would never have been in the courts; for the law has not provided an appeal from the action of the Commissioner in trade-mark matters; and the merest tyro in legal knowledge knows that a proceeding in mandamus cannot be made to supply the office of an appeal or of a writ of error.

The contention of the Plaintiff in Error is not that the Commissioner of Patents merely erred in the interpretation of the statute; it is that he assumed to interpret where it was not his province or jurisdiction to interpret; and hence that his interpretation was not either good or bad, but a mere nullity; in other words, that without authority from the United States, or its laws, under which he claimed to act, he assumed to sit in judgment on the legal character of the acts of trade between the Plaintiff in Error and the residents of foreign nations; and that, in the exercise of this factitious authority, resting only upon his own void act of construction, he refused to register the trade-mark of the Plaintiff in Error.

The present case, therefore, is altogether different from one in which the jurisdiction of the officer is apparent or admitted; as, for instance, in the case against the accounting officers of the Treasury (U. S. *v.* Lynch, 137 U. S. 280) where the right to act was unquestioned and the thing complained of was simply an erroneous act committed within the lines of their jurisdiction; or, to put the case in the words of the court (pp. 285–6): "We think that the authority of the Second Comptroller and the Fourth Auditor is not directly denied here, nor the validity of that authority questioned, but that what is claimed is that, in the exercise of a valid

authority, the Auditor and Comptroller erred in respect to an allowance, in view of the decision of this court in another case." The court had just said previously (p. 285): "The validity of a statute or the validity of an authority is drawn in question when the existence, or constitutionality, or legality of such statute or authority is denied, and the denial forms the subject of direct inquiry." "*The validity of an authority is drawn in question when the existence or legality of such authority is denied, and the denial forms the subject of direct inquiry.*"

The contention of the relator is that the Commissioner of Patents is not invested with authority to sit in judgment on the legal character or effect of foreign sales; that it is not given to him, the recording officer, to speculate as to whether trade *de facto* is also trade *de jure*, or as to whether the agent, whose amenability is to the principal, is acting within the scope of his authority when he makes the sale. Such questions might possibly be raised in a proper case in the courts; but it is not competent for the recording officer to raise them. His duty, on the proper facts appearing as required by the registration act, is to register. The authority claimed and exercised by the Commissioner of Patents is that of unlimited discretion according to which he shall act in registering trade-marks. The contention of the relator is that the Commissioner, in the face of facts such as beset this case, is a ministerial officer, his duty being determined by positive law and not by official discretion.

When the Commissioner of Patents refuses to register what is not a valid trade-mark, the mere name of the applicant, for instance, or a geographical name, or a word or term that is merely descriptive, he is not by that act become an officer of discretion to pass upon the validity of trade-marks; it is not the judgment of the Commissioner, but the declaration of the law, that determines the invalidity of these marks. Suppose the Commissioner of Patents should refuse registration

for a mark which was perfectly proper as a trade-mark, on the ground that the mark offered did not constitute a trade-mark; would it be pretended for one moment that the judgment of the Commissioner would be allowed by the courts to stand between the owner and the act of registration? Would the court not determine for itself the validity of the mark, and enforce registration accordingly? And why? Because the law has not committed to the judgment of the Commismissioner the determination of what shall constitute proper trade-marks. In the same way, suppose the Commissioner should refuse registration on the ground that sales to residents of foreign countries, made in a particular way, did not constitute a foreign commerce; would the courts be helpless to afford a remedy? Has any such question as the drawing of legal inferences from admitted facts as to foreign sales been committed to the judgment of the Commissioner?

The relator has never denied a limited discretion to the Commissioner in trade-mark matters, to wit, a discretion to pass upon the question of *ownership* when doubt or controversy exists in regard thereto. But it is not enough that there be a discretionary power given to an officer; the power must be exercised on the occasion, and under the circumstances, that the law intends. Courts check the exercise of discretion when assumed in regard to matters not properly within it, or when mistake is made in law not germane to the discretion. Given for one purpose the discretion cannot, under the guise of such purpose, be used, either wittingly or unwittingly, in such way as to accomplish a different result from that which the law intended should be accomplished thereby. For instance, if a board of County Commissioners, having authority to approve the bond of an officer, without which bond and approval the officer cannot enter upon his duties, the Commissioners, the bond having been otherwise satisfactory to them, will not be allowed to withhold their approval on the ground that the officer has not been duly

elected, it being no part of the board's duty to inquire into the title or tenure by which the office is claimed (Nelson *v.* Edwards, 55 Tex., 389, 391; Beck *v.* Jackson, 43 Mo., 117; Gulick *v.* New, 14 Ind., 93). Or, if a clerk of a court whose duty it is to approve bonds in attachment proceedings, refuses to approve a bond offered because it contains the name of no surety who is resident in the county, the Court, being of the opinion that such residence is not necessary, will require the clerk to pass upon the bond without regard to that condition (Mobile Mutual Ins. Co. *v.* Cleveland, 76 Ala., 321). Nor can the mayor of a city, being required to issue a license for a particular business on the making of a satisfactory bond to him in a specified sum, decline to issue the license (objection not being taken to the sufficiency of the bond) on the plea that he has concluded that it would be better not to issue the license (The People *ex rel.* Osterhout *v.* Perry, Mayor of Albany, 13 Barbour, 206). The statute under which this case arose was the following:

"No person or persons shall exercise the vocation of booking emigrant passengers or taking money for their inland fare, or for the transportation of the luggage of such passengers, without keeping a public office for the transaction of such business, nor without the license of the mayor of the city in which such office shall be located, for which shall be paid the sum of twenty-five dollars per annum, and give satisfactory bonds in the penal sum of one thousand dollars to the mayor of said city, as security for the proper manner in which his or their business shall be conducted in forwarding said emigrant passengers or their luggage."

The Court says (p. 208):

"That officer (the mayor) claims that the section is to be so construed as to vest in him the power of granting or withholding such license as, in the exercise of his discretion, he shall see fit; while the relator insists that, upon complying with the law, he is entitled to the license as a matter of legal right.

"It may well be, that it would have been better if the legislature had authorized the mayor to grant or withhold licenses, in his discretion. The abuses that have been practised upon the unwary foreigner have been most revolting in their character. The attempt of the mayor to check those abuses deserves commendation. In determining to withhold licenses, it cannot be doubted that he has been actuated by honest and humane motives. Most willingly would I leave him to execute the law according to his own views. But it is my duty, as well as his, to administer law as it is, and not as we may think it *ought to be*. Convinced, as I am, that by the misconstruction of the statute the relator has been deprived of a legal right, I have no alternative but to award the remedy which the law has provided for the enforcement of that right. The motion for a peremptory mandamus must therefore be granted."

Another case where officers, having been led astray by a mistaken notion of the law, were controlled by mandamus, is the case of Thomas *v.* Armstrong *et al.*, Supervisors of Yuba county (7 Cal., 287). The provision of the law was:

"Any person having a license to keep a ferry, and who has kept such ferry in accordance with the law, shall be entitled to have such license renewed for one year, from the date of the expiration of the same."

The County Supervisors refused to renew the license of Thomas on the ground that his franchise or privilege had been sold on execution and that the purchaser at the execution sale, to whom they issued the license, had been subrogated to Thomas' rights. On mandamus proceedings instituted by Thomas, the court held that a franchise was not the subject of levy and sale by execution, and hence that the execution sale had been a nullity. It thereupon awarded a mandamus for performance of the specific act of renewing the license to Thomas. The place for exercising discretion, to wit, inquiring as to the observance of the ferry law, having been reached and passed, there was no further discretion to be ex-

ercised; and hence the action of the court directing the particular act to be done.

In the present case the Commissioner of Patents was without the realm of his discretion when he reached the ground upon which he placed his refusal to register. True, use of a trade-mark in commerce with a foreign nation or an Indian tribe is a fact which must be made to appear before the owner thereof is entitled to registration under the Federal statute. But controversies or disputes between rivals at the Patent Office concerning the fact of foreign trade would be senseless, since registration is intended only for the *owner* of the trade-mark. No matter who may first have used the mark in foreign commerce, or under what circumstances he may have used it, or to what extent, such use will not avail for registration, unless the person so using it should be also the *owner*. The prime question, therefore, the one that lies at the threshold of the act of registration, is the question of ownership; and this is the question concerning which the Commissioner of Patents is authorized, in the latter part of section 3 of the trade-mark statute, to pass upon disputes—"to decide the presumptive lawfulness of claim to the alleged trade-mark;" and this question is that which measures and circumscribes the discretion of the Commissioner in trade-mark matters. When the Commissioner assumes to go further and to invade the field of foreign commerce, as in the present case, he is without his discretionary jurisdiction and is liable to be specifically controlled by mandamus.

The Commissioner exhausts his discretion when he decides "the presumptive lawfulness of claim to the alleged trade-mark;" decides, not the *lawfulness of the alleged trade-mark*—the law determines that, but the lawfulness of *claim to the alleged trade-mark;* and this is a question of ownership which is raised only when apparently conflicting rights are presented to the Commissioner. For the Commissioner to attempt, under the guise, or in the name, of the authority here given,

to go back of a mark having all the registrable qualities, and call in question the ownership of the party presenting it, no one disputing the presenter's claim, or appearing from the Commissioner's record to have an adverse interest; in other words, for the Commissioner to deny to the "owner of a trade-mark" the benefits of the statute which expressly says what "owners of trade-marks" may do, to wit, register their trade-marks, would be an arbitrary exercise, not to say, abuse, of discretion which this court would not hesitate to curb. Legal discretion of itself imports limitations; and for the Commissioner to claim, under the clause in question, such power as is here suggested, is to claim the power, at his pleasure, to nullify or defeat the law, whose officer he is—a contention not to be tolerated.

In this case, therefore, the authority that was claimed and exercised by the Commissioner of Patents under the trade-mark statute is directly drawn in question. The statute itself is in nowise questioned, but the authority that the Commissioner of Patents has assumed to exercise in its name is questioned. The Commissioner, by an interpretation of his own, sought to clothe himself with judicial discretion; the relator asked the court to construe the statute, insisting that the duty of the Commissioner under the statute, in the face of such facts as were developed in this case, was purely ministerial.

The motion to dismiss is also resisted on the score of pecuniary value. When the subject-matter of litigation is a thing possessed in the eye of the law of a money value, this court will not decline jurisdiction merely because the value is incapable of being estimated to a certainty in dollars and cents. This principle is illustrated in the case of Sparrow *v.* Strong, reported in 3 Wall., 97. The subject-matter of litigation in that case was a "*mining claim*" in the Territory of Nevada.

The United States, at the origin of that case, had not even surveyed the land in which the claim was situate, much less issued a patent therefor; and the fee was in nowise involved. There was nothing about the case, or the pleadings in it, to indicate that the ownership of the soil, as distinguished from the mineral deposits that were in it, was in any manner involved in the litigation. On the contrary, such claims seem to have been regarded and treated in the mining regions as a species of property existing independently of the ownership of the soil; and the suit referred to was one that sought the recovery simply of one of these "*mining claims*"—a thing that might prove to be of very great value, and yet a thing that might prove to be utterly worthless. Because its worth was thus indefinite, incapable of calculation in dollars and cents, it was objected by the defendant in error that the requisite jurisdictional value was wanting; and the court was asked to dismiss the writ of error on that ground. The court in speaking to that point (p. 104) says:

"We know that the Territorial legislature has recognized by statute the validity and binding force of the rules, regulations and customs of the mining districts. And we cannot shut our eyes to the public history, which informs us that under this legislation, and not only without interference by the National Government, but under its implied sanction, vast mining interests have grown up, employing many millions of capital, and contributing largely to the prosperity and improvement of the whole country.

"We cannot dismiss this writ of error, therefore, on the ground that a controversy concerning *the possessory right to a mining claim*, existing under the express sanction of the Territorial legislature and the implied sanction of the National Government, does not relate to a subject-matter capable of being valued in money."

A trade-mark being a species of property recognized by the courts as of pecuniary value, and a right of action existing for every infringement or invasion thereof, either at law for the

damage, or in equity for an injunction and accounting (McLean *v.* Fleming, 96 U. S. [6 Otto], 245; Julian *v.* The Hoosier Drill Co., 78 Ind., 408; Graham *v.* Plate, 40 Cal., 593; Avery *v.* Meikle, 85 Ky., 435; Stonebraker *v.* Stonebraker, 33 Md., 252; Hostetter *v.* Vowinkle, 1 Dill., 329), this court, on the principle followed in the case of Sparrow *v.* Strong, *supra*, will not assume the value to be less than $5,000 when the article of commerce to which applied is of as wide and extensive use as the one involved in this case. The magnitude of the traffic in distilled liquors is public knowledge of a kind that this court will not shut its eyes to, the article being found in the marts of the whole civilized world; and the pecuniary value for these goods of a trade-mark that is widely famous and known to designate chemical purity in the article to which attached is hardly to be overestimated from a mercantile stand-point. Indeed, in the case in 96 U. S., above cited, which was for infringing the trade-mark on liver pills only, the damages awarded by the circuit court were $7,399.35.

It is not a sufficient answer to what is here urged in regard to the money value of a trade-mark to say that the controversy in this case has to do, not with the trade-mark itself, but only with the registration of it; not with the substantive thing, but only with the evidences of it. Registration, which by the act is allowed to all "owners of trade-marks used in commerce with foreign nations," is a means of securing to the owner the fullest enjoyment of trade-mark property. It furnishes evidence, *prima facie*, of ownership; it affords to the owner the right, in suits for infringement, to resort to the United States courts, which are given jurisdiction, original and appellate, without regard to the amount in controversy; and, to say nothing of its moral effect in deterring from infringements, it is a condition precedent to the owner's registration of it in foreign countries, the International Trade-mark compact requiring that the owner shall first have registered in the

country of origin, after which the other members of the Union will register as a matter of course on application; or, to quote the words, in part, of Article 6 of the Convention of the International Union for the protection of Industrial property (of which Union the United States is a member): "Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union."

But, without further specifying the advantages of registration under the trade-mark statute, it may be remarked generally that the peculiar character of trade-mark property makes it specially desirable for the owner to have the convenient and inexpensive proof of ownership that comes from registration, together with the other features that inhere and belong to the act of registration and that so sensibly enhance the value of the property.

The motion to dismiss is therefore opposed on two grounds —the two which are embraced in the following quotation from Sec. 8 of the act which created the Court of Appeals of the District of Columbia (act of February 9, 1893; 27 St. at L., 436):

"Any final judgment or decree of the said Court of Appeals may be re-examined and affirmed, reversed or modified by the Supreme Court of the United States upon writ of error or appeal (1) in all causes in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars * * *; and also (2) in cases, without regard to the sum or value of the matter in dispute * * * in which is drawn in question the validity of * * * an authority exercised under the United States."

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